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U.S. Patent and Trade-Mark Law  
Commission.

# REPORT

OF

## THE COMMISSIONERS APPOINTED TO REVISE THE STATUTES RELATING TO PATENTS, TRADE AND OTHER MARKS, AND TRADE AND COMMERCIAL NAMES,

UNDER

ACT OF CONGRESS APPROVED JUNE 4, 1898.

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FRANCIS FORBES,  
PETER STENGER GROSSCUP,  
ARTHUR P. GREELEY,  
*Commissioners.*

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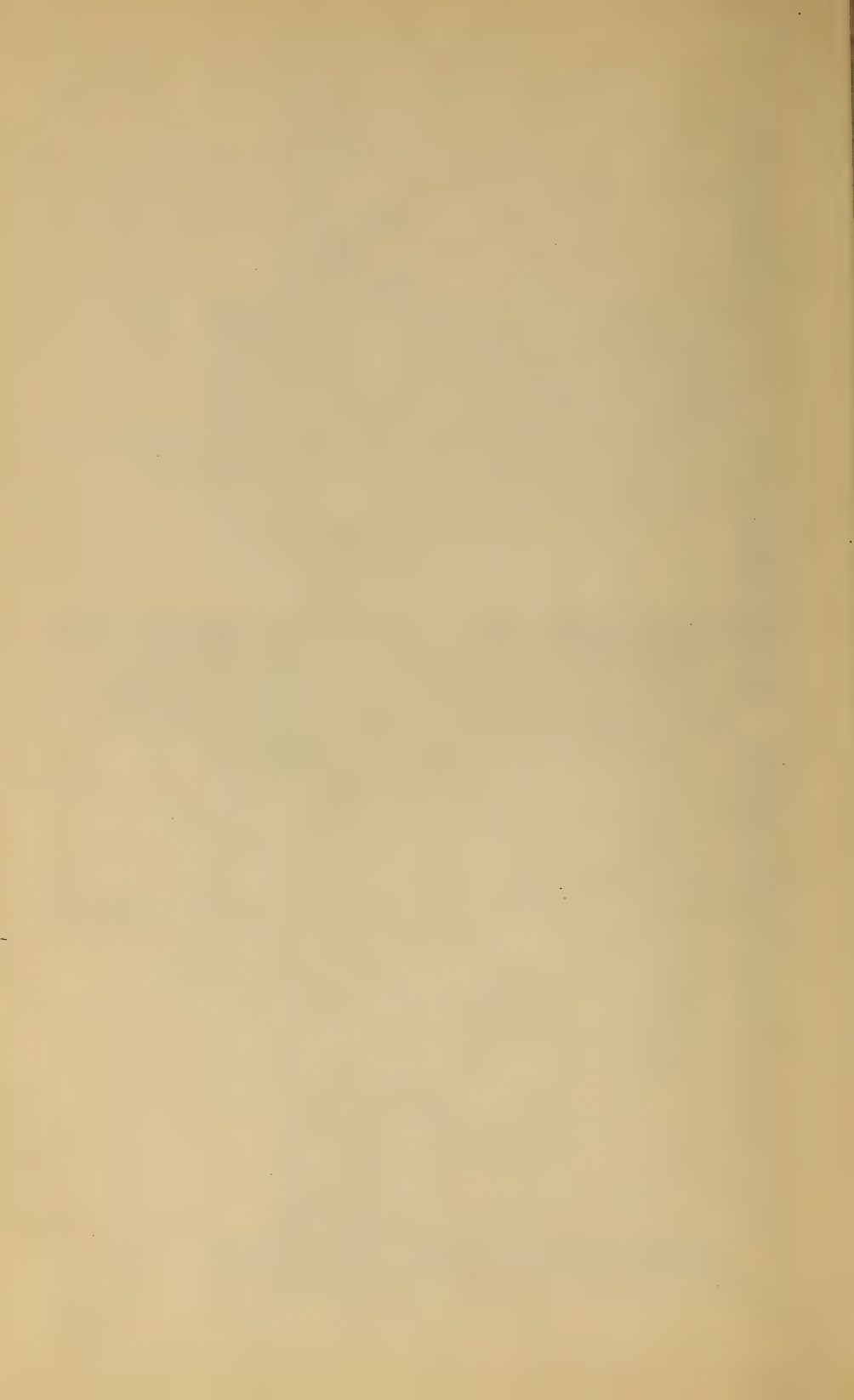
REPORT

OF THE

COMMISSIONERS APPOINTED TO REVISE THE LAWS  
RELATING TO PATENTS, TRADEMARKS, AND  
TRADE NAMES, WITH REFERENCE  
TO EXISTING CONVENTIONS  
AND TREATIES.

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*To the Congress of the United States of America:*

We, the commissioners appointed by the President under the act entitled "An act appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names," approved June 4, 1898, have the honor to submit herewith the report called for by said act.

Respectfully,

FRANCIS FORBES.  
PETER STENGER GROSSCUP.  
ARTHUR P. GREELEY.

NOVEMBER 27, 1900.



## REPORT.

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*To the Congress of the United States of America :*

We, the commissioners appointed by the President of the United States under the act entitled "An act appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names," have the honor to submit the following report and accompanying bills.

In order that we might have the fullest possible expression of the views of those interested in the patent system and in the question of the protection of trademarks, we issued a circular letter inviting expressions of views on these questions, sending it to commercial and manufacturing organizations throughout the country, as well as to the members of the patent profession, who are necessarily in close touch with the patent and trademark interests of the country. We also held public hearings in Chicago, New York, and Washington, which were largely attended and at which a full opportunity was given for the expression of the views of all persons interested in the questions before the commission for consideration. We have, in making the recommendations contained in this report, taken into consideration the views expressed on these questions by the American Bar Association, the Manufacturers' Association of America, The Pharmaceutical Association, the United States Trade-Mark Association, the Association of Retail Druggists, and, in general, the views of any and all persons who have presented their views to us, either orally or by letter.

These hearings were had and views expressed without reference to any specific bill providing for changes in the patent or trademark laws.

While the views expressed to us are not in all respects in agreement, we have found that there is general agreement on the following propositions:

1. That the International Convention signed at Paris, March 20, 1883, is advantageous to the people of this country, and the United States, as a party thereto, should provide for carrying out its provisions in good faith.

2. That the treaty relations of the United States, the interests of American manufacturers engaged in domestic trade, and particularly the interests of manufacturers engaged in foreign trade, demand a national trademark law which, so far as the Congress has the power

to do under the Constitution, shall regulate and protect trademarks used in commerce within the United States more satisfactorily than is now possible.

It was also very generally agreed that if it appeared that the privilege of filing caveats under the same conditions as they are permitted to be filed by United States citizens could not be properly given to residents of foreign countries, the caveat should be abolished, it being generally considered that the caveat is at the present time of little or no importance.

The changes which we recommend should be made in the patent laws<sup>1</sup> are embodied in three proposed bills which accompany this report. None of the proposed changes affect the general provisions of the patent law. In reference to trademarks, however, it appeared clear that there is a necessity for a complete revision of the existing law, and the single proposed bill on this subject which accompanies this report is submitted as a substitute for the present trademark law.<sup>2</sup>

The questions of the revision of the patent law, on the one hand, and of the laws relating to trademarks and commercial names, on the other, are so materially different, that we have considered them separately in this report, taking up first the question of the revision of the patent law.

### THE REVISION OF THE PATENT LAW.

#### TREATY OBLIGATIONS REGARDING THE PROTECTION OF INVENTIONS.

We have found it desirable in considering the question of revision of the patent law to first consider what changes in the law are needed to give full force and effect to the treaty obligations which the United States has undertaken touching the protection of inventions made by the subjects or citizens of certain foreign countries.

The most important diplomatic agreement to which the United States is a party, both as regards the interests of its own citizens and the subjects or citizens of foreign countries, is the International Convention for the Protection of Industrial Property, concluded at Paris, March 20, 1883, to which the United States adhered May 30, 1887.<sup>3</sup>

The following foreign nations are at present parties to this Convention:

Belgium; Brazil; Denmark, with the Farøe Islands; Dominican Republic; France, with Algeria and the French colonies; Great Britain, with New Zealand and Queensland; Italy; Japan; the Netherlands, with Dutch East Indies, Surinam, and Curaçao; Norway; Portugal, with the Azores and Madeira; Serbia; Spain; Sweden; Switzerland; Tunis.

The only other diplomatic arrangement with a foreign nation respecting patents is:

The treaty of commerce and navigation concluded between the United States and Japan, November 22, 1894, Article 16 of which relates to "patents, trademarks, and designs," which was followed by a convention "relating to patents, trademarks, and designs" between the same nations, concluded January 13, 1897.<sup>4</sup>

The treaty with Japan is not now of special importance to the present inquiry. The rights which it secured in Japan to citizens of the

<sup>1</sup> See page 36.

<sup>2</sup> See page 65, also page 126.

<sup>3</sup> Appendix, Chap. II, sec. 1, p. 146.

<sup>4</sup> Appendix, Chap. XVIII, sec. 9, p. 332.



United States, so far as patents are concerned, were secured by the adhesion of Japan to the International Convention, above referred to, and by a modification of the patent law of that country.

#### INTERNATIONAL CONVENTION OF PARIS, 1883.

In order to understand the purpose and meaning of this Convention, it is desirable to take into consideration the causes which led to an appreciation of the desirability of an international agreement respecting the protection of patents for inventions and other industrial property and the part taken by the United States in the efforts which culminated in its conclusion in 1883.

In the year 1873, an international exposition was held at Vienna. In connection with this exposition a call was issued for an international congress for the consideration of the subject of patents. Prior to that time the unsatisfactory condition of legislation relating to patents in the European countries had been the theme of discussion in many quarters.

The congress which assembled under this call included a very general representation of the countries which at that time were interested in the development and protection of invention, the German element, as would naturally be expected from the locality in which the congress was held, being largely predominant.

The United States was represented at this congress by the Hon. J. M. Thacher, then Assistant Commissioner of Patents.

In an unofficial statement of the proceedings of this congress, which was in session for five days and after a very full discussion adopted resolutions recommending to the different countries there represented a basis of reform in patent legislation throughout the world, Mr. Thacher said:

It was the general, I may say universally expressed, opinion in the congress at Vienna that in order to secure the advancement of the mechanic arts in their own countries and to prevent the emigration of their most skilled artisans it was necessary to secure a reform in European patent legislation.

Count Andrassy, the premier of the Austrian Government, put it in a very few words during an interview with the permanent committee when he said:

"I look to England and I look to America, and I find that they are the foremost countries of the world in manufactures. I find also, upon examining their laws, that they have the best patent systems in the world.

"Putting these two facts together, I conclude that the one is dependent upon the other, and therefore I am in favor of a thorough reorganization and revision of the patent laws of Austria."

This feeling has grown from year to year and from one international exposition another until I think I am not extravagant in saying that there is a general agreement among leading men—thoughtful men—not only in England, but upon the continent of Europe, that a revision of their patent laws is absolutely necessary. \* \* \*

Since the adjournment of the congress I have been in correspondence with the permanent secretary of the executive committee, Mr. Carl Pieper, civil engineer, of Dresden, and I am assured that the influence of the discussions in the congress and the resolutions there adopted are already being felt in Europe.

You are aware that Switzerland never has had a general patent law and that Holland several years ago abolished her patent law. One of the fruits of this congress in Vienna is a fresh discussion in Holland of the desirability of reestablishing their patent law, or a better one, it is to be hoped. Another is the discussion in Switzerland of the proposition to establish a patent system there; and one of the latest communications from Mr. Pieper informs me that he is now at work as a "missionary," as he terms it, in his own country, organizing associations everywhere and endeavoring to secure the election of such men to their next legislative body as will favor a careful revision of the patent system of Germany.

The resolutions adopted at this congress<sup>1</sup> set forth the views of its members as to the importance of the protection of inventions by the grant of patents, stating the reasons why such protection is of importance. The particular resolutions relating to an international understanding are as follows (translation):

III. Considering the great differences in present patent administration and the altered international commercial relations, the necessity of reform is evident; and it is of pressing moment that Governments should endeavor to bring about an international understanding upon patent protection as soon as possible.

IV. The congress empowers the preparatory committee to continue the work commenced by this first international congress, and to use all their influence that the principles adopted be made known as widely as possible and carried into practice.

While the effect of this congress was of undoubted importance, and led to some changes in the patent laws of European countries, it did not result at once in the international arrangement sought.

#### THE PATENT CONGRESS OF 1878 AT PARIS.

In connection with the international exposition of 1878 at Paris, another patent congress was held.<sup>2</sup> Germany, Luxemburg, Norway, Sweden, Spain, Russia, and the United States were represented at this congress, as well as France. The purpose of the congress was indicated by its president, M. Tesserenc de Bort, the French minister of agriculture and commerce, in the following words (translation):

Industrial property will never be truly protected until there prevail everywhere simple, uniform, and definite regulations, forming between the nations a kind of conventional plan, a sort of mutual insurance against the infringer and the counterfeiter.

The plan of an international agreement took more definite shape at this congress, which created a permanent commission charged with the duty of devising means for carrying the views of the congress into effect. Mr. Forbes, of this commission, assisted at this congress.

#### PRELIMINARY STEPS LEADING TO THE ADOPTION OF THE INTERNATIONAL CONVENTION OF PARIS, 1883.

The French Government was induced to take the initiative in calling an international official conference for the consideration of the plan for a convention for the international protection of industrial property. On the invitation of that Government, the following countries were represented at this conference, either by their ministers at Paris or by special delegates:

Argentina, Austria-Hungary, Belgium, Brazil, United States, France, Great Britain, Guatemala, Italy, Luxemburg, The Netherlands, Portugal, Russia, Salvador, Norway, Switzerland, Turkey, Uruguay, Venezuela.

The conference met at Paris November 4, 1880, and remained in session until November 20, 1880.

The basis of discussion was a report of a draft convention by M. Ch. Jagerschmidt, a French delegate to the conference. The draft is here given in full as throwing light upon the theory upon which the

<sup>1</sup> Appendix, Chap. VII, p. 224.

<sup>2</sup> Appendix, Chap. VIII, sec. 1, p. 228.



convention was drawn and the evils which it was designed to obviate. The draft is as follows (translation):

ARTICLE 1. Austria-Hungary, Belgium, Brazil, the United States of America, France, the United Kingdom of Great Britain and Ireland, Italy, Luxemburg, The Netherlands, Portugal, Russia, the United Kingdom of Sweden and Norway, Switzerland, Turkey, Uruguay and Venezuela are formed into a state of union for the protection of industrial property.

ART. 2. The subjects and citizens of each of the contracting States shall reciprocally enjoy in all the other States of the Union, in matters of patents of invention, industrial designs or models, marks of manufacture or of commerce and the commercial name, the advantages that their respective laws grant at present or shall hereafter grant to natives. They shall have the same protection as these latter and the same legal recourse against all injury done to their rights, upon the sole condition of complying with the formalities imposed upon natives by the domestic legislation of each State.

ART. 3. Every deposit of an application for patent of invention, of an industrial design or model, of a mark of manufacture or of commerce, regularly effected in any one of the contracting States, shall secure for the depositor a right of priority of registration in all the other States of the Union during a period of ——— beginning from the date of the deposit.

ART. 4. The owner of a patent of invention shall have the right to introduce into a country where the patent shall have been granted him, articles manufactured in any one of the contracting countries without that introduction being a cause of forfeiture of the patent.

ART. 5. The ownership of industrial designs or models, and of marks of manufacture and of commerce, shall be considered in all the States of the Union as lawfully acquired by those who make use of such designs or models and marks of manufacture and commerce, conformably to the laws of the country of origin.

ART. 6. Every production bearing, unlawfully, either the mark of a manufacturer or of a merchant located in one of the countries of the Union, or an indication of origin in such country, shall be prohibited entry in all the other contracting States, excluded from transit and from storage, and may be subject to seizure followed, if necessary, by a suit in court.

ART. 7. The deposit of any mark of manufacture or of commerce shall be permitted in all the States of the Union, at the risk and peril of the depositor, whatever may be the nature of the product to which the mark is applied.

ART. 8. The ownership of a commercial name shall be guaranteed in all the States of the Union without distinction of nationality and without obligation of deposit, whether or not it forms part of a mark of manufacture or of commerce.

ART. 9. The high contracting parties agree to accord a temporary protection to patentable inventions, to industrial designs or models, as well as to marks of manufacture and of commerce for the productions, which may figure at official or officially recognized international exhibitions.

Articles claimed to be infringements may be seized in the inclosure of the exhibitions.

ART. 10. Each one of the high contracting parties agrees to establish a special service of industrial property and a central depot, for communicating to the public patents of invention, industrial designs or models, and marks of manufacture and of commerce.

ART. 11. An international organization, placed under the high authority of the Swiss Confederation, shall be charged, under the title of the International Bureau of Industrial Property, with the duty of assembling, arranging, and publishing information of all kinds relative to patents of invention, industrial designs or models, and marks of manufacture and commerce.

The expense to which this institution shall give rise shall be borne by all the Governments of the contracting States.

The International Bureau shall publish a journal of industrial property in the ——— language, by the aid of documents which should be placed at its disposition by the said Governments.

ART. 12. The present convention shall be submitted to periodical revisions for the purpose of introducing improvements of a kind to perfect the system of union of the contracting States.

For that purpose, conferences shall take place successively in the capital of each of the contracting States, between the delegates of said States.

The next meeting shall take place ——— in ——— at ———.

ART. 13. The high contracting parties respectively reserve the right to make separately between themselves special agreements for the protection of industrial property in so far as these agreements shall not interfere with the provisions of the present Convention.

ART. 14. The States which have not taken part in the present Convention shall be admitted to adhere to the same upon their application.

This adhesion shall be notified through the diplomatic channel to that one of the contracting States in which the last conference was held, and by that State to all the others.

It shall convey, of full right, accession to all the clauses and admission to all the advantages stipulated by the present convention.

ART. 15. The present Convention shall be put into execution from ———, and shall remain in force during an indefinite period, until the expiration of a year from the day upon which the denunciation shall be made.

This denunciation shall only produce its effect as regards the State making it, the convention remaining executory for the other contracting parties.

ART. 16. The present Convention shall be ratified and the ratifications exchanged at Paris at as early a date as possible.

- In witness whereof, etc.

The draft was modified in language and added to. An article was inserted giving residents and persons having commercial establishments in one of the States of the Union the same rights under the Convention as citizens. Article 3 of the draft became article 4 of the Convention, and was greatly enlarged.<sup>1</sup> Article 4 of the draft was modified by adding thereto: "The patentee, however, shall be subject to the obligation of working his patent conformably to the laws of the country into which he introduces the patented article."

New articles (6 and 7) in regard to registration of trademarks were added, and a new article (9) in regard to seizure of products bearing illicitly trademarks and commercial names was also added.

A final protocol, explanatory of the articles of the Convention, was also added. The amended articles will be considered hereafter.

The United States was represented at this conference by the Hon. James O. Putnam, United States minister to Belgium,<sup>2</sup> who took part only so far as to obtain the insertion of section 4 of the protocol, which declared that it is understood that the provisions of the Convention shall not be applicable except within the limits of the constitutional powers of the high contracting parties.

The form of convention adopted was applicable, in the case of patents, to the European system under which on deposit of an application for a patent it is granted without examination for novelty; and, in the case of trademarks, to the system under which the deposit of the mark is required in order to obtain any right whatever.

The draft convention adopted by the conference of 1880 was submitted to the participating States, and a second conference was held at Paris in 1883, at which the following nations were represented:

Argentina, Austria-Hungary, Belgium, Brazil, United States, France, Great Britain, Guatemala, Italy, Luxembourg, The Netherlands, Portugal, Russia, Salvador, Sweden, Switzerland, Turkey, Uruguay, Venezuela.

The United States was represented by the Hon. Levi P. Morton, minister to France, who took no part in the discussion.

Section 4 of the protocol, as drafted at the prior conference, was wholly omitted.

No changes were made to conform the Convention to the patent system of the United States; indeed, there was no need of such modifica-

<sup>1</sup> Appendix, Chap. II, sec. 1, p. 146.

<sup>2</sup> Appendix, Chap. VIII, sec. 2, p. 235.



tions, since the laws of the United States were so liberal that nothing could have been added by the Convention to the rights of foreigners in the United States.

The Convention was ratified at Paris June 6, 1884, but was not adhered to by the United States until March 29, 1887, and proclaimed by the President June 11, 1887. Still our Government sent a delegate to the first conference under it, held at Rome in 1886.

#### CONFERENCES HELD UNDER THE CONVENTION.

Conferences looking toward amendment of the Convention have from time to time been held, and at all of these the United States has been represented. At the conference held at Rome in 1886, our minister to Italy, Hon. J. B. Stallo, was in attendance, though it was not until the following year that the United States formally announced its adhesion to the Convention.<sup>1</sup>

While the United States was ably represented at these various congresses and conferences, at none of them, except the congress at Vienna in 1873, was there present on behalf of the United States any delegate qualified by the close and thorough knowledge of our patent system, which can be acquired only by experience, to properly present to the European delegates its principles and advantages. It not unnaturally happened that the Convention as adopted was drawn with less reference to the peculiarities of our system and the needs of our citizens than might otherwise have been the case.

At the conference held under the Convention at Madrid in 1890 the United States was represented not only by Hon. Thomas W. Putnam, at that time minister to Spain, but also by delegates thoroughly familiar by long experience with our patent system. These delegates were Mr. Forbes, a member of this commission, and Mr. F. A. Seely, at that time an official of the United States Patent Office, and since deceased. The report of these delegates is found in the appendix.<sup>2</sup>

At the conference held under the Convention at Brussels in December, 1897, the United States was represented by Hon. Bellamy Storer, United States minister to Belgium, and by Mr. Forbes. The report of the delegates is annexed hereto.<sup>3</sup>

#### ADVANTAGES SECURED THROUGH THE CONVENTION.

While it must be admitted that the Convention as it stands to-day does not call for full reciprocity in patent matters, does not require the foreign nations which are parties to it to extend the same privileges to citizens of the United States which are extended by our laws to foreigners, and has not led to doing away with some of the requirements of foreign patent laws which have seemed exceedingly onerous to our citizens who have sought to protect their inventions in foreign countries, it can not be questioned that it secures for our citizens important advantages, the value of which is bound to be more fully appreciated as the rapidly growing foreign market for our manufactures and inventions develops.

Some of the advantages in reference to patents secured to our citizens by this Convention as originally adopted are pointed out in the

<sup>1</sup> Appendix, Chap. VIII, sec. 3, p. 243.

<sup>2</sup> Appendix, Chap. VIII, sec. 4, p. 245.

<sup>3</sup> Appendix, Chap. V, p. 192.

report of the Hon. James O. Putnam, before referred to.<sup>1</sup> It is important to consider the advantages secured to our citizens by the Convention as it stands to-day.

#### EQUAL RIGHTS TO FOREIGN AND DOMESTIC INVENTORS.

First of these to be considered is the provision of articles 2 and 3, by which the subjects or citizens of one country shall enjoy in all the other countries of the Union all the advantages with respect to protection for their inventions which are accorded to subjects or citizens of those countries.<sup>2</sup> Citizens of the United States under these articles are assured the same facilities for taking out patents, and the same protection for their patented inventions, in Belgium, Brazil, Denmark, France, and the other countries of the Union, that subjects or citizens of those countries have under their respective laws. In other words, it is provided that there shall be in the countries belonging to the Union no discrimination against subjects or citizens of other countries of the Union in the matter of patents.

#### PRIORITY UNDER THE CONVENTION.

The second provision of the Convention to be noticed, and one which may be of very great advantage to those of our citizens who desire to secure patents in foreign countries for their inventions, is that contained in article 4, and relates to the so called "delay of priority," or "period of priority."<sup>3</sup>

The laws of the more important foreign countries as they stood prior to the conclusion of the International Convention and as, for the most part, they stand to-day, so far as the subjects or citizens of other countries not parties to the International Convention or other special conventions or treaties on the subject are concerned, preclude the grant of a valid patent for an invention which has, prior to the date of filing of the application, been described in a printed publication either official or unofficial, which is accessible to the public in the country in which the application for patent is made. The law of France is even more stringent in this matter, providing that publication of a description of the invention *in any country* even a day before the filing of the application in France invalidates the patent granted on such application. The law of Portugal is equally stringent, and the laws of Austria, Denmark, Germany, Hungary, and Japan appear to be the same.

While in some of these countries it is provided that patents may be granted for inventions previously patented in other countries, such patents are not only limited to expire with the prior patents in other countries, but can be held valid only in case the prior patents granted in other countries were either secret patents or were not published before the filing of the application or were not published in full or otherwise than by title or by abstract insufficient to fully disclose the invention. Such publication of the invention as is made in this country immediately upon the issue of the patent, both by abstract in the Official Gazette and in full in the printed copies of patents, would, if prior to the application, certainly if sufficiently prior to have reached

<sup>1</sup>Appendix, Chap. VIII, sec. 2, p. 235.

<sup>2</sup>Appendix, Chap. II, sec. 1, p. 146.

<sup>3</sup>Appendix, Chap. II, sec. 1, p. 146.

the country in which the application is made, invalidate the patent granted on that application.

Any public use of an invention, in any other country than the United States, prior to the filing of an application therein for a patent is absolutely fatal to the validity of the patent granted on that application. In no European country is any exception to this rule permitted, except as provided for by the International Convention or other conventions having similar provisions. In the United States prior publication in a printed publication or prior use of the invention in public, provided the publication or use is not more than two years prior to the application, is not a bar to the grant of a valid patent for the invention, but such a rule is unknown in any European country. But in those countries which are parties to the International Convention, provided application for patent is filed within seven months of the date of application in this country, valid patents may be granted, notwithstanding publication of the invention in this country or abroad if subsequent to the filing of the application here, and notwithstanding its working (*exploitation*) by a third party in this country or abroad, even in the country in which the patent is sought.<sup>1</sup> The amendment adopted at Brussels (not yet ratified) strikes out the words "by a third party."

While this period of seven months may seem short, it gives an inventor who considers that his invention may be of value in foreign countries an opportunity to determine whether or not he will find a market for his invention in any of these countries before going to the expense of applying for patents there. If this "delay of priority" can be extended to one year, as has been proposed and is strongly urged,<sup>2</sup> its value to our inventors will be very greatly increased and will be an advantage of very great importance.

#### IMPORTATION OF PATENTED ARTICLES.

Another provision of the Convention of great importance is contained in article 5, which provides that—

The introduction by the patentee into countries where the patent has been granted of articles manufactured in any other of the States of the Union shall not entail forfeiture.

The patentee, however, shall be subject to the obligation of working his patent conformably to the laws of the country into which he has introduced the patented article.

Prior to the adhesion of the United States to the International Convention an American inventor who had secured a valid patent in France or Tunis was not only required, in order to keep his patent in force, to satisfy the requirements of the laws of those countries as to working the invention there within two years of the grant of the patent, but was not permitted even during that two years to import into the country so much as a single article embodying the patented invention manufactured in this country, unless by consent of the Government, without forfeiting his patent. Under the Convention the American inventor who has secured a patent in either of these countries may send into the country during the two years following the grant of the patent articles embodying the invention manufactured in this country or in

<sup>1</sup>Appendix, Chap. XI, p. 269.

<sup>2</sup>Appendix, Chap. V, p. 192.



any other country without forfeiting his patent. This privilege is of very great importance, as it gives an opportunity for an inventor to ascertain by a practical test whether there is a sufficient market in that country for his invention before going to the expense of such establishment as may be necessary to manufacture the invention within the country. And even after such steps have been taken to manufacture the invention on a commercial scale within the country or the requirements respecting working have been otherwise satisfied, the privilege of importing articles embodying the invention is still of material importance.

#### INDEPENDENCE OF PATENTS.

Of special importance is the provision contained in the amendment to article 4, adopted at the recent conference at Brussels,<sup>1</sup> not yet ratified. It provides that patents granted in the different countries for the same invention shall be independent; that is, shall not be limited in terms by the term of any patent previously taken out in another country and shall not be made void by the forfeiture of a patent in another country. Prior to the act of March 3, 1897, a patent granted in the United States on an invention previously patented abroad was required to be limited to expire with the foreign patent.<sup>2</sup> The same provision is found in the laws of many foreign countries, and in certain countries the patent granted on an invention which has been previously patented in other countries becomes forfeited if in any of the other countries the patent ceases to be in force. Under the present law of the United States<sup>3</sup> patents are granted for the full term of seventeen years, whether the invention patented has been previously patented abroad or not. This amendment to the Convention is directly in line with the change in our law.

Without this provision of the Convention it might become necessary for an inventor, who out of abundant caution had taken out a patent on his invention in each of a half dozen or more countries, in one or two of which the invention might prove of great value, while in the others it might for various reasons prove of little value, to pay the heavy annual taxes in every one of these countries and satisfy the requirements as to working in order to prevent the forfeiture of his patents in the countries in which his invention was of value. The dependence of a patent in one country assigned, it may be, to a citizen of that country, upon the continued existence of a patent for the same invention in another country and under the control of some other person, obviously could not but render property in a patent right most uncertain. To have done away with this serious difficulty is a long step forward.

#### RECAPITULATION OF ADVANTAGES SECURED BY THE CONVENTION.

The advantage to our citizens in the matter of patents directly afforded by the convention may be thus recapitulated:

First. The enjoyment in foreign countries of equal rights with subjects or citizens of those countries.

<sup>1</sup> Appendix, Chap. III, sec. 1, p. 182.

<sup>2</sup> Sec. 4887, Rev. Stat.

<sup>3</sup> Act of March 3, 1897.

Second. The "delay of priority" of seven months within which to file applications abroad after filing in this country.

Third. The privilege of introducing articles embodying the invention manufactured in this country into foreign countries to a certain extent without thereby causing the forfeiture of the patents taken out there.

To these advantages will be added, when the amendment above referred to as adopted at Brussels is ratified, the very important advantage that patents taken out in different countries will be independent of each other.

It may be true of some of the countries which are members of the Union that they do not carry out the terms of the Convention to the full extent which our interpretation of its terms requires, as in the case of the United States, still we may fairly say that they seem to be generally enforced, as shown by the laws of these countries.<sup>1</sup>

#### PROGRESS IN INTERNATIONAL AGREEMENT AS TO PATENTS SINCE THE CONVENTION.

Since the adoption of the Convention, those interested in patent matters in the various countries, both those which are parties to the Convention and some of those which are not (for at all of these conferences representatives of countries not now in the Union have been in attendance),<sup>2</sup> have been brought more closely in touch and have taken more liberal views of the rights of the inventor and the desirability in the interest of the public of affording him adequate protection for his invention.

As an indication of the interest in patents and trademarks from an international standpoint which has been aroused it should be noted that since the Convention was concluded similar conventions, providing for even longer periods of priority, have been concluded between certain South American countries (conventions of Montevideo, 1889);<sup>3</sup> between Germany and Austria-Hungary, 1891;<sup>4</sup> Germany and Italy, 1892;<sup>5</sup> and Germany and Switzerland, 1892<sup>6</sup>.

#### MODIFICATION OF REQUIREMENTS AS TO WORKING.

This progress has been most marked in the modification of the requirement for working, which is a feature of most European laws. This requirement has been regarded as a great hardship by our citizens who take out patents abroad. The time limit within which the invention must be worked, that is, manufacturing carried on to an extent sufficient to satisfy the various governments, varied prior to the Convention in different countries, from one year in Austria, Denmark, and Spain, to two or three years in other countries. In Denmark, working was required to be continuous. In Austria and Denmark, the term has now been extended to three years, and this is now the term in nearly all of the countries which require working. The extension of the term is a material advantage in that it permits the inventor

<sup>1</sup> Appendix, Chap. XI., p. 269.

<sup>2</sup> Appendix, Chap. V., p. 192.

<sup>3</sup> Appendix, Chap. IX, secs. 1 and 2, p. 254.

<sup>4</sup> Appendix, Chap. IX, sec. 3, p. 256.

<sup>5</sup> Appendix, Chap. IX, sec. 4, p. 258.

<sup>6</sup> Appendix, Chap. IX, sec. 4, p. 258.

a reasonable time within which to dispose of his rights before incurring the expense of working.<sup>1</sup>

#### CHANGES IN PATENT LAWS SINCE THE ADOPTION OF THE CONVENTION.

It is not too much to say that nearly every foreign country of industrial importance, unless indeed its earlier laws were comparatively liberal, has within the last fifteen years wholly rewritten its patent laws on broader lines and in the direction of far greater liberality than was before considered possible.

The Austrian law of 1852 did not provide for preliminary examination as to novelty, nor for the publishing of patents granted. On request, patent specifications were preserved in secrecy. Inventions were required to be worked within one year.

The present law of 1897 provides for preliminary examination, for the printing of patents issued, and extends the term within which the invention should be worked to three years.

Denmark had no patent law prior to the present law of 1894. Patents were granted by the crown, but were for terms of but three to ten years; in special cases only, for fifteen years; in no case to foreigners for more than five years. Patents were forfeited if the inventions were not worked within one year and worked continuously thereafter.

The present law provides for preliminary examination, recognizes the inventor, whether a Danish subject or a foreigner, as the one to whom or in whose interest the patent should be granted, provides for the grant of patents for fifteen years in all cases, and extends the term for working to three years. It also provides for giving full force and effect to the provisions of the International Convention.

Mexico, prior to 1890, granted patents for but ten years, and limited patents for improvements to six years. Patented inventions were required to be worked within two years. Under the present law patents are granted for twenty years, and do not lapse for nonworking.

In Norway there was no patent law prior to 1885, though under a royal decree of 1839 patents for a limited term, not to exceed ten years, could be granted. Patents were granted to foreigners only on condition of their becoming citizens of Norway, and the inventions were required to be worked within two years.

Under the present law patents are granted for fifteen years, there is no discrimination against foreign inventors, the law provides for preliminary examination as to novelty, and three years is allowed for working.

Russia, prior to the present law of 1896, granted patents for but three, five, or ten years, and required the invention to be worked within not exceeding one-fourth of the term for which the patent was granted. The term for which patents are now granted in Russia is fifteen years, and five years is allowed for working.

In Sweden, under the law of 1819, foreigners were not permitted to obtain patents. The law of 1834 permitted foreigners to take out patents on condition of establishing domicile in Sweden within a year or assigning the patent to a Swedish subject. The law of 1856 modified this condition, foreigners being permitted to take out patents on condition of appointing a representative in the country.

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<sup>1</sup> Appendix, Chap. V., p. 192.



The present law of 1884, as modified in 1893, 1897, and 1898, provides for giving full force and effect to the requirements of the International Convention and is in full accord with the spirit of the Convention. Under it there is no discrimination against foreign inventors. The system of preliminary examination is provided for, and while working is still required, a patent granted for an invention previously patented in another country is not forfeited for failure to work the invention in Sweden, provided the requirements as to working in the country of origin are satisfied.

Switzerland had no general patent law prior to 1888, though prior to that year certain Cantons had made some provision for the protection of inventions. The present law is in most respects an excellent one, intended to give full force and effect to the requirements of the International Convention. It does not, however, permit patents to be granted for inventions for chemical or other processes or for chemical products.

#### DATE OF ADOPTION OF PATENT LAWS AT PRESENT IN FORCE.

The date of adoption of the patent laws at present in force in the principal countries of industrial importance is significant of the attention which is being given in recent years to the question of patents throughout the world and of the general recognition by the more progressive nations of the importance of adopting laws more liberal toward the inventor than those formerly in force.

*Austria.*—Law of January 11, 1897. This law is in substantial harmony with the spirit of the International Convention, though Austria is not a member of the International Union.

*Belgium.*—Law of May 24, 1854, amended March 27, 1857, and July 5, 1884. This law is a liberal one, providing for the grant of patents to foreigners under the same conditions as to subjects for a term of twenty years and under fair conditions as to working. The requirements of the International Convention are given full force and effect.

*Brazil.*—Law of October 14, 1882. At the date of the adoption of this law the International Convention, though not formerly concluded, was under consideration, and the law is so drawn as to give effect to its provisions.<sup>1</sup>

*Canada.*—Law of 1872, amended July 9, 1892, and April 1, 1893. This law is in a number of important particulars substantially identical with the United States patent law.

*Denmark.*—Law of April 13, 1894. This law resembles in many respects the German law of 1891, but is drawn with special reference to giving effect to the provisions of the International Convention, to which Denmark became a party soon after the adoption of this law.<sup>2</sup>

*Finland.*—Law of March 30, 1894. While Finland is not a party to the International Convention, the influence of the Convention is plainly apparent from the very liberal provisions of this law.

*France.*—July 5, 1844, amended May 23, 1856, and May 23, 1868. While this law has not been substantially modified, and is in full force in all its requirements, which are most stringent, especially as to the question of novelty, the forfeiture of a patent for importation of articles embodying the invention manufactured in a foreign country and the requirement as to working, so far as subjects or citizens of countries not parties to the International Convention are concerned, it does not apply in any matter in which it is not in harmony with the requirements of the International Convention to those entitled to claim the privileges thereof.

*Germany.*—Law of April 7, 1891. This law, with the law of 1877, for which it is a substitute, is largely based on the United States patent law, though it contains a requirement for working and other requirements not found in the United States law.

<sup>1</sup>Appendix, Chap. XI, sec. 1, (a), p. 269. <sup>2</sup>Appendix, Chap. XI, sec. 3, (a), p. 270.

Germany, though not a party to the International Convention, is a party to similar conventions with certain European countries, the provisions of which are even more liberal as regards the delay of priority than the International Convention, and full force and effect are given to these conventions.<sup>1</sup>

*Great Britain.*—Statute of monopolies of 1623, law of August 25, 1883, amended June 25, 1886, and December 24, 1888. Under this law the provisions of the International Convention, so far as they relate to patents, are given full force and effect.<sup>2</sup>

*Hungary.*—Law of July 14, 1895. This law is in substantial harmony with the spirit of the International Convention.

*Italy.*—Law of October 30, 1859, amended January 31, 1864, and January 16, 1898. This law, like that of Belgium, though not of recent date, is liberal in its provisions. The amendment of 1898 provides expressly for carrying into effect the provisions of the International Convention as regards priority, though prior to that law the provisions of the Convention had been given full force and effect.<sup>3</sup>

*Japan.*—Law of March 1, 1899. This law is drawn with especial regard to the provisions of the International Convention, to which Japan has since its adoption become a party, and was evidently prepared after a thorough study of the patent laws of the United States and the principal European countries.<sup>4</sup>

*Luxemburg.*—Law of June 10, 1880.

*Mexico.*—Law of June 7, 1890, amended June 22, 1896. This law is in most respects a liberal one, embodying many of the provisions found in the International Convention, the influence of which is apparent. The amendment of 1896 does away with the requirement of working.<sup>5</sup>

*Norway.*—Law of June 16, 1885. This law in many respects follows the German patent law. It provides for giving full force and effect to the provisions of the International Convention, to which Norway became a party shortly after the passage of the law.<sup>6</sup>

*Portugal.*—Law of December 15, 1894, amended and finally adopted May 21, 1896. This law is evidently drawn with especial regard to both the letter and the spirit of the International Convention, to the provisions of which it gives full force and effect.<sup>7</sup>

*Russia.*—Law of May 20—June 1, 1896. This law is much more liberal than earlier laws.

*Spain.*—Law of July 30, 1878. The provisions of the International Convention are given full force and effect in Spain.

*Sweden.*—Law of May 16, 1884, amended June 12, 1891, April 14, 1893, March 26, 1897, May 28, 1897, and May 27, 1898. This law, though largely based on the German patent law, was drawn with special regard to the provisions of the International Convention, to which Sweden became a party in 1885. The later amendments to the law are in the direction of greater liberality toward inventors, particularly foreign inventors, than is required even by the International Convention.<sup>8</sup>

*Switzerland.*—Law of June 29, 1888, amended March 13, 1893. Though Switzerland was one of the original parties to the International Convention, no patent law was adopted until 1888. The law is a liberal one in most respects, though it provides for the grant of patents only for inventions which can be represented by models, thereby excluding from protection inventions relating to chemical processes. It is drawn with special reference to the provisions of the International Convention and gives full force and effect to those provisions.<sup>9</sup>

Of these twenty countries all but five have either wholly rewritten or materially modified their patent laws since the conclusion of the International Convention, and in those countries which are parties to the International Convention and have not modified their patent laws since its conclusion, the Convention is recognized as having the effect of law.

It is, however, to be noted that of the countries which are parties to the International Convention, two in Europe, the Netherlands and Serbia, have at the present time no patent laws, and the Dominican Republic also has none.

<sup>1</sup>Appendix, Chap. IX, sec. 3, sec. 4, p. 256.

<sup>2</sup>Appendix, Chap. XI, sec. 5, p. 273.

<sup>3</sup>Appendix, Chap. XI, sec. 7, p. 275.

<sup>4</sup>Appendix, Chap. XI, sec. 8, p. 275.

<sup>5</sup>Appendix, Chap. XI, sec. 13 (a), p. 280.

<sup>6</sup>Appendix, Chap. XI, sec. 14 (a), p. 281.

<sup>7</sup>Appendix, Chap. XI, sec. 15, p. 281.

<sup>8</sup>Appendix, Chap. XI, sec. 19 (a), p. 285.

<sup>9</sup>Appendix, Chap. XI, sec. 20, p. 286.



## EXAMINATION OF CONVENTION IN DETAIL.

The Attorney-General of the United States in 1889 expressed the opinion (47 Official Gazette, 398, Opinions of Attorney-General, vol. 19, 273)<sup>1</sup> that the International Convention, in so far as the agreements therein contained are not in accordance with the present laws of the United States, is without force and effect; that it is not self-executing, but requires legislation to render it effective for the modification of existing laws; and while this opinion has no other effect than the creation of a rule of departmental practice and is not binding upon the courts, it is our opinion that such legislation should be adopted as shall definitely and positively provide for carrying into effect the requirements of the Convention.

Examining the Convention in detail, in connection with the statutes of the United States relating to patents for the purpose of determining what legislation is necessary to carry its requirements into effect in good faith, we find:

## ARTICLE I OF CONVENTION.

Article I of the Convention contains an enumeration of the States which "have constituted themselves into a state of Union for the protection of industrial property," and is to be read in connection with the first section of the *final protocol* to the Convention, viz:

(1) The words *industrial property* are to be understood in their widest acceptation, in the sense that they apply not only to the productions of industry properly so called, but equally to the productions of agriculture (wines, grains, fruits, cattle, etc.) and to mineral productions used in commerce (mineral waters, etc.).

## ARTICLE II OF CONVENTION.

The subjects or citizens of each of the contracting States shall enjoy, in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterwards accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.

This article is to be read with sections 2 and 3 of the *final protocol*, which are as follows:

(2) Under the name *patents of invention* are included the various classes of industrial patents granted by the laws of the contracting States, such as patents of importation, patents of improvement, etc.

(3) It is understood that the final provision of article 2 of the convention shall in no respect infringe upon the laws of each of the contracting States, so far as concerns the procedure before the courts and the competence of the said courts.

1. Article II clearly has no bearing on the organization of the offices in which applications for patents are filed; and therefore the provisions of the United States laws in regard to the organization of the United States Patent Office need not here be considered.

2. Sections 4883 to 4891, inclusive, 4893 to 4895, inclusive, and 4897 of the Revised Statutes, which provide for the manner of the grant of a patent, to whom a patent can be granted, and for what subject-matter, and set forth the prerequisites to the grant, make no distinction between citizens of the United States and subjects or citizens of foreign coun-

<sup>1</sup> Appendix, Chap. X, p. 265.

tries, giving to foreign inventors, so far as the requirements contained therein are concerned, all the privileges which are given to our own citizens. These sections, therefore, need no amendment in view of Article II of the convention.

3. Section 4892, while permitting an applicant to make oath to his application before any person within the United States authorized by law to administer oaths, requires an applicant residing in a foreign country to make such oath before a United States officer or notary public. While, strictly speaking, this section does not in terms discriminate between citizens of the United States and subjects or citizens of foreign countries, in its practical working a seemingly necessary and unintended hardship does result to foreign inventors from the fact that in a number of foreign countries the notaries public are not authorized to administer the oath to the applicant. As a result, applicants are in some cases put to the expense of considerable journeys to appear before a United States officer. It is also a matter of doubt whether in some of these countries the oath taken by a subject or citizen before a United States officer has by the laws of these countries any validity. To provide that the oath may be taken in foreign countries before any judge or magistrate authorized by law to administer an oath and having an official seal could not in any way prejudice the rights of any American citizen and would relieve foreigners of a requirement which has sometimes proved onerous.

Such a change would be in the spirit of the Convention, and we recommend that it be made.

#### FOREIGN EXECUTORS AND ADMINISTRATORS.

4. Section 4896, which provides for an application for patent by the executor or administrator of a deceased inventor, does not in terms discriminate against subjects or citizens of foreign countries. This section is as follows:

SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

The Patent Office has, however, by the decision of the Commissioner in *ex parte* Ransom, C. D., 1870, refused to recognize under this section of the statutes an executor or administrator unless authorized to act by a probate court located in the United States. As a result of this ruling it has been necessary in case of the death of a foreign inventor for an administrator to be appointed under ancillary letters from some probate court in this country. The expense of this proceeding is necessarily considerable. In practically all of these cases, the only estate in this country to be administered upon consists of the right of applying for a patent. Until the act of March 3, 1897, went into effect, the time within which an application for a patent on an invention made by a foreigner for which an application had been previously filed in a foreign country could be filed was not limited unless the invention had been in public use or on sale in the United States, in which case it was necessarily filed within two years from the beginning



of such use or sale. There was therefore ample time within which to take out ancillary letters in this country and to make application in the name of the administrator authorized to act under such letters. As the law now stands an application for patent for an invention for which a foreign patent has been granted must be filed within seven months from the date of the application on which such foreign patent was granted. Circumstances may, and in fact do, arise which render it impossible for the ancillary letters to be issued prior to the expiration of this term of seven months, with the result that the right to a patent in this country is lost.

It is not believed that it was intended by Congress to prevent by such a requirement the grant of a patent to the executors or administrators of a deceased inventor, even though he were a subject or citizen of a foreign country. Such a discrimination, whether or not it arises from the direct requirements of the law, is not in harmony with the spirit of the Convention.

We therefore recommend that this section be amended so as to expressly authorize the filing of an application by an executor or an administrator authorized by the law of the domicile of the inventor to administer upon his estate, whether such inventor was domiciled in the United States or in a foreign country.

5. Section 4898, which provides for an assignment of a patent; section 4899, for the protection of purchasers from the inventor before application; and sections 4900 and 4901, for the marking of patented articles and a penalty for wrongly marking, require no revision, since no distinction is made in them between citizens of the United States and foreigners.

#### CAVEATS.

6. Section 4902 provides for the filing of caveats by citizens of the United States only. The caveat is not an application for a patent, but at most merely a statement to the Government by a citizen, that he has made an invention or discovery which is not at the time matured, under which statement he is entitled to notice of an application for patent by another for the same invention, in order that he may contest the right of the latter.

This section says:

SEC. 4902. Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner, in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and models within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

It may perhaps be contended, for the reason above given, that this section is not at variance with Article II of the Convention; but we deem it for the best interest of the country that the broadest and most lib-

eral construction should be put upon the Convention, and that the right of the subjects or citizens of each of the contracting States to "enjoy in all the other States of the Union, so far as concerns patents for inventions, \* \* \* the advantages that the respective laws thereof accord \* \* \* to subjects or citizens," should be construed to mean the right to enjoy all that which precedes as well as that which succeeds the grant of the patent, notwithstanding the concluding sentence of the article, which is as follows:

In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.

If it be not so construed in foreign countries, the citizens of the United States might possibly be cut off from the right to take the necessary steps preliminary to applying for a patent, and, consequently, never obtain a patent, and still the obligations of the Convention be regarded as fulfilled, since the laws of other countries might still give the same protection to our citizens in regard to patents as to their own citizens; but the law would be, nevertheless, construed in such a way as to prevent our citizens from obtaining patents.

With this understanding of the meaning of the Convention, it is clear that the United States is in good faith bound to so amend the law that foreigners entitled to the privileges of the Convention shall, in respect to the filing of caveats, be placed on the same footing with our own citizens. This may be done in either of two ways, one of which is to remove from the statute the words by which it is restricted in its application, to citizens of the United States. If such amendment should be made, it should be provided that foreigners filing caveats appoint an agent in the United States, on whom notices may be served, so that unnecessary delays may be avoided.

The second way in which the requirements of the Convention may be satisfied, and this is, in our opinion, the better way, is to repeal the statute providing for the filing of the caveats.

The very general opinion of those most familiar with patent practice, as expressed to us, is that the caveat is practically of no use to inventors. Many attorneys of long experience in patent matters have assured us that they always advise their clients not to file caveats. The preparation of a caveat, if it be prepared with care and skill, involves considerable expense, hardly less than the preparation of an application. The filing of a caveat necessarily implies the subsequent filing of an application, with the result that the inventor is put to practically a double expense without practical advantage.

If foreigners are permitted to file caveats, as it would seem must be done if our citizens are permitted to do so, the result will be the introduction of a class of evidence which has always been considered open to very serious objection, and has never been permitted to be introduced in any proceeding before the Patent Office, or before the courts in patent matters—namely, evidence of acts performed in a foreign country. If foreigners are permitted to establish conception of an invention in a foreign country by filing a caveat—and a caveat has practically no other effect than that of establishing conception of the invention described therein on the date on which it is filed—it would seem to be necessary to permit evidence to be introduced of the reduction of the invention to practice, as by construction of a machine, in the foreign country.



We are clearly of the opinion that the statute providing for the filing of caveats should be repealed.

7. Section 4903 is merely a matter of official requirement of notice of rejection, and, being general in its character, that is, applicable to citizens or subjects of all nations, requires no revision.

8. Sections 4904 and 4908 provide for determining which one of several applicants for a patent for the same invention is entitled to a patent. No distinction is made in the statute between citizens of the United States and foreigners and, therefore, these sections do not require amendment, unless it be to change a rule of evidence as to the effect of foreign applications. This will be considered when Article IV of the Convention is reached.

9. Sections 4909 to 4914, inclusive, provide for various appeals from primary examiners to the examiners-in-chief, to the Commissioner of Patents, and to the supreme court of the District of Columbia, but the proceedings are equally open to citizens and foreigners in all respects, and these sections do not require revision.

10. Section 4915, providing for a suit in equity to obtain the grant of a patent; section 4916, for a reissue of a defective patent; section 4917, for a disclaimer; and section 4918, for a suit to determine the question of rightfulness of grant between two conflicting patent grants are open to citizens and foreigners alike and, therefore, do not need amendment.

11. Sections 4919 to 4923, inclusive, refer to procedure in the courts for the suppression of infringements and the recovery of damages for past infringements. The remedies provided for under these sections are open to all patentees or owners of patents whether citizens of the United States or foreigners. No discrimination is made against foreigners in these sections and for the purpose here considered they need no amendment.

12. Sections 4924 to 4928, inclusive, providing for extension of patents granted prior to March 2, 1861, are now obsolete.

13. Sections 4929 to 4933, inclusive, providing for the grant of patents for designs are not restricted in their scope to any nationality.

14. Sections 4934 to 4936, inclusive, which state the fees required in connection with patents, apply equally to citizens and foreigners and need no amendment.

#### ARTICLE III OF CONVENTION.

Article III of the Convention "assimilates" subjects or citizens of States not forming part of the Union for the Protection of Industrial Property in certain cases to the subjects or citizens of the contracting States, and as both such classes of persons are treated alike under our laws, need not be further considered except in connection with Article IV below.

#### ARTICLE IV OF CONVENTION.

Article IV of the Convention reads as follows:

Any one who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods can not be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working by a third party, by the sale of copies of the design or model, by the employment of the mark.

The periods of priority above mentioned shall be six months for patents of invention and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the seas.

It is unnecessary to go over the separate sections of the statute again in connection with this article.

Article IV is in substance an agreement that after the filing of an application for a patent in one of the countries of the Union created by the Convention, the applicant shall have a reasonable time within which to make application in the other countries of the Union without the risk of preventing the grant of valid patents to him in these other countries by premature publication of his invention, or other acts by which knowledge of the invention might be disclosed in such other countries in advance of the actual filing of his application there. Such matters happening either before or after the period of priority are unaffected by the Convention. This period of time is made in certain cases six months and in others seven months. It is similar in many respects to the two years' period allowed to the inventor by section 4886 of the Revised Statutes, since the patent afterwards granted to him in the United States can not be invalidated "by publication of the invention or its working by a third party," or even by the inventor himself during said period if the amendment striking out "third party," adopted at the Brussels conference, is ratified.

What the effect of the application will be, and whether or not it must disclose, as filed, a patentable invention in sufficiently full and clear terms to warrant the grant of a patent, is not specified in the Convention. It is only agreed that acts done by a third party in the specified period subsequent to its filing shall be without effect upon applications for patent filed in other countries before the expiration of that period.

There is nothing in the letter or the spirit of the Convention to require the United States to give to the application in any respect except its date any standing to which it would not be entitled if filed by a citizen of the United States. Necessarily, in order to be given the advantage of the date of the foreign application, the application filed here must correspond in all substantial particulars with the foreign application; that is, it must be for the invention disclosed in the foreign application. Nothing in the nature of new matter or unwarrantable expansion of the disclosure of the invention in the original application can be permitted.

If the prior foreign application fails to disclose the invention disclosed in the application filed here, it can not serve as a basis for the claims of priority under the Convention.

The sufficiency of the disclosure and the novelty and patentability of the invention as found in the foreign application must be decided in accordance with existing laws, precisely as in a case of a like application filed by a citizen of the United States. We are, therefore, of the opinion that an amendment to the law should be made, providing that the foreign application shall have, in case an application is filed in this country by the applicant abroad within the specified period, the same effect as if filed here on the day it was filed abroad.



Section 4887 of the Revised Statutes, as amended by the act of March 3, 1897, is not in harmony with Article IV of the Convention. The section is as follows:

SEC. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, in which case no patent shall be granted in this country.

The effect of this section, as amended, is to subject the inventor who has merely made application for and received a patent in a foreign country to more severe conditions than are enforced against the inventor who, without applying for a patent, has disclosed his invention to the public in a printed publication. The inventor who has applied for and received a patent abroad must, under this section, be refused a patent in this country if he does not apply here within *seven months* from the date of his application abroad. The inventor who has disclosed his invention to the public in a printed publication is not refused a patent here if he filed his application at any time within *two years*. The foreign inventor who puts his invention in public use abroad, provided it has not been on sale or in public use in the United States for more than two years and has not been disclosed in a printed publication for more than two years, may apply at any time for a patent in this country and may receive a valid patent.

It is generally recognized that the only ground for refusal of a patent for an invention, which, at the date of its invention was new and patentable, is that before application is made the invention had been so disclosed to the public that it had by presumption of law ceased to be the exclusive property of the inventor, and as the filing of an application for patent in this or any other country is not in itself a disclosure of the invention, applications being generally kept secret in this country until actual issuance of the patent, and in other countries during at least a portion of the period intervening between the filing of the application and the grant of the patent, it seems clear that no presumption of dedication to the public or abandonment of his rights by the inventor can arise from the mere filing of an application.

It, therefore, appears that this section discriminates without good reason against the inventor who has merely filed his application abroad. So far from being in accordance with the Convention, this section is not only contrary to its spirit, but introduces into the United States law, which has heretofore been justly considered the most liberal patent law in the world, a ground for rejection not recognized by any European country, even by those whose laws are most stringent as to the requirement of absolute novelty.

If foreign countries were to adopt such a provision as is contained in this section, making it obligatory upon American inventors to apply for patents abroad within seven months from the date of filing of their applications here, our inventors would be deprived of the benefit of the preliminary examination here and would be compelled to file their applications abroad in an incomplete and unsatisfactory form. The result would be that inventors would often be subjected unnecessarily to great expense, or would fail to secure valid patents abroad. This is precisely the effect which this section has upon foreign inventors,



particularly those who first file their applications in a country in which applications are subjected to preliminary examination.

For instance, an application is filed in Germany. It is seldom that the examination is completed there for eight months. The German inventor must, therefore, either file his application here before the novelty of his invention has been ascertained through the examination made by the German patent office, or must depend upon getting his application patented in this country within a few weeks of its filing in this country—practically an impossibility.

We may also call attention to the fact that under the laws of most foreign countries the first to apply for a patent is the one to whom it is granted. The Convention has created an exception to the rule and made an application in any State of the Union for the Protection of Industrial Property of the same effect as an application in the country where an application is subsequently made within the time specified as a period of priority. For example, one who first applied for a patent for an invention in Great Britain would be entitled to it unless someone had applied for a patent for the same invention in the United States prior thereto, and in that case, if the citizen of the United States should apply for a patent under the Convention, claiming the date of his United States application, he, and not the British subject, would receive the patent. This has actually happened in practice.

It has been suggested that section 4887 may be made the basis of reciprocity with countries which do not grant patents for product inventions.

It has also been suggested that the section be repealed.

We recommend that section 4887, as amended March 3, 1897, be so amended that the application for patent in a foreign country shall not be a bar to the grant of a patent to the same applicant in this country.

#### ARTICLE V OF THE CONVENTION.

Article V of the Convention provides that patents shall not be forfeited by reason of importation of the articles covered by the patent. Forfeiture for this cause has never been a requirement of the United States laws, and no change in the law is needed to carry this provision of the Convention into effect.

#### OTHER ARTICLES OF THE CONVENTION.

Articles VI, VII, VIII, IX, and X of the Convention relate to trademarks and commercial names and will be considered later with reference to the trademark law.

Article XI requires that temporary protection be accorded to inventions which may be exhibited at international exhibitions. The purpose of this requirement is to permit exhibitors to patent their inventions, notwithstanding an exhibition of them which would in certain countries amount to such a disclosure as would bar the grant of a valid patent. As by the United States law public use of an invention, if not more than two years prior to the filing of the application therefor, is not a bar to the grant of a valid patent it is clear that the exhibition of an invention during the few months during which international expositions usually last would not prevent the grant of a patent on an application filed within a reasonable time. The present law gives full effect to this article and no change in the law is required by it.

Article XII of the Convention relates to establishing a special service for industrial property and a central depot for giving information to the public, etc. The Patent Office, as it has existed in the United States since long prior to the Convention, in all respects satisfies the requirements of this article and no further legislation on this matter is needed.

Article XIII of the Convention relates to the establishment of the international bureau and the provision for its support. The obligation resting on the United States in this matter has been met by including in the annual appropriation acts a provision for the payment of the necessary amount.

The remaining articles of the Convention relate to revision of the Convention, the adherence of new States, and other matters which do not affect the present inquiry.

#### THE TREATY WITH JAPAN.

The treaty with Japan,<sup>1</sup> so far as it relates to patents, does not make necessary any change in existing law, except in the matter of caveats. Under the treaty subjects of Japan are entitled equally with our own citizens to file caveats, and section 4902 of the Revised Statutes should be amended to permit them to do so if that section of the statutes is to remain in force.

#### CHANGES REQUIRED IN THE LAWS OF THE UNITED STATES TO GIVE FULL EFFECT TO THE CONVENTION.

From this consideration of the Convention and treaties to which the United States is a party and of the present laws of the United States relating to patents it appears that the following changes are necessary in order to give full force and effect to the agreements which have been entered into:

First. The application for a patent filed within seven<sup>2</sup> months of the filing of an application for a patent for the same invention in any foreign country which is a party to the International Convention should be given the same force as regards the question of priority that it would have if filed on the date on which the foreign application was filed.

Second. Subjects or citizens of countries which are parties to the International Convention and subjects of Japan should be permitted to file caveats if the law providing for the filing of caveats is to remain in force.

These changes are required by the letter and spirit of the International Convention and the treaty with Japan.

Third. Executors or administrators authorized under the law of the domicile of the deceased inventor to administer upon his estate should be permitted to make application and receive the patent for such invention.

Fourth. Applicants located in foreign countries should be permitted to make the affidavit required by law before any judge or magistrate authorized to administer oaths of the country in which they may be.

These changes are, in our opinion, in accord with the spirit of the Convention, and should be made in order to relieve foreign applicants from requirements which impose hardships upon them and are not absolutely necessary.

<sup>1</sup> Appendix, Chap. XVIII, sec. 9, p. 332.

<sup>2</sup> Extended to twelve months.

## THE PATENT LAWS OF FOREIGN COUNTRIES.

We have carefully considered the patent laws of foreign nations and compared their essential features with those of the United States law with a view to determining what provisions of those laws, if any, are suggestive of advantageous changes in our law.

We find that no less than seventy-one of the countries of the world, including, with but one or two exceptions, every country which is considered as a part of the civilized world, have recognized the importance of encouraging the development of the liberal arts by adopting laws under which an inventor may, as a matter of right, secure protection for a limited term for any new and useful invention capable of industrial use.<sup>1</sup> Among the countries which have patent laws are included practically all English-speaking countries. Hardly a colony of Great Britain, whatever its size or importance—Hongkong as well as Canada, St. Helena as well as New South Wales and Victoria—but has its patent law. Besides the countries which have general laws providing for the grant of patents, a number of other countries protect inventions by special legislative or crown grants. Such protection is, however, hardly to be classed with the protection afforded by patents granted under a general law.<sup>1</sup> It is obviously both costly to the inventor and liable to serious abuse. It is to be classed with monopolies such as existed in England early in the seventeenth century and were found to be open to such serious objections that they were done away with by the Statute of Monopolies of 1623.

No country which has ever had a patent law, with the single exception of the Netherlands, is without a patent law to-day. Few subjects have received from legislators throughout the civilized world more careful attention in recent years than that of patent protection. As might naturally be expected, the patent laws of the different countries differ in many particulars from each other and from the United States law, though the differences are in many respects less wide than they were a comparatively few years ago.

## DIFFERENCES BETWEEN PATENT LAWS OF FOREIGN COUNTRIES AND THAT OF THE UNITED STATES.

It is hardly of importance to our present inquiry to present in detail the features of the patent legislation of the different countries. It will be sufficient to here consider those features in which foreign laws differ from the United States law which may appear to be, or which have been urged upon us as being, features in which the United States laws could be amended with benefit to the public.

## PRELIMINARY EXAMINATION OF APPLICATIONS FOR PATENT.

Perhaps the most important particular in which the United States patent law differs from the majority of foreign patent laws is in the preliminary examination. In many of the foreign countries patents are granted on application without examination into the novelty of the invention, patents being granted for inventions which are obviously old and in common use as readily as for inventions

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<sup>1</sup> Appendix, Chap. XIII, p. 292.



which are new. Necessarily the patents granted for inventions which are not new are invalid and worthless. While this system of granting patents has its earnest advocates (and it is to be said that under this system there is no opportunity for the refusal of a patent for a meritorious invention, and it is undoubtedly true that in some cases patents have been refused for meritorious and important inventions under the preliminary examination system, and it should also be said that under this system patents are granted without the delay necessary under the preliminary examination system), we are of opinion that the present laws of the United States, in so far as they provide for the examination of all applications for patent and for the grant of a patent only in case the invention is new and useful, need no change. This opinion is strengthened by the fact that the preliminary examination system on the same general plan as provided for in the United States law has so far commended itself to foreign legislators that it has been adopted in many important countries, notably Austria, Canada, Denmark, Germany, Japan, Norway, Russia, and Sweden.

In this connection should be mentioned a system which, though not in practical operation in Europe, is advocated by many jurists, viz, the combination of the registration and preliminary examination systems by issuing patents to all applicants, affixing to the patents the results of a preliminary examination such as now made in this country. It is claimed that the advantages of both systems of granting patents would thus be obtained. The inventor would not be prevented from obtaining protection for his actual invention in the terms in which he chooses to present it, and the public would be warned as to the extent of that invention by the disclosure of the state of the art.

#### THE QUESTION OF NOVELTY.

In regard to what constitutes patentable novelty, foreign patent laws generally differ widely from the United States law. Under the United States law an invention which has been disclosed to the public, and has even been in public use or on sale, may be patented, provided it is applied for within two years from the date on which it was first disclosed to the public in a printed publication or first put in public use or offered for sale. Under foreign laws generally any disclosure of the invention to the public of the country prior to the date of application for patent, whether by disclosure in a printed publication or by use in public, is sufficient to prevent the grant in the countries in which the system of preliminary examination prevails, and in countries in which patents are granted on application without such examination is fatal to the validity of the patent. The law of France is so strict in this regard that the publication in print of a description of an invention in this country the day before the application is filed in France is sufficient to invalidate the patent granted on such application.

We see no reason for changing the existing law of the United States in this regard.

#### DISTINCTION BETWEEN A PATENT AND A PRINTED PUBLICATION.

In this connection it is to be noted that under the United States law<sup>1</sup> the patenting of an invention is made the equivalent of the publication

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<sup>1</sup> Sec. 4886, Rev. Stat.

of the invention in print as a bar to the grant of a patent. In this country patenting is the equivalent of publication in print, for the reason that printed copies of patents are accessible to the public on the day of their issue. Such is not the case in many of the foreign countries. In fact, in few countries are patents published on the day of their issue. In some countries, as, for instance, Ecuador and Bolivia, the specifications of patents are preserved in secret until their expiration. In Austria up to the date at which the law of 1897 went into effect, the specifications of patents could on request be kept secret. In France the specifications of patents are by law required to be published in print only after they have been in force a year, and in fact have not been published since 1893. In other countries, as, for instance, Belgium, abstracts only are published.

The fact that patenting and publication in print are not the same thing is clearly recognized in most foreign countries. The law of France makes publication of an invention in print prior to the date of application an absolute bar to the grant of a patent, but expressly provides that an invention already patented abroad may be patented in France, the effect of such foreign patent being to limit the term of the French patent, but not to bar the grant of a valid patent. It is to be understood that such foreign patent if published in print becomes at once a publication, and as such is an absolute bar to the grant of a valid patent thereafter in France.

With the exception of Belgium, Canada, Italy, and Russia, none of the more important countries makes the previous patenting of an invention in another country, as distinguished from its publication in print, a bar to the grant of a patent, and in these countries the foreign patent is not a bar to the grant of a patent to the inventor who secured such foreign patent.

In Great Britain, Germany, Austria, Denmark, Hungary, Japan, Norway, Portugal, Sweden, and Switzerland, a valid patent may be obtained irrespective of patents previously obtained for the same invention in other countries, provided such patents have not, at the date of filing of the application, been published in print.

The United States law<sup>1</sup> makes knowledge or use of an invention by others *in this country* prior to its invention by the applicant for patent, or public use or sale *in this country* for more than two years prior to the publication, a bar to the grant of a patent, but there is nothing in the law to make prior knowledge or use of the invention in a foreign country or public use or sale in a foreign country a bar, though publication in print in any foreign country for more than two years prior to the application is by the same section of the statute made a bar to the grant of a patent. If prior knowledge or use or public use or sale in a foreign country is not under the law a bar to the grant of a patent, it seems clear that the mere issuance of a patent in a foreign country, so long as that patent is not published in print, should not be a bar.

This view is in accord with the opinion of the representatives of the countries which are parties to the International Convention, as appears from the adoption of the amendment to article 4, before referred to, which provides that patents granted in the different countries of the International Union shall be independent of patents obtained in other countries.

<sup>1</sup> Sec. 4886, Rev. Stat., as amended March 3, 1897.

PROVISION BY NONRESIDENT APPLICANTS FOR SERVICE ON THEM IN  
THE UNITED STATES.

In none of the foreign countries which have patent laws, with but a single exception (Guatemala), is it made essential that an inventor in order to be entitled to a patent shall be a subject or citizen of the country or a resident thereof. But under the patent laws of nearly all foreign countries applicants for patent are required to state their domicile, if within the country, and if not, to elect domicile at some place within the country or to appoint some person domiciled within the country to represent them in any proceedings relative to the patent.<sup>1</sup>

The purpose of this requirement is to give the courts of the country jurisdiction in any proceedings which may be brought against the owner of the patent in regard to his rights under the patent. This is of perhaps greater importance in foreign countries where the law provides for the revocation of the patent, for compelling the owner of the patent under certain circumstances to grant licenses to others to use the invention, or for the expropriation of the invention by the state, than it is in the United States. No such proceedings are provided for by the United States law, but that law provides for certain proceedings touching the right of a patentee to the patent granted to him, as, for instance, interference proceedings in the Patent Office under section 4904 of the Revised Statutes, procedure to secure a patent for an invention which may have been patented by another, under section 4915 of the Revised Statutes, and suits on interfering patents under section 4918 of the Revised Statutes, in all of which the patentee or owner of the patent must be made a party and must be duly notified of the proceedings. In case the patentee or owner of the patent is a foreigner nonresident in the United States, the difficulties in serving legal notice upon him may not only be practically insurmountable, but even if notice be served upon him, it is open to serious doubt whether so long as he remained out of the country any United States court could take jurisdiction of the matter. An amendment to the law requiring nonresident applicants to fix a place for service within the United States, i. e., a place where the leaving of process or papers shall be equivalent to personal service, or to appoint a representative resident within the United States on whom process or papers may be served with the same legal effect as if served personally on the patentee, would be in the interest of United States citizens and would not be an unreasonable requirement to demand of nonresident applicants and patentees, since it is but just that the patentee who must necessarily appeal to our courts to enforce his rights against infringers should be required to place himself constructively within the jurisdiction of our courts in order that others may have such remedies against him as may be provided for by law.

We recommend that the law be amended so as to make it obligatory upon nonresident applicants and patentees to fix a place for service in this country or appoint a representative resident here on whom service can be made.

## CLASSES OF INVENTION EXCLUDED FROM PROTECTION.

Under the United States patent law no class of useful inventions is excluded from protection. The same is true of the law of Great

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<sup>1</sup>Appendix, Chap. XIV, p 294.



Britain and the British colonies generally, but many foreign countries exclude from protection one or more classes of invention. The class of inventions which more than any other is excluded from protection is that relating to medicines. It is excluded in Germany, France, Austria-Hungary, Italy, Japan, Denmark, Norway, Sweden, Portugal, Russia, and a number of other countries. Other classes of inventions excluded from protection in many countries are foods, chemical products, and inventions relating to war material.<sup>1</sup>

The exclusion from protection of inventions relating to medicines or foods does not generally extend to those relating to processes or apparatus for their manufacture. In all foreign countries which exclude chemical products from protection, except Switzerland, inventions relating to chemical processes may be patented, and in nearly all such countries it is expressly provided by law that a patent for a chemical process by which a new chemical product is made shall in effect cover such product, unless it is shown that such product was in fact made by some other process.<sup>2</sup>

It has been urged before us, both at the hearings above referred to and in written communications laid before us, that the United States law should be amended to exclude from patent protection both medicines and chemical products generally, at least so far as such inventions are the inventions of subjects or citizens of the foreign countries which exclude these classes of invention from patent protection, and it has been contended that subjects or citizens of foreign countries should not be permitted to receive in this country patents for inventions which are not patentable in their own country.

An amendment to the International Convention in the line of a change, such as is now urged, and also providing that the subject or citizen of a foreign country be required to pay in this country, for a patent the same fees which are required in his own country, was proposed at the Brussels conference in December, 1897, by the United States.<sup>3</sup> This was not adopted, but it was suggested that such a change in our law could be made without its necessitating our withdrawal from the Convention, provided the requirement as to increased fees and the restriction as to patentable subject-matter be made to apply to all applicants, whether citizens of the United States or foreigners, who had prior to application in this country patented their inventions abroad.

#### THE DATE GIVEN TO PATENTS IN FOREIGN COUNTRIES.

In many foreign countries the patent dates from the date of application and not from the date of the grant, as in the United States. In certain countries in which the application is subjected to delay for examination the result is that the effective term of the protection is less than the nominal term. Under such laws there is no advantage to be gained by causing unnecessary delay in the issuance of the grant. The United States law is not intended to encourage delays in the prosecution of applications, but the law does undoubtedly make it possible to delay the issuance of the patent and may result in practically extending the monopoly for a longer period than was ever intended or contemplated, since however long the application may remain in the

<sup>1</sup> Appendix, Chap. XV, p. 306.

<sup>2</sup> Appendix, Chap. XV, secs. 2, 6, 7, and 9, pp. 306, 308, and 309.

<sup>3</sup> See proposition of the United States, Appendix, Chap. IV, p. 189.

Patent Office, and some applications for important inventions have remained there ten or even more years, the patent when granted secures the control of the invention for the full term of seventeen years from the date of grant. With a view of remedying this, the act of March 3, 1897, required applications to be prosecuted without a delay of more than one year after any action by the office, instead of two years as before required, but even with this change, as repeated actions by the office are often required and as after each action the applicant has under the law a year in which to respond, it is evident that it is still possible to delay the issuance of a patent almost indefinitely if it is in the applicant's interest to do so. We do not, however, feel called upon to here recommend any further legislation in this regard.

#### SECOND PATENT GRANTED TO FIRST INVENTOR.

In this connection it should be noted that in regard to the term of the patent granted to the true inventor (the first inventor under the United States law) after a patent has already been granted to another for the same invention, the United States law differs from the laws of foreign countries. It not infrequently happens that a patent is granted to an applicant who claims to be entitled thereto as the first and original inventor and later another makes application for patent for the same invention and in proceedings authorized by law, it is adjudged that he, and not the patentee, is in fact the first and original inventor and that the person to whom the patent was granted was either not the inventor or, being an inventor of the invention in question, was not the first inventor. In such case, while the patent already granted cannot be revoked, there being in the United States law no provision for the revocation of a patent once granted, the Commissioner of Patents may under the law grant a patent, for the same invention covered by the patent already issued, to the later applicant.<sup>1</sup> The patent so granted to the later applicant is necessarily granted for the full term of seventeen years. As the proceedings necessary to secure a final adjudication establishing the right of the later applicant to a patent may consume months or even years, the patent issued to him may be in force years after the patent first granted for the invention has expired, years after the date at which the public has the right to assume that the invention has become public property.

Foreign countries generally provide that the real inventor shall not be deprived of his right to a patent by reason of the fact that a patent has been issued to another not legally entitled thereto. In some countries the patent already granted is recognized as valid, but its ownership is transferred to the later applicant. In Great Britain and many other countries, including Japan, the patent first granted is revoked and a patent is granted to the later applicant. The patent so granted is not granted for the full term, but only for the unexpired portion of the term of the first patent granted.<sup>2</sup> By this plan there is no extension of the monopoly, and the public may be certain that a patented invention will become public property on the expiration of the first patent granted therefor, whether or not there may be changes in the ownership of the patent by transfer of the title or by the issuance of a new patent.

<sup>1</sup>Sec. 4904 Revised Statutes.

<sup>2</sup>Appendix, Chap. XVI, p. 313.

We recommend that in all cases in which a patent is granted for an invention already patented to another, it be provided that such patent be limited to expire with the expiration of the patent first granted.

#### REVOCATION OF PATENTS.

While in nearly all foreign countries the laws expressly provide for the revocation of patents found to have been illegally granted, in the United States law, as has been above stated, there is no such provision.<sup>1</sup> We recognize the desirability of providing for the revocation or cancellation of such patents, but to do so would necessitate either giving to the Patent Office, as in Germany and a number of other countries, substantially judicial powers, or providing for proceedings in the courts.

#### PATENT FEES.

Under the United States patent law the fees payable for the examination (\$15) and for the issuance of the patent (\$20) are all the fees required to keep the patent in force throughout the term for which it is granted. In foreign countries, and this is true of practically all countries which have patent laws, the fees payable prior to the issuance of the patent keep the patent in force for from one to four years only. Thereafter further fees or taxes must be paid or the patent then ceases to be in force. In most countries the annual fees increase each year and are in the aggregate an enormous tax upon patentees. For the last year of the term the tax in Great Britain is £14, or nearly \$70; in Austria it is 340 florins, or about \$136; in Russia, 400 rubles, or over \$200.

The primary object of such tax is revenue for the support of the government, but the effect of requiring the payment of these heavy taxes is to compel the forfeiture of the large majority of foreign patents long before the expiration of the term for which they were granted. In Great Britain the term for which patents are granted is fourteen years, but of those granted not over 30 per cent are kept in force after the fifth year, not over 11 per cent after the tenth year, and less than 7 per cent are kept in force for the full term. In other countries which have this system substantially the same results are bound to follow. This is claimed by some to be advantageous, because it effectually disposes of patents which have been granted for inventions which are impracticable and useless. This argument doubtless has force where, as in many foreign countries, patents are granted on application without preliminary examination as to novelty or utility. In this country the preliminary examination system is in force and patents are granted only for inventions which are found on examination to be new and useful. The adoption of a system of taxation, however, we are satisfied would result in discouraging invention, particularly invention by those whose means are insufficient to pay the taxes and who would be unable under such a system to hold their patents long enough to be able to dispose of them to advantage. The purpose of the patent law is to promote invention, and while it may be admitted that the owners of many of the patents heretofore granted could well afford to pay annual taxes to keep them in force, it is clear that the effect of a system of taxation would not only have been to prevent the taking out of many patents for useful invention, but would have caused the forfeiture of many which while of doubtful value

<sup>1</sup> See U. S. v. Am. Bell Telephone Co., 167 U. S., 224.



during the first few years of their existence have eventually proved of great value and have been the foundation of important industrial enterprises.

#### WORKING OF PATENTED INVENTION—COMPULSORY LICENSE.

The requirement is found in the patent laws of most foreign countries that an invention which is the subject of a patent be worked—that is, be manufactured on a commercial scale—in the country in which the patent is granted on pain of forfeiture of the patent. The purpose of this requirement is, primarily, to benefit the industries of the country directly by requiring the patentee to carry on the manufacture of his invention in the country, as well as to prevent the injury to other manufacturers of articles of the same class which might arise from the introduction of articles embodying the invention made in other countries to compete upon the market with the productions of such other manufacturers, or which might arise from a refusal to supply the public of that country with the patented article while fully satisfying the public needs in another country.

The patent law of Great Britain, while not requiring that the invention of a patent be worked in the country, provides against such an exercise of his rights by a patentee as might work an injury to the public by requiring that under certain circumstances the patentee may be compelled to grant licenses to other manufacturers. This law is as follows:

It on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms,

(a) the patent is not being worked in the United Kingdom; or  
(b) the reasonable requirements of the public with respect to the invention can not be supplied; or

(c) any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

This system is embodied in the recent patent laws of many of the British colonies and in the laws of a number of other countries.<sup>1</sup>

#### SUMMARY OF RECOMMENDATIONS.

In addition to the changes in the patent laws above pointed out (page 27 above), as required to give full force and effect to the letter and spirit of the Convention, we recommend the following changes, suggested by the study of foreign patent laws, as desirable:

1. To require nonresident applicants for patents to place themselves within the jurisdiction of the courts of this country.

2. To provide that a disclosure of an invention in a foreign patent shall have the same effect as a bar to the grant of a patent in this country that is given to any other disclosure, that is, if printed, the patent shall have the effect of a printed publication; if not printed, the patent shall have no other effect than that of knowledge or use of the invention in a foreign country.

3. To provide that an application for a foreign patent shall not be a bar to the grant of a patent to the applicant in this country.

4. To provide that a patent granted on an invention previously patented in this country to another, shall expire with the expiration of the first patent.

<sup>1</sup>Appendix, Chap. XVII, p. 318.

We have embodied these recommendations, together with those which we have before referred to as required by our treaty obligations, in three proposed bills which are submitted herewith.

A BILL to give effect to treaty stipulations relating to letters patent for inventions.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* An application for patent for an invention or discovery, or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within seven months from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery, or a design, which had been described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing.

SEC. 2. In case it shall be provided in any treaty, convention, or agreement to which the United States shall hereafter be a party, or in case any treaty, convention, or agreement to which the United States is now a party shall be so modified as to provide that an application for patent for an invention or discovery, or for a design regularly filed in a foreign country which is a party to any such treaty, convention, or agreement, shall be accorded priority for a longer period than the period of seven months specified in the preceding section of this act, such period of priority shall be increased to equal the longer period so provided for immediately from and after the proclamation by the President of such treaty, convention, or agreement, or of the modification of such treaty, convention, or agreement.

SEC. 3. Section forty-eight hundred and ninety-six of the Revised Statutes is amended by adding thereto the following sentence:

The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent.

So that the section as amended shall read as follows:

SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent.

SEC. 4. Section forty-eight hundred and ninety-two of the Revised Statutes is amended by inserting after the words "notary public" the



words "judge or magistrate having an official seal and authorized to administer oaths," so that the section so amended shall read:

SEC. 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths of the foreign country in which the applicant may be.

SEC. 5. Section forty-nine hundred and two of the revised Statutes is repealed.

SEC. 6. This act shall take effect upon its passage (but caveats filed as provided for in section forty-nine hundred and two of the Revised Statutes prior to the passage of this act shall be operative for the term for which they were filed).

A BILL to revise the patent laws of the United States.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:* Section forty-eight hundred and eighty-six of the Revised Statutes, as amended by act of Congress approved March 3, 1897, is amended by erasing therein the words "patented or," and by inserting on line —, after the words "described in any," the words "printed patent or other," so that the section so amended shall read as follows:

SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country before his invention or discovery thereof, and not described in any printed patent or other printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceeding had, obtain a patent therefor.

SEC. 2. Section forty-nine hundred and twenty of the Revised Statutes, as amended by act of Congress approved March 3, 1897, is amended by erasing from the third clause of said section the words "patented or," and by inserting after the words "described in some" the words "printed patent or other," so that the section so amended shall read as follows:

SEC. 4920. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been described in some printed patent or other printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.



And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

SEC. 3. Section forty-eight hundred and eighty-seven of the Revised Statutes, as amended by act of Congress approved March 3, 1897, is amended by erasing all that portion which follows the words "in a foreign country," and substituting in lieu thereof the following:

Unless said foreign patent was granted more than two years prior to the filing of the application in this country, in which case no patent shall be granted in this country.

So that the section so amended shall read as follows:

SEC. 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless said foreign patent was granted more than two years prior to the filing of the application in this country, in which case no patent shall be granted in this country.

SEC. 4. Section forty-nine hundred and four of the Revised Statutes is amended by adding thereto the following sentence:

But in case a patent has already been granted to the adverse party, the patent granted to the party adjudged to be the prior inventor shall be limited to expire with the expiration of the term for which such patent was granted.

So that the section so amended shall read as follows:

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

But in case a patent has already been granted to the adverse party, the patent granted to the party adjudged to be the prior inventor shall be limited to expire with the expiration of the term for which the patent to such adverse party was granted.

SEC. 5. This act shall take effect immediately.

A BILL respecting applicants for patents not residing in the United States.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:* Section forty-eight hundred and ninety-three of the Revised Statutes is amended by adding thereto the following sentence:

Applicants for patent not residing in the United States shall, before the issuance of the patent, designate, by a notice in writing filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings brought under sections 4904, 4915, or 4918 of the Revised Statutes, or under other laws of the United States relating to patents, may be served with the same force and effect as if served upon the applicant or patentee in person.

So that the section so amended shall read as follows:

SEC. 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is suffi-

ciently useful and important, the Commissioner shall issue a patent therefor. Applicants for patent not residing in the United States shall, before the issuance of the patent, designate, by a notice in writing filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings brought under sections 4904, 4915, or 4918 of the Revised Statutes, or under other laws of the United States relating to patents, may be served with the same force and effect as if served upon the applicant or patentee in person.

SEC. 2. Section forty-eight hundred and ninety-eight of the Revised Statutes as amended by the act of March 3, 1897, is amended by adding the following sentence:

Before any such assignment, grant, or conveyance shall be recorded in the Patent Office the assignee or assignees, if not residing in the United States, shall designate, by a notice in writing filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings brought under sections 4904, 4915, or 4918 of the Revised Statutes, or under the laws of the United States relating to patents, may be served with the same force and effect as if served upon such assignee or assignees in person.

So that the section so amended shall read as follows:

SEC. 4898. Every patent or any interest therein shall be assignable in law by an instrument in writing, and the patentee or his assigns or legal representatives may in like manner grant or convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories, or the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be *prima facie* evidence of the execution of such assignment, grant, or conveyance.

Before any such assignment, grant, or conveyance shall be recorded in the Patent Office the assignee or assignees, if not residing in the United States, shall designate, by a notice in writing filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings brought under sections 4904, 4915, or 4918 of the Revised Statutes, or under the laws of the United States relating to patents, may be served with the same force and effect as if served upon such assignee or assignees in person.

SEC. 3. Every person who owns an undivided interest in any unexpired patent heretofore granted or which may hereafter be granted in this country who does not reside in the United States shall designate, by a notice in writing filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings brought under sections 4904, 4915, or 4918 of the Revised Statutes, or under other laws of the United States relating to patents, may be served with the same force and effect as if served upon said owner of an undivided interest in person.

SEC. 4. This act shall take effect the first day of July, nineteen hundred and one. If any person required by this act to designate a person residing in the United States on whom process or notice may be served as provided for by this act shall fail to file in the Patent Office the notice of such designation required by this act prior to the date at which this act takes effect, he shall be considered to have elected residence in the District of Columbia, and publication of process or notice of proceedings brought under any of the Revised Statutes referred to in this act, or under other laws of the United States relating to patents, for four successive weeks in the Official Gazette of the Patent Office shall be equivalent to service of such process or notice.



## TRADE AND OTHER MARKS AND TRADE OR COMMERCIAL NAMES.

We are also required by the act under which we were appointed to revise and amend the laws of the United States concerning trade and other marks and trade or commercial names so far as the same relate to matters which are contained in or are affected by the Convention for the Protection of Industrial Property, concluded at Paris, March 20, 1883,<sup>1</sup> to which we have heretofore referred, and to the Agreements under said convention concluded at Madrid, April 14, 1891,<sup>2</sup> and the treaties of the United States and laws of other nations relating to trade and other marks and trade or commercial names, and to report our reasons for any recommendations which we may make.

The United States is a member of the Union created by the Convention for the Protection of Industrial Property, concluded at Paris, March 20, 1883, of which the other members are Belgium, Brazil, Denmark, Dominican Republic, France, Great Britain, Italy, Japan, The Netherlands, Norway, Portugal, Spain, Serbia, Sweden, Switzerland, and Tunis, as before stated, and has not become a member of the subsidiary Unions created by the Agreements of Madrid above referred to.

The United States has made separate treaties, conventions, and declarations relating in whole or in part to trademarks with Austria-Hungary, Belgium, Brazil, Denmark, France, Germany, Great Britain, Italy, Japan, Russia, Servia, and Spain.<sup>3</sup>

Substantially, every civilized nation has promulgated laws relating to the regulation of the use of trademarks in commerce.<sup>4</sup>

As directed by the said act we have revised and amended the laws mentioned therein in the manner prescribed, and submit the same herewith in the form of a proposition for the regulation of marks used in commerce, accompanied by a preliminary statement of its scope and the changes made by it, and notes to the several sections.

We here propose to review all the treaties, conventions and declarations to which the United States is a party, commencing with the Convention of Paris, 1883, and the Agreements thereunder for the repression of false indications of origin and for the international registration of trademarks, and following with the treaties, conventions, and declarations with single foreign governments. We thereafter propose to review certain salient features of foreign trademark laws which are of interest to our citizens and which may aid in coming to a conclusion as to what should be incorporated into such a law and the powers of the General Government in regard to the same.

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<sup>1</sup> Appendix, Chap. II, sec. 1, p. 146.

<sup>2</sup> Appendix, Chap. II, secs. 3 and 4, pp. 158, 160.

<sup>3</sup> Appendix, Chap. XVIII, p. 325.

<sup>4</sup> Appendix, Chap. XIX, p. 340



## CONVENTION OF PARIS, MARCH 20, 1883.

The Convention for the Protection of Industrial Property, concluded at Paris, March 20, 1883, includes within its terms the products of industry, properly so called, as well as the products of agriculture (wines, grains, fruits, cattle, etc.), and mineral products which enter into commerce (mineral waters, etc.).<sup>1</sup>

Article 2 provides that the subjects or citizens of each of the contracting States shall enjoy in all of the other States of the Union for the Protection of Industrial property, so far as concerns trade or commercial marks, and the commercial name, the advantages which the respective laws thereof accord to subjects or citizens.<sup>2</sup> That is, the United States shall grant within its territory to citizens or subjects of other members of the Industrial Property Union the same rights as it grants to its own citizens. These rights are secured by an act approved March 3, 1881, and entitled "An act to authorize the registration of trademarks and protect the same," supplemented by an act approved August 5, 1882, and entitled "An act relating to the registration of trademarks." These acts are reciprocal and fulfill the requirements of the Convention so far as they go. Trademarks and the commercial name are also protected by many State statutes and by the common law existing in the several States of the United States, to which an alien may resort without regard to the protection which his own Government extends to citizens of the United States. While it may be contended that subjects or citizens of the other contracting States enjoy in the United States, so far as concerns trade and other marks and the commercial name, the advantages which the respective laws thereof accord to subjects or citizens under the conditions above stated, i. e., a limited national law and complete laws in many of the States of the United States, it is not true, in our opinion, that they receive protection from the United States as a *nation* to the extent to which they are entitled and which they expect in granting similar rights to our citizens. That *national* and not State protection is sought by the other members of the Industrial Property Union is shown by the resolutions of the French delegation offered at the conference at Brussels in 1897, viz:

That the Government of the United States of America attempt in every way to provide, as soon as possible, Federal legislation which will replace local legislation in reference to trademarks, and will insure an easier and more efficient suppression of trademark infringements.<sup>3</sup>

A casual examination of the trademark laws of the other States of the Union for the Protection of Industrial Property<sup>4</sup> will show that the existing trademark statutes of the United States do not give that protection to trademarks which such laws of other countries give to their own citizens or subjects and therefore to citizens of the United States.

By article 12 of the Convention, the United States agrees to establish a special service of industrial property and a central depot for giving information to the public concerning trade or commercial marks. If this article means the establishment of an office merely, the United States has complied with it, since the United States already had an

<sup>1</sup> Final Protocol of Convention, clause 1 (Appendix, Chap. I, sec. 1), p. 152.

<sup>2</sup> Appendix, Chap. I, sec. 1, p. 148.

<sup>3</sup> Appendix, Chap. V, p. 192.

<sup>4</sup> Appendix, Chaps. XXI, XXII, XXIII, and XXIV, pp. 349, 352, 363, and 373.

office, called the Patent Office, charged with the registration of trade-marks before its adhesion to the Convention. But the discussions of the conferences held under the Convention show that this is not the understanding of the meaning of article 12 by the other members of the Union. They claim it to be a pledge for the making of laws applicable to the protection of industrial property, including marks.

Section 11 of the tariff act of 1897 provides for the protection of the trademarks of any domestic manufacture or manufacturer by forbidding entry into the United States of any article of imported merchandise bearing such marks. The advantages of this law are not extended to foreigners.

Article 3. This article gives the privileges granted by the Convention to persons domiciled or having industrial or commercial establishments upon the territory of one of the States of the Industrial Property Union to the same extent as to a subject or citizen of such State.

The act of March 3, 1881, contains a proviso that owners of trade-marks used in commerce with foreign nations or with the Indian tribes located in any foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, may obtain registration, etc. It therefore fulfills the requirements of this article.

Article 4 provides that any person who shall have regularly deposited an application for a trademark in one of the contracting States shall enjoy, for the purpose of making the deposit in the other States and under the reserve of the rights of third parties, a right or priority of three months in Europe and four months in countries beyond the sea,<sup>1</sup> during which a deposit subsequently made in one of the other States of the said Union can not be invalidated by another deposit or by the employment of the mark.

No provision is made in the law of 1881 for the precedence of a prior applicant in another State of the Union for the Protection of Industrial Property over an applicant for registration here.

It is to be noted that article 4 excepts out from its provisions the rights of third parties. We understand this to mean those in the United States who obtain title to a mark by use before application abroad. It is also to be noted that the use of the mark after the deposit of the application in one of the States of the Union will not invalidate the claim to registration during the period of four months thereafter. Now, as a trademark can not be registered under the present law except to the first user, the registration abroad should be given the effect of a user of the mark in this country at the date of the first application.

Article 6 is as follows:

Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union.

Shall be considered as country of origin, the country where the depositor has his principal establishment.

If this principal establishment is not situated in one of the countries of the Union, shall be considered as country of origin that to which the depositor belongs.

The deposit may be refused if the object for which it is asked is considered contrary to morals and to public order.

Final protocol 4, which is to be read with article 6, is as follows:

4. Paragraph 1 of article 6 is to be understood in the sense that no trade or commercial mark shall be excluded from protection in one of the states of the Union by the

<sup>1</sup> This includes the United States.



mere fact that it may not satisfy, in respect to the signs composing it, the conditions of the laws of this state, provided that it does satisfy in this regard the laws of the country of origin, and that it has been in this latter country duly deposited. Saving this exception, which concerns only the form of the mark, and under reservation of the provisions of the other articles of the convention, the domestic legislation of each of the states shall receive its due application.

In order to avoid all misinterpretation, it is understood that the use of public armorial bearings and decorations may be considered contrary to public order in the sense of final paragraph of article 6.

The above provisions of article 6 as modified by protocol 4 furnished one of the principal subjects for debate at the Brussels conference. The differences of opinion in the conference were so great that the matter was left open for consideration at a future session.

These provisions are essentially French in their origin and are intended to secure the free circulation and protection of marks—good in the country of origin—in all other countries, no matter what may be their inherent defects, viewed from the standpoint of any other country than the country of origin, and no matter what the articles distinguished by the particular marks. A similar provision is embodied in a treaty between Russia and Switzerland concluded as late as 1899.<sup>1</sup> Substantially the same provision seems to be contained in article 1 of the treaty of November 25, 1871, with Austria-Hungary;<sup>2</sup> article 15 of the treaty of March 6, 1875, with Belgium<sup>2</sup> (superseded by the treaty of April 7, 1884); the treaty of April 16, 1869, with France;<sup>2</sup> treaty of January 27, 1868, with Russia<sup>2</sup> (superseded by the declaration of November 24, 1874), and the treaty of October 14, 1881, with Serbia.<sup>2</sup>

This article is wholly disregarded by Great Britain. Its provisions were invoked in the case of an American mark, "Syrup of Figs," duly registered here, but registration was there refused on the ground that the mark registered here did not come within the definition of a trademark contained in the British law.<sup>3</sup>

The trademark act of 1881 seems to fulfill the requirements of article 6 in the following language: "But no alleged trademark shall be registered unless the same \* \* \* is within the provision of a treaty, convention, or declaration with a foreign nation."

A provision more clearly following the Convention is embodied in the proposed statute drafted by us.

Article 7 is as follows:

The nature of the production upon which the trade or commercial mark is to be affixed can not in any case be an obstacle to the deposit of the mark.

This article is not to be understood as requiring trademarks which are to be applied to articles, the trade in which is contrary to public order or good morals, to be registered or protected. It is understood to be intended to prevent refusal of registration of marks applied to products which in certain countries are government monopolies, as, for instance, marks applied to tobacco, which in certain European countries is a government monopoly. As in this country no trademarks are refused registration on account of the products to which they are applied, it is clear that no amendment to the present law is necessary to give effect to this article.

<sup>1</sup> Appendix, Chap. IX, sec. 5, p. 260.

<sup>2</sup> Appendix, Chap. XVIII.

<sup>3</sup> See position of British delegates to Conference of 1897, stated in Appendix, Chap. VI, p. 214.



Section 8 of the act of 1881, which forbids suits in any case where the trademark is used in any unlawful business or upon any article injurious in itself or which mark has been used with the design of deceiving the public in the purchase of merchandise or under any certificate of registry fraudulently obtained, is not antagonistic to article 7 of the Convention.

Article 8 is as follows:

The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not of a trade or commercial mark.

There is no provision by statute of the United States for the protection of the commercial name. The United States as a nation or government does not protect commercial names, and so far does not fulfill the requirements of the Convention, although the several States do. We have therefore included these in our proposed bill.<sup>1</sup>

Article 9 is as follows:

Every production bearing unlawfully a trade or commercial mark, or a commercial name, may be seized upon importation into those of the States of the Union in which such mark or such commercial name has a right to legal protection.

The seizure shall take place either at the instance of the public prosecutor or of the interested party, conformably to the domestic legislation of each State.

There is no provision in any Federal law of the United States for seizure of productions bearing unlawfully a trade or commercial mark, etc., in favor of the subjects or citizens of the other States of the Union for the Protection of Industrial Property. An amendment to this section was proposed at the Brussels conference, as follows:

In the States whose legislation does not admit of seizure on importation, such seizure may be replaced by the prohibition of importation.

The authorities shall not be required to effect seizure in case of goods in transit.<sup>1</sup>

There is a provision in the tariff act of 1897 for the exclusion of goods bearing the marks of *domestic* manufacturers only. We have included in the proposed bill a section to replace section 11 of the tariff act of 1897 extending its operation to citizens or subjects of the other States of the said Union.<sup>2</sup>

Article 10 is as follows:

The provisions of the preceding article shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention.

Is reputed interested party every manufacturer or trader engaged in the manufacture or sale of this production, when established in the locality falsely indicated as the place of export.

What we have said in regard to article 9 is applicable here also. There is no statute providing for seizure of products bearing falsely, as indications of origin, the name of a stated locality. It is provided in the tariff law of 1897 as follows:

SEC. 8. That all articles of foreign manufacture, such as are usually or ordinarily marked, stamped, branded, or labeled, and all packages containing such or other imported articles, shall, respectively, be plainly marked, stamped, branded, or labeled in legible English words in a conspicuous place, so as to indicate the country of their origin and the quantity of their contents; and until so marked, stamped, branded, or labeled they shall not be delivered to the importer.

This is not the case contemplated by article 10. That article is intended to reach products bearing fictitious names in imitation of the

<sup>1</sup> Section 2 of proposed bill, p. 65.

<sup>2</sup> Section 33 of proposed bill, p. 77.

usual names of a neighborhood to which the goods are falsely attributed. An amendment to this article was adopted at the conference at Rome, 1885, but was not ratified. At the conference of Madrid a subsidiary agreement was adopted which became binding on those States only which signed it. The subject is further discussed hereinafter in connection with that agreement.

Sections 3 and 33 of the proposed act are intended to carry this article into effect.<sup>1</sup>

Article 11 is as follows:

The High Contracting parties engage between themselves to accord a temporary protection to patentable inventions, to industrial designs or models, as well as to trade or commercial marks for the productions which may figure at official or officially recognized International Exhibitions.

The only statute of the United States on the subject of international exhibitions granted immunity to citizens of another country for the infringement of any patent granted in the United States, or of any trademark or label registered in the United States, "where the act complained of is or shall be performed in connection with the exhibition of any article or thing at the World's Columbian Exposition at Chicago."<sup>2</sup>

This law went further than was required by article 11 of the Convention. That article contemplated the protection against infringement, i. e., "temporary protection" for the short period of the exhibition, and we may presume that it was intended also to prevent during that period the registration by a stranger of a trademark attached to an exhibited article. It was not intended to suspend the laws as to infringement of trademarks and excuse such infringement during the exhibition. An amendment to this article, adopted by the Brussels conference, is as follows:

ART. 11. The High Contracting parties shall accord conformably to the legislation of each country a temporary protection to patentable inventions, to industrial designs or models, as well as to trademarks, for the productions which may figure at official or officially recognized International Expositions organized upon the territory of one of them.

It is apparent from this examination of the Convention of Paris of 1883 that a new trademark statute superseding the statute of 1881 is required in order to give effect to the provisions of the Convention.

#### AGREEMENTS OF MADRID, APRIL 14, 1891.

The Convention was amended at a conference held at Rome in 1886, but the amendments failed of ratification by the powers forming the industrial Union because unanimous consent could not be obtained. At the succeeding conference of Madrid in 1890, the simple expedient was adopted of proposing to the members of the Union subsidiary agreements which should be binding on those only who signed the same. The agreements proposed by the Madrid conference related (1) to the prevention of false indications of origin, and (2) to the international registration of trademarks. The United States is not a party to either of these agreements.

<sup>1</sup> Sections 3 and 33 of proposed bill, pp. 65 and 77.

<sup>2</sup> Statutes at Large, chapter 33, approved April 6, 1893.



# AGREEMENT CONCERNING THE SUPPRESSION OF FALSE INDICATIONS OF ORIGIN ON MERCHANDISE.<sup>1</sup>

The following members of the Union created by the principal convention have entered into an agreement between themselves for the prevention of false indications of origin of goods, viz, Brazil, France, Great Britain, Guatemala, Portugal, Spain, Switzerland, and Tunis.

Article 1 of the Agreement is as follows:

All goods bearing a false indication of origin, in which one of the contracting States, or a place situated therein, shall be directly or indirectly indicated as being the country or place of origin, shall be seized on importation into any of the said States.

The seizure may also take place either in the State where the false indication of origin has been applied, or in that into which the goods bearing the false indication may have been imported.

If the law of any State does not permit seizure on importation, such seizure shall be replaced by prohibition of importation.

If the law of any State does not permit seizure in the interior, such seizure shall be replaced by the remedies assured in such case to natives by the law of such State.

This article is of such interest to our people that we have introduced a clause into the proposed act to enforce its provisions.<sup>2</sup>

Section 8 of the tariff act of 1897 requires marking of goods imported into the United States with the name of the country from which imported, but does not extend its protection to the name of the place, e. g., it requires the name of France to be marked on goods made in France and forbids the use of the name falsely, but does not protect the name of Lyons, a city of France. Besides it is an obligatory mark, and not a mark for the protection of the citizens or subjects of the foreign nation.

There is a view of this subject which is of peculiar interest to the manufacturers of the United States. Take, for example, butter which because of its superior quality is sold in Europe as Danish butter. The latter had a reputation in Europe when our butter was introduced, and the first sales under that name were therefore fraudulent as to the buyer, and since the butter is as good as Danish butter these sales prevented the fact becoming known and a reputation and demand being formed for the American butter. The price follows the reputation and demand. On the other hand, the sale of butter as American butter, which is of inferior quality, will work great injury to our country in reducing the reputation of its butter, and therefore the price.

The interest of our people in the subject is shown by the adoption by many of our communities of marks for commercial purposes, e. g., Omaha, Kansas City, etc.

We are of the opinion that the United States should make use of this agreement before the names of certain of her products become generic, as, for example, champagne has become to the great loss of the champagne districts of France.

Article II relates to persons at whose instance seizure may be made, and that it shall not be made in case of goods in transit.

Article III is as follows:

The present stipulations are not intended to prevent the vendor from indicating his name or address upon goods coming from a country other than that where the sale takes place, but in such case the address or the name must be accompanied by a clear indication in legible characters of the country or place of manufacture or production.

<sup>1</sup> Appendix, Chap. II, sec. 3, p. 158.

<sup>2</sup> See section 33 of proposed bill, p. 77.



Article IV makes provision for cases where names of places have become generic as follows:

The tribunals of each country will decide what appellations, on account of their generic character, do not fall within the provisions of the present arrangement, regional appellations concerning the origin of products of the vine being, however, not comprised in the reserve provided for by the present article.

#### AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF TRADEMARKS.

The following members of the Union for the Protection of Industrial Property have signed the Agreement adopted at Madrid concerning the international registration of trademarks, viz, Belgium, Brazil, France, Italy, the Netherlands, Portugal, Spain, Switzerland, and Tunis.

Article I of the agreement is as follows:

The subjects or citizens of each of the contracting States may secure in all the other States the protection of their trademarks accepted at the depository in the country of origin, by means of the deposit of the said marks at the international bureau at Berne made by the intervention of the government of the said country of origin.

We have prepared a section of the trademark bill to provide proceedings to facilitate the taking advantage by our citizens of this agreement whenever it shall be adhered to by the United States.<sup>1</sup>

It is unnecessary here to reproduce the remaining articles of the Agreement. They will be found in the Appendix.<sup>2</sup>

The arguments in favor of the adhesion of the United States to the Agreement given by the International Bureau of Berne will be found in the Appendix.<sup>3</sup>

The cost of registration in foreign countries through individual agencies is now so great that we would refer to the fact that the cost of registration in all the States adhering to this subsidiary Union, and named above, is only 100 francs (\$20), in addition to the fee which may be established by the United States Government.<sup>4</sup>

It is to be understood that the United States would receive no fee for the registration of marks forwarded to it by the International Bureau at Berne from other States of the subsidiary Union.

#### TREATIES, CONVENTIONS AND DECLARATIONS BETWEEN THE UNITED STATES AND OTHER SINGLE POWERS.

##### RUSSIA.

An article respecting trademarks additional to the treaty of navigation and commerce of December 6-18, 1832, with Russia was concluded at Washington January 27, 1868; proclaimed October 15, 1868. The additional article other than the preamble and provision for termination is as follows:

The high contracting parties desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trademarks affixed in the other on

<sup>1</sup>See section 41 of proposed bill, p. 78.

<sup>2</sup>Appendix, Chap. II, sec. 4, p. 160.

<sup>3</sup>Appendix, Chap. II, sec. 6, p. 166.

<sup>4</sup>Appendix, Chap. II, sec. 6, p. 168.

merchandise to show its origin and quality shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trademarks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other must be lodged exclusively, to wit, the marks of citizens of the United States in the Department of Manufactures and Inland Commerce at St. Petersburg, and the marks of Russian subjects at the Patent Office in Washington.<sup>1</sup>

A declaration regarding the above article was signed March 28, 1874, proclaimed November 24, 1874. It is as follows:

The Government of the United States of America and the Government of His Majesty the Emperor of all the Russias, having recognized the necessity of defining and rendering more efficacious the stipulations contained in the additional article of the 15th-27th January, 1868, to the Treaty of Commerce and Navigation concluded between the United States of America and Russia on the 6th-18th December, 1832, the undersigned, duly authorized to that effect, have agreed upon the following arrangements:

ARTICLE 1. With regard to marks of goods or of their packages, and also with regard to marks of manufacture and trade, the citizens of the United States of America shall enjoy in Russia, and Russian subjects shall enjoy in the United States, the same protection as native citizens.

ART. 2. The preceding article, which shall come immediately into operation, shall be considered as forming an integral part of the treaty of the 6th/18th December, 1832, and shall have the same force and duration as the said treaty.<sup>1</sup>

The declaration is an addition only to the original article. It makes certain the fact that citizens of the United States shall enjoy the same protection as Russian subjects, but it does not change the obligation of either party to prohibit false marking, etc., as stated in the original article.

This treaty requires the enactment of some law by the Congress of the United States in distinction from any State legislation for the prohibition and suppression of the counterfeiting of trademarks of Russian subjects in the United States. It requires at least some national law, to which the subjects of Russia can resort, more far-reaching than the law of 1881.

This treaty requires the Russian subject to lodge his trademark in the Patent Office at Washington, but the Commissioner of Patents, as the trademark law is at present construed, does not consider that he has authority to register Russian trademarks, unless they are such marks as could be registered by citizens of the United States.

It is of advantage to the citizens of the United States that a rule corresponding to the treaty should prevail. Our commerce has become so extensive abroad that our marks should have full protection everywhere in order to reap the full advantage of such trade. For example, single names such as "Sapolio," "Listerine," and other advertised marks here are not trademarks under the laws of some of the countries of Europe, and therefore these articles can not be exported there with the assurance of protection against infringement, and if export is desired some other trademark must be adopted. We can well receive and record the few Russian marks that will be offered, such as they are, and without making them conform to our rules.

#### BELGIUM.

In the same year that the agreement was concluded with Russia an additional article to the treaty of commerce and navigation of July

<sup>1</sup> Appendix, Chap. XVIII, sec. 11, p. 335.

17, 1858, concerning trademarks, was concluded with Belgium. (Concluded December 20, 1868; proclaimed July 30, 1869.) The additional article is as follows:

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens of one of the two countries may wish to secure the right of property in the other must be lodged, to wit: The marks of citizens of the United States at Brussels in the office of the clerk of the tribunal of commerce; and the marks of Belgian citizens at the Patent Office in Washington.

It is understood that if a trade-mark has become public property in the country of its origin it shall be equally free to all in the other country.<sup>1</sup>

The treaty to which this was an additional article was abrogated, and a new "treaty of commerce, navigation, and trademarks" with Belgium was concluded March 8, 1875, in which was inserted an Article XV in substantially the same language as above.<sup>2</sup> National, as distinguished from State, trade-marks are clearly pointed out by the last paragraph of the article. It is necessary for the statute to decide what trade-marks have become public property in all the States of the United States; e. g., "Matzoon" has been held in New York State to be a good trade-mark,<sup>3</sup> and the United States circuit court in Chicago, administering the common law of Illinois, has held it to be public property.<sup>4</sup> This treaty seems to be still in force, yet a separate convention with Belgium concerning trademarks only was concluded April 7, 1884; proclaimed July 9, 1884. It is as follows:

The President of the United States of America and His Majesty the King of the Belgians being desirous of securing reciprocal protection for the trade-marks and trade labels of their respective citizens or subjects within the dominions or territories of the other country, have resolved to conclude a convention for that purpose, and have appointed as their plenipotentiaries: \* \* \*

ARTICLE 1. Citizens of the United States in Belgium and Belgian citizens in the United States of America shall enjoy, as regards trade-marks and trade labels, the same protection as native citizens, without prejudice to any privilege or advantage that is or may hereafter be granted to the citizens of the most favored nation.

ART. 2. In order to secure to their marks the protection provided for by the foregoing article, the citizens of each one of the contracting parties shall be required to fulfill the law and regulations of the other. (Appendix, Chap. XVIII, sec. 2.)

If the treaty of 1875 is in force, the same observations must be made in regard to it as were made in regard to the treaty with Russia.<sup>5</sup> They may also be applied, because the convention of 1884 contains the most-favored-nation clause.

In either case the treaty refers to the United States of America and its laws and not to local laws.

#### FRANCE.

In 1869 a separate convention concerning trademarks was concluded with France. (Concluded April 16, 1869; proclaimed July 6, 1869.) It is as follows:

The United States of America and His Majesty the Emperor of the French, desiring to secure in their respective territories a guaranty of property in trademarks,

<sup>1</sup> Appendix, Chap. XVIII, sec. 2, p. 326.

<sup>2</sup> *Id.*, p. 327.

<sup>3</sup> 15 Misc. R. (N. Y.), 300.

<sup>4</sup> 72 Fed. Rep., 1010.

<sup>5</sup> *Ante*, p. 48.



have resolved to conclude a special convention for this purpose, and have named as their plenipotentiaries: \* \* \*

ARTICLE I. Every reproduction in one of the two countries of trademarks affixed in the other to certain merchandise to prove its origin and quality is forbidden, and shall give ground for an action for damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven, just as if the plaintiff were a subject or citizen of that country.

The exclusive right to use a trademark for the benefit of citizens of the United States in France, or of French subjects in the territory of the United States, can not exist for a longer period than that fixed by the law of the country for its own citizens.

If the trademark has become public property in the country of its origin, it shall be equally free to all in the other country.

ART. II. If the owners of trademarks residing in either of the two countries wish to secure their rights in the other country they must deposit duplicate copies of those marks in the Patent Office at Washington, and in the clerk's office of the tribunal of commerce of the Seine at Paris.<sup>1</sup>

In this case the language of the prior treaties is not used, and the citizen of France is secured the same rights only as if he were a citizen of the United States.

French citizens are to deposit duplicate copies of their marks in the Patent Office at Washington. Under the present law as at present construed they can not deposit them unless they are such marks as would be registrable to citizens of the United States.

#### AUSTRIA-HUNGARY.

In 1871 a convention with Austria-Hungary, relative to trademarks alone, was concluded. (Concluded November 25, 1871; ratifications exchanged at Vienna April 22, 1872; proclaimed June 1, 1872.) It is as follows:

The United States of America and his Majesty the Emperor of Austria, King of Bohemia, etc., and Apostolic King of Hungary, desiring to secure in their respective territories a guarantee of property in trade-marks, have resolved to conclude a special convention for this purpose, and have named as their plenipotentiaries: \* \* \*

ARTICLE I. Every reproduction of trade-marks which in the countries or territories of the one of the contracting parties are affixed to certain merchandise to prove its origin and quality is forbidden in the countries or territories of the other of the contracting parties, and shall give to the injured party ground for such action or proceedings to prevent such reproduction, and to recover damages for the same, as may be authorized by the laws of the country in which the counterfeit is proven, just as if the plaintiff were a citizen of that country.

The exclusive right to use a trade-mark for the benefit of citizens of the United States in the Austro-Hungarian Empire or of citizens of the Austro-Hungarian Monarchy in the territory of the United States can not exist for a longer period than that fixed by the law of the country for its own citizens. If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the countries or territories of the other of the two contracting parties.

ART. II. If the owners of trade-marks, residing in the countries or territories of the one of the contracting parties, wish to secure their rights in the countries or territories of the other of the contracting parties, they must deposit duplicate copies of those marks in the Patent Office at Washington and in the Chamber of Commerce and Trade in Vienna and Pesth.<sup>2</sup>

The language of this convention is very similar to that of the declaration with Russia,<sup>2</sup> and the same observation may be made in regard to it. It is also similar to that of the treaty with Belgium, 1875, in that the trademark is to become public property in both countries at the same time, and the remarks there made as to the necessity of national control, drawn from the language, apply here also.

<sup>1</sup> Appendix, Chap. XVIII, sec. 5, p. 330.

<sup>2</sup> Appendix, Chap. XVIII, sec. 1, p. 325.

<sup>3</sup> Ante, p. 48.

## GERMANY.

In 1871 a convention was entered into with the German Empire. It is entitled in the collection of treaties and conventions published by the United States, "Convention Respecting Consuls and Trademarks." (Concluded December 11, 1871; proclaimed June 1, 1872.) The convention is much broader than the title indicates, and has but one article in eighteen on trademarks, viz:

ART. XVII. With regard to the marks or labels of goods, or of their packages, and also with regard to patterns and marks of manufacture and trade, the citizens of Germany shall enjoy in the United States of America, and American citizens shall enjoy in Germany, the same protection as native citizens.<sup>1</sup>

The present trademark statute appears to satisfy this treaty; but it seems hardly just that the Germans should be relegated to the protection offered in forty-five possible ways by forty-five different States, when the citizens of the United States need look to but one law, viz, that of the German Empire. This remark is applicable to all the treaties granting reciprocal rights.

## GREAT BRITAIN.

In 1877 a declaration respecting trademarks was concluded between Great Britain and the United States. (Concluded October 24, 1877; ratification advised by Senate May 22, 1878; ratified by President May 25, 1878; proclaimed July 17, 1878.) It is as follows:

The Government of the United States of America and the Government of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:

The subjects or citizens of each of the contracting parties shall have, in the dominion and possessions of the other, the same rights as belong to native subjects or citizens, or as are now granted or may hereafter be granted to the subjects and citizens of the most-favored nation, in everything relating to property in trade-marks and trade-labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfill the formalities required by the laws of the respective countries.<sup>2</sup>

This declaration, except so far as expanded by the most-favored-nation clause, is satisfied by the present trade-mark law of 1881. It is to be noted that the language would seem to imply that citizens of the United States can register in Great Britain and subjects of the Queen of Great Britain can register in the United States only what are recognized as good trademarks in the country where registration is sought. It may happen, therefore, that a citizen of the United States may have a perfectly good trademark in the United States, registered under the law of 1881, and still not be able to register the same mark in Great Britain, if some other American or some subject of the Queen applies first to register the United States registered mark in England, since the English law grants the registration to the first applicant if he is the first user in Great Britain. This would not be done in the United States. The first user in Great Britain would be given in the United States the registration over a subsequent adopter here under the theory that the first to adopt and use has the prior right.

The treaty seems to be more than satisfied by the act of 1881.

<sup>1</sup> Appendix, Chap. XVIII, sec. 6, p. 331.

<sup>2</sup> Appendix, Chap. XVIII, sec. 7, p. 331.



Does not fulfilling formalities mean the mere compliance with the forms for registration and not compliance with the definition of a trademark?<sup>1</sup>

#### BRAZIL.

An agreement concerning trademarks with Brazil was concluded September 24, 1878; proclaimed June 17, 1879.

The agreement recites:

The Government of the United States of America and the Government of His Majesty the Emperor of Brazil, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:

The citizens or subjects of the two high contracting parties shall have in the dominions and possessions of the other the same rights as belong to native citizens or subjects in everything relating to property in marks of manufacture and trade.

It is understood that any person who desires to obtain the aforesaid protection must fulfill the formalities required by the laws of the respective countries.<sup>2</sup>

This agreement is satisfied by the present trademark law of 1881.

#### SERBIA.

A convention for facilitating and developing commercial relations with Serbia was concluded at Belgrade, October 14, 1881; proclaimed December 27, 1882, in which was included an article as follows:

ART. XII. The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trademarks affixed in the other on merchandise to show its origin and quality shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured parties, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trademarks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other must be registered exclusively, to wit, the marks of citizens of the United States in the tribunal of commerce at Belgrade and the marks of Serbian subjects in the Patent Office at Washington, subject to the conditions and restrictions prescribed by the laws and regulations of the country in which the trade-marks are registered.<sup>3</sup>

This seems to be a copy of the agreement with Russia, 1868,<sup>4</sup> except that the marks of the citizens of the United States are to be registered in "the tribunal of commerce at Belgrade," and the addition of the clause, "Subject to the conditions and restrictions prescribed by the laws and regulations of the country in which the trademarks are registered." The remarks made in regard to the Russian agreement apply here also, except so far as modified by the last clause of the last sentence. Whether we give more than we receive depends upon the meaning of the undefined words in the law of 1881, "a legal trademark." What Serbia protects is stated in Appendix to be:

Every mark serving to distinguish products of industry or articles of commerce from similar products or articles is considered a trade-mark.

No person can enjoy the exclusive right to a mark which is in general use in commerce, or which consists of a single letter, figure, or word. The reproduction of the national arms as a trade-mark is as a rule interdicted. Marks which have an immoral character, or might be prejudicial to public order, can not be admitted to registration.

<sup>1</sup> See report of the British delegates, Appendix, Chap. VI, p. 214.

<sup>2</sup> Appendix, Chap. XVIII, sec. 3, p. 328.

<sup>3</sup> Appendix, Chap. XVIII, sec. 12, p. 336.

<sup>4</sup> Ante, p. 48.



## ITALY.

A declaration for the reciprocal protection of marks of manufacture and trade with Italy was concluded June 1, 1882; proclaimed March 19, 1884. It is as follows:

The Government of the United States of America and the Government of His Majesty the King of Italy, wishing to provide for the reciprocal protection of the marks of manufacture and trade, have agreed as follows:

The citizens of each of the high contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as belong to native citizens, or as are now granted or may hereafter be granted to the subjects or citizens of the most favored nation, in everything relating to property in trade-marks and trade-labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfill the formalities required by the laws of the respective countries.<sup>1</sup>

This declaration is in substantially the same form as that with Great Britain,<sup>2</sup> and the remarks made as to that declaration are also applicable here.

## SPAIN.

A convention concerning trademarks with Spain was concluded June 19, 1882; proclaimed April 19, 1883. It is as follows:

The President of the United States of America and His Majesty the King of Spain, being desirous of securing reciprocal protection for the trade-marks and manufactured articles of their respective citizens or subjects within the dominions or territories of the other country, have resolved to conclude a convention for that purpose, and have appointed as their plenipotentiaries: \* \* \*

ARTICLE I. The citizens and subjects of each of the two contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as the natives of the country in everything relating to the ownership of trade-marks, industrial designs or models, or of manufactures of any kind.

ART. II. Persons desiring to secure the aforesaid protection shall be obliged to comply with the formalities required by the laws of the respective countries.<sup>3</sup>

The convention is given for the better understanding of the diplomatic history of our relations with foreign nations on the subjects being considered.

## DENMARK.

A convention relating to trademarks with Denmark was concluded June 15, 1892; proclaimed October 12, 1892. It is as follows:

With a view to secure for the manufacturers in the United States of America and those in Denmark the reciprocal protection of their Trade Marks and Trade Labels, the undersigned, duly authorized to that effect, have agreed on the following dispositions:

ARTICLE I. The subjects or citizens of each of the High Contracting parties shall in the dominions and possessions of the other have the same rights as belong to native subjects or citizens, in everything relating to Trade Marks and Trade Labels of every kind.

*Provided always,* That in the United States the subjects of Denmark, and in Denmark the citizens of the United States of America, can not enjoy these rights to a greater extent or for a longer period of time than in their native country.

ART. II. Any person in either country desiring protection of his Trade Mark in the dominions of the other must fulfill the formalities required by the law of the latter, but no person being a subject or citizen of one of the contracting States shall be entitled to claim protection in the other by virtue of the provisions of this convention, unless he shall have first secured protection in his own country in accordance with the laws thereof.<sup>4</sup>

<sup>1</sup> Appendix, Chap. XVIII, sec. 8, p. 332. <sup>3</sup> Appendix, Chap. XVIII, sec. 13, p. 337.

<sup>2</sup> Ante, p. 51.

<sup>4</sup> Appendix, Chap. XVIII, sec. 4, p. 329.

## JAPAN.

A treaty of commerce and navigation between the United States of America and Empire of Japan was concluded November 22, 1894; proclaimed March 21, 1895. This treaty contained an article on trade-marks, joined with patents and designs, as follows:

ART. XVI. The citizens or subjects of each of the High Contracting Parties shall enjoy in the territories of the other the same protection as native citizens or subjects in regard to patents, trademarks, and designs, upon fulfillment of the formalities prescribed by law.<sup>1</sup>

This article was by special convention concluded January 13, 1897; proclaimed March 9, 1897, made immediately operative:

The President of the United States of America and His Majesty the Emperor of Japan, being desirous of securing immediate reciprocal protection for patents, trademarks, and designs, have resolved to conclude a Convention for that purpose, and have appointed as their Plenipotentiaries:

\* \* \* \* \*

Article XVI of the Treaty of Commerce and Navigation between the United States of America and Japan, concluded at Washington on the twenty-fourth day, the eleventh month, the twenty-seventh year of Meiji, corresponding to the twenty-second day of November, eighteen hundred and ninety-four of the Christian Era, shall have full force and effect from the date of the exchange of ratifications of this Convention.

## FOREIGN LAWS RELATING TO TRADE AND OTHER MARKS.

Foreign laws relating to marks may be divided into two classes, viz, (1) those which make registration declaratory of right to the mark, and (2) those which make registration attributive of right to the mark.

The laws of France<sup>2</sup> belong to the first class, and the validity of a registered mark may be questioned in the French courts, notwithstanding registration. The laws of Germany,<sup>3</sup> etc., belong to the second class, and the validity of the registered mark can not be questioned collaterally, since the registration is the basis of every right. No protection, therefore, is afforded to unregistered marks by the laws of the latter countries, even if they are such marks as may be registered, and the question of prior use is never raised, since the title is not based on use. The result of the attributive system is beneficial in this, that any person desiring to make use of a particular mark may, by examining the register, determine whether or not that mark is already appropriated by another; and if he does not find the mark, he may himself register it and use it with the certainty that, so long as he keeps his registration in force, he can not be interfered with in the use of the mark by a prior user or by any other person.

Such a law is open to the objection that it permits well-known but unregistered marks to be registered by and become the property of any person who chooses to apply for registration, but in answer to this objection it must be said that such a result is due not to anything in the law, but to the laches on the part of the original owner of the mark. It can not be considered unreasonable to require anyone who seeks to protect his rights to notify the public of his claim promptly, if he would maintain that claim.

<sup>1</sup> Appendix, Chap. XVIII, sec. 9, p. 332.

<sup>2</sup> Appendix, Chap. XXIII, p. 363.

<sup>3</sup> Appendix, Chap. XXII, p. 352.

Under the class of declaratory laws of which those of France have been given as an example, registration is a prerequisite of right to sue for a violation of the exclusive use of the mark. In the case of attributive laws registration is necessarily so.

There is great variation in the character of the marks which may be registered. In some countries single words can not be registered, no matter whether newly coined or not; in others single words other than the names of persons and places may be registered, and the latter may be registered in a special form. Coats of arms and marks not subject to the rules of good morals can not be registered.

Commercial or trade names as a rule are the subject of special protection and do not receive that provided for trademarks—so also the names of localities.

Many foreign trademark laws, as well as those of many of the States of the United States, provide for the registration of trade-marks which are used by associations of workmen or of manufacturers or dealers who, by reason of being located in the same region, or for other reasons, have agreed upon a particular mark to distinguish the place of manufacture or origin, or the workmen engaged on a particular manufacture.<sup>1</sup>

In those countries where the registration of a mark is attributive of property in the registered mark, it is apparent that use before application for registration need not be made essential and that the registration of marks which are *intended* to be used may be allowed. In Great Britain a mark may be and is frequently registered in all classes, although used in one only, for the purpose of preventing that confusion which sometimes happens because of the use of the same trademark by different manufacturers on goods sold through the same dealers, although of different classes.<sup>2</sup> Article 4 of the Convention of Paris, 1883, refers to registration and not to use. It seems to refer to the case of a merchant who, desiring to establish a trade in a certain product, registers the mark he proposes to use in connection therewith and seeks thereby to escape the danger and expense of the use of the mark before a determination as to its validity and its right to registration. If Congress can pass a law to carry into effect the treaties and conventions which we have entered into on the subject of trademarks, it can provide for the case of the foreign manufacturer who has registered at home before use and seeks also to register here, and vice versa for the citizens of the United States who seek registration abroad in anticipation of foreign trade. We further see no distinction in the regulation of commerce by means of marks, between the filing of a mark in use or intended to be used. The filing of the mark is merely notice giving certain rights in case of use.

The formalities required for registration in foreign countries are usually few and simple.<sup>3</sup> Practically nothing is required beyond a statement sufficiently full to identify the applicant, a facsimile or specimen of the mark, and a statement of the class of goods to which it is or is intended to be applied. No elaborate description is required, nor is it necessary for the applicant to attempt to distinguish the essential features of his mark. The application may in many of these countries be made upon a simple form furnished by the registry office, which

<sup>1</sup> Appendix, Chap. XXI, p. 349, etc.

<sup>2</sup> By section 75 of the law of Great Britain application for registration is made the equivalent of public use. See Appendix, p. 375.

<sup>3</sup> See Trademark law of France, Appendix, Chap. XXIII, p. 363.



can be filled out by any person of intelligence.<sup>1</sup> In Great Britain a disclaimer is required in certain cases and is the subject of differences of opinion among jurists. Some take the ground that the effect of the disclaimer is to allow the trademark to be evaded by the dishonest, and say that the courts in order to avoid its effects are taking jurisdiction of cases where the defendant is said to be passing off his goods for those of another.

The fees for registration are in most cases very small. In 14 out of 26 principal countries the fees are less than \$5, averaging less than \$3; in 4 others, less than \$10; in 6 others, less than \$14 (in 4 of these 6). The fees for renewal are less than \$3. In only 2 countries are the fees for registration greater than in the United States, viz, Argentine Republic \$40, and Canada \$30, for general trademarks.

The term of registration in most countries is comparatively short. It is 10 years in 17 of 28 principal countries providing for registration; not over 15 years in 6 others; 20 years in 3 others; 25 years or longer in 2 countries.

Registration may be renewed in all of them indefinitely on payment of a fee generally less than \$5. If not renewed, as a general rule, all rights secured by registration lapse. In some cases, as in Portugal, the mark falls into the public domain and may at once be adopted and registered by another, or may be adopted and registered by any other after the expiration of a definite period, e. g., in Germany, after 2 years.

The registered mark under most laws is transferable in connection with the business and good will only. This provision is considered to be in the interest of the public. To permit a trademark to be transferred from a manufacturer without anything else, or to permit the owner of the mark to license others to use it is promotive of fraud upon the purchasing public.

It is generally provided in foreign trademark laws that the foreign owner of a trademark shall be entitled to registration of and protection for his trademark, but conditional on the validity of the mark in the country where applicant for registration resides, proved by the registration there.

It is provided in many foreign trademark laws that an applicant for registration of a trademark shall in his application appoint a representative in the country,<sup>2</sup> or, as in the trademark laws of Great Britain, shall "give the comptroller an address for service."<sup>3</sup> In other words, these laws recognize the necessity for the owner of a trademark who seeks the protection of the laws of the country to so far place himself within the jurisdiction of the courts of the country that legal notice of any proceedings adverse to the rights claimed by him may be served upon him in the country.

All the foreign trademark laws considered contain provisions for punishing by fine or imprisonment those who willfully and fraudulently counterfeit or imitate the registered trademark of another. Such laws also provide for suits for damages and some even compel the publication of the decision, if against the defendant, at his expense.

<sup>1</sup> See blank form used for international registration. (Appendix, Chap. II, sec. 6, p. 176.

<sup>2</sup> Appendix, Chap. XIV, p. 294.

<sup>3</sup> Patents, etc., act of 1888, p. 297.

## PRESENT NECESSITY OF REGISTRATION OF ALL MARKS USED IN COMMERCE.

The system of adoption and use of marks on goods to distinguish them from other goods of the same kind (without registration) has become practically a pitfall for all who are engaged in commerce. In a directory of stove marks made a few years ago the familiar marks of an acorn, a star, etc., were each stated to be used by from two to fifteen manufacturers. This, no doubt, occurred because of the bulky character of the article, which prevented a maker in one section of the country from confusing his stoves with those in another section. But the means of communication are now so easy and trade so great that this noninterference is not likely to continue, if it has not already stopped, unless both users of the means of commerce are very small. But as the law now stands the small user of commerce for his wares is entitled to the same rights as the large, and it is not an infrequent occurrence that the user of commerce in a large way finds himself confronted with the fact that an extremely small dealer has a right which he, the large dealer, can neither purchase nor disregard, to his great loss.

The operation of the British marks act of 1862 showed practically the difficulty arising from nonregistration. Hardingham, an English text writer, says, speaking of the law of 1862:

It was almost impossible to ascertain whether any particular device which a manufacturer might wish to adopt as a distinguishing mark for his goods was novel, or had already been appropriated. This led to the act of 1875, which, in effect, provides that no emblem or distinctive device applied to articles of manufacture or commerce need be recognized as a trade-mark unless it be duly registered.<sup>1</sup>

The first section of the British trademarks registration act of 1875 is as follows:

1. A register of trade-marks, as defined by this act and of the proprietors thereof, shall be established, under the superintendence of the commissioner of patents, and from and after the first day of July, one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceedings to prevent the infringement of any trade-mark, as defined by this act, until and unless such trade-mark is registered in pursuance of this act.<sup>2</sup>

Again the same thought is expressed in the reasons accompanying the proposed trademark law presented to the Chamber of the States General of The Netherlands in 1879. It is translated in British Commercial Report No. 12. of 1879, as follows:

The State should afford an opportunity to the public to acquire authentic information with regard to those marks, for the exclusive right to which application may have been made. The means afforded for depositing and reporting marks in places accessible to the public conduce to this object. By this means the precise nature of the mark itself, as well as the date from which the general employment of such mark ceases to be allowed, will be exactly determined. In this way it will be possible for persons interested to prove their right in a similar and inexpensive manner, while other persons can secure themselves against the unintentional assumption of a mark similar to one already used by another person.

The pecuniary loss to the innocent user of a mark already adopted and used by another is very serious and generally unjust; but a fine or imprisonment under a penal statute where there is no means of determining surely what are the existing trademarks would be unbearable,

<sup>1</sup> Hardingham Trade-Marks, London, 1881, p. 1.

<sup>2</sup> 38 and 39 Vict., ch. 91.



and is the chief argument against such a statute, which might well be made for the punishment of the willful and dishonest infringer.

All foreign trademark laws provide for registration and reward the registrant by making the registration a prerequisite to suit. This is under both the attributive and declaratory systems of which we have before spoken. There may be registration and the court may still have the right to pass upon the character of the mark as now.

Besides, the treaties of the United States with Russia, France, Austria-Hungary, Brazil, Great Britain, Belgium, Serbia, Italy, and Japan all require the citizen of the United States to register in the country where his commerce or trade is carried on in order to obtain the rights of citizens there. In the case of Russia we required registration in the United States of Russian marks before we had passed a law to provide for the registration of the same.

#### REGULATION OF COMMERCE THROUGH THE REGULATION OF MARKS HISTORICALLY CONSIDERED.

As early as 1791 the proper practice under the Constitution was indicated by Thomas Jefferson, then Secretary of State, to whom was referred the petition of a sailcloth maker of Massachusetts for the registration of his trademark.

DECEMBER 9, 1791.

The Secretary of State, to whom was referred by the House of Representatives the petition of Samuel Breck and others, proprietors of a sail-cloth manufactory in Boston, praying that they may have the exclusive privilege of using particular marks for designating the sail-cloth of their manufactory, has had the same under consideration, and thereupon

Reports, That it would, in his opinion, contribute to fidelity in the execution of manufactures, to secure to every manufactory, an exclusive right to some mark on its wares, proper to itself.

That this should be done by general laws, extending equal right to every case to which the authority of the Legislature should be competent.

That these cases are of divided jurisdiction: Manufactures made and consumed within a State being subject to State legislation, while those which are exported to foreign nations, or to another State, or into the Indian Territory, are alone within the legislation of the General Government.

That it will, therefore, be reasonable for the General Government to provide in this behalf by law for those cases of manufactory generally, and those only which relate to commerce with foreign nations, and among the several States, and with the Indian Tribes.

And that this may be done by permitting the owner of every manufactory to enter in the record of the court of the district wherein his manufactory is, the name with which he chooses to mark or designate his wares, and rendering it penal to others to put the same mark on any other wares.<sup>1</sup>

We deem the report of Jefferson conclusive on the question of the connection between the regulation of commerce under the Constitution and the securing "to every manufactory an exclusive right to some marks on its wares proper to itself." Jefferson was intimately acquainted with the causes, mainly commercial, which led to the adoption of the Constitution. The note to it, at page 17, Revised Statutes, says:

In January, 1786, the legislature of Virginia passed a resolution providing for the appointment of five commissioners, who, or any three of them, should meet such commissioners as might be appointed in the other States of the Union, at a time and place to be agreed upon, to take into consideration the trade of the United States, to consider how far a uniform system in their commercial regulations may be necessary to their common interest and their permanent harmony, and to report to the several States such an act relative to this great object as, when ratified by them, will enable the United States in Congress effectually to provide for the same.

<sup>1</sup> Jefferson's Complete Works, Washington, 1854, vol. 7, p. 563.



The Articles of Confederation had only been adopted July 9, 1778, and contained an Article IV, as follows:

The better to secure and perpetuate mutual friendship and intercourse among the people of the different States \* \* \* the people of each State shall enjoy therein (in every other State) all the privileges of trade and commerce, subject to the same duties, impositions, and restrictions as the inhabitants thereof respectively, provided that such restrictions shall not extend so far as to prevent the removal of property imported into any State to any other State of which the owner is an inhabitant. \* \* \*

This was a treaty in effect, and applied the State restrictions as to marking, etc., which then existed.

That there was not sufficient demand at the time of Jefferson's report or for seventy-nine years afterwards for a law to put into effect his recommendations does not at all modify the authority of the report on the subject of the power of the Congress. Laws requiring the marking of certain goods, e. g., tobacco, flour, pork, etc., before sale or shipment, existed in the Colonies and were continued by the States after the adoption of the Constitution, but no State law was enacted "to prevent fraud in the use of false stamps and labels," i. e., marks used in trade, until 1845, in New York. State laws under different titles but all looking toward the protection of the public by means of the regulation of marks on goods were passed in Connecticut in 1847; Pennsylvania, 1847; Massachusetts, 1850; Ohio, 1859; Iowa, 1860; Michigan, 1863; Oregon, 1864; Nevada, 1865; Kansas, 1866; Maine, 1866; Missouri, 1866. These are all the State statutes on the subject of optional marks used in the commerce within the State making the law until the national law of 1870.

In the preface of his Treatise on the Law of Trade-marks (Albany, N. Y., 1860) Francis H. Upton says that no other book had been previously published on the subject. The next book was Cox's American Trademark Cases (Cincinnati, 1871), purporting to publish nearly all the trade-mark cases tried in this country in the civil courts in chronological order. The first trademark case proper reported was decided in the year 1837. This was followed by one case in each of the years 1844, 1846, 1847, 1848, two in the year 1849, one in 1850, one in 1851, one in 1853, three in 1854, two in 1855, three in 1856, six in 1857, one in 1859, six in 1860, one in 1861, and two in 1862, one in 1863, and one in 1864, three in 1865, seven in 1867, seven in 1868, four in 1869, and three in 1870, making a total of 62, with which were included five others about newspaper names, four about hotel names, and others about names of stores, etc.

#### CONSTITUTIONALITY OF PROPOSED ACT.

The draft of the act submitted to Congress is, we submit, within the constitutional authority of Congress.

The Trademark Cases (100 U. S., 82) ruling upon the act of 1870 held (1) that authority to solely legislate did not fall within the provision of the Constitution relating to inventions and copyrights, and (2) that the act in question, relating as it did to all trademarks, whether interstate or intrastate, was broader than the constitutional authority. It was expressly pointed out that an act relating to trademarks applicable only to commerce with foreign nations and with the Indian tribes and to interstate commerce was not ruled upon.

Every article to which the mark, trademark, or commercial name, provided in our draft of an act is to be applied, is, of course, the subject-matter of commerce, foreign, interstate, or with the Indian tribes. The effect of the proposed bill will be to prohibit the taking of these

goods into interstate or foreign commerce unless they bear such character of marks as are provided for. The ultimate purpose of such marks is to so identify and individualize the articles of commerce that the purchaser may know, without question, the country of their origin, and the identity of the manufacturer, and, to a large extent (for quality frequently depends on the identity of the manufacturers), the quality and character of the article. Identification by means of a registered mark prevents an unscrupulous competitor from imposing upon the public articles different from what the public may have previously known, and naturally supposed itself to be buying. It is in this respect a protective measure, not simply of the manufacturer, but of the purchaser as well.

It has frequently been held that commerce in merchandise may, for the protection and purposes suggested, be regulated by the police powers of the several States. (*Pittsburg & S. Coal Co. v. State of La.*, 156 U. S., 590; *Turner v. State*, 107 U. S., 38; *Patapsco Guano Co. v. Bd. of Agriculture of N. C.*, 171 U. S., 345.) It is also in effect ruled, we think, in *Schollenberger v. Pennsylvania* (171 U. S., 1), in *in re Kollock* (165 U. S. 526), and in *Addyston Pipe & Steel Co. v. United States* (175 U. S., 211) that where such protective legislation is made to apply to articles that enter into interstate or foreign commerce the power of Congress under the interstate commerce clause is plenary. Indeed, it would be an anomaly, and a departure from all settled conception of the interstate commerce clause, if regulation relating to national and foreign commerce, which in its nature must be national, could not be brought under the authority of that clause. If the State may, in these matters of regulation, either by restriction or by conditional allowance, affect commerce within its own territory, what argument can there be against a like power in the National Government, under the commerce clause, when the need of a national regulation becomes apparent. The proposed act regulates solely the production, control, and disposition of property in its relation to interstate and foreign commerce.

If Congress should conclude not to pass this proposed act in its entirety, but to confine itself to an act providing for registration as declaratory only, we submit that the foregoing views are still applicable. Such registration is, in its essence, although not to so apparent an extent, preventive of fraud upon the public by the identification of articles of commerce with their proper owners. It is a measure not simply for the benefit of the producer; it is equally beneficial to the purchasing public. Around this realization—protection to the public—has recently grown up the whole doctrine of prevention of unfair competition. Legislation therefor, though it goes only to the limited extent of declaratory registration, is, in the long run, legislation to protect, by designated regulation, the public, as well as the producer, in touch with foreign or interstate commerce.

The foreign laws, of which a summary of the chief characteristics has been given, have been made use of in framing the proposed bill with which we accompany this report. We have stated in the *proposition for a law* our conclusions as to the possible extent of such a law, but do not wish to be understood as expressing any opinion as to the expediency of the proposed act.

We ask the opportunity of here thanking the learned and experienced gentlemen who, with patriotic motives, appeared before us and gave us the result of their experience, and also those who expressed



their opinions in writing. We have appended to this report copies of the treaties, conventions, agreements, and declarations referred to in the report; also the reports of delegates from the United States under the Convention of Paris, 1883, to the several conferences thereunder and various matters historically connected with that Convention, the legislation of certain countries on the subject of industrial property, certain conventions between foreign nations, also extracts from the Congressional Globe and Record presenting the debates in Congress on the subject of trademarks. We believe that these various papers will greatly aid the Congress in arriving at a right conclusion on the recommendations made by us.

Respectfully submitted.

FRANCIS FORBES.

PETER STENGER GROSSCUP.

I concur fully in the above report and recommendations, so far as they relate to changes in the patent law, and in the proposed bills in which such recommendations are embodied. So far as the portion of the report relating to trade and other marks is concerned, while I concur fully as to the extent of the constitutional authority of Congress to provide for the registration and protection of trademarks used in commerce among the several States, as well as those used in commerce with foreign nations, and as to the necessity for so amending the present law as to give full force and effect to the provisions of the International Convention and other treaties, to secure the general registration of all marks used in interstate or foreign commerce by reducing the fee for registration, by making more simple the procedure necessary to secure registration, and by giving to registered marks advantages not given to unregistered marks, and while I believe the proposed bill may be enacted into law by Congress without exceeding the authority conferred by the commerce clause of the Constitution, I can not join in presenting a proposed bill which seems to abrogate the common-law rights now enjoyed by owners of trademarks and carries the regulation of interstate commerce to such an extent as the bill proposed by my colleagues.

In my opinion the legislation called for by the needs of our growing commerce, both interstate and foreign, is in the direction of affording fuller protection to the rights acquired under the common law rather than in the direction of changing the mode of acquiring the right to the exclusive use of a mark. In accordance with this opinion I submit a draft of a proposed bill to revise the laws relating to trademarks, which, without abrogating in any respect the common-law rights of the owners of trademarks, satisfies, in my opinion, the present needs of our trademark interests.<sup>1</sup>

In order to make my position in this matter clear I submit, in connection with my proposed trademark bill, a review of the history of trademarks and trademark legislation in the United States, for the purpose of indicating the origin, development, and extent of the protection to trademarks afforded by the common law, as I understand it.<sup>2</sup>

Respectfully submitted.

ARTHUR P. GREELEY.

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<sup>1</sup>See page 126.

<sup>2</sup>See page 89.





## PROPOSITION FOR THE REGULATION BY THE CONGRESS OF THE UNITED STATES OF THE USE OF MARKS IN COMMERCE.

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It seems desirable at the present time that all marks which have more than a local use should be regulated by a single law applicable to the entire territory of the United States.

Such a law should so state the intent of Congress that no question may arise as to its power to make the law.

It should apply to all marks used in commerce extending beyond the boundaries of a single State, whether marks of an agriculturist, a manufacturer, a merchant, a community, a union of persons, or a common carrier, and whether obligatory or optional.

It should provide for registration and notice thereof, in order—

That the law may not be unwittingly violated;

That treaty obligations may be fulfilled; and

That home registration by our citizens, when a prerequisite to foreign registration, may be secured.

It should make such registration easy and cheap, e. g., as copyright now is; and for that purpose should provide statutory forms as in copyright.

It should reward registration under it.

It should provide means—

For cancelling registration;

For repressing and punishing any unlawful use of marks and awarding damages to parties injured thereby;

For repressing deceptive marks on foods and medicines;

For repressing marks falsely indicating inspection wherever inspection is required; and

For excluding from the United States goods, bearing misleading marks, or not marked as required by law.

*The chief points of difference between the provisions of this bill and those of the present trademark act of 1881 are these :*

The present bill proposes to cover the regulation of commerce with foreign nations, and among the several States and with the Indian tribes, and in the territory of the United States not included within the several States, in so far as concerns marks affixed to objects of commerce for identification or for information, whether optional or obligatory. The act of 1881 relates only to the very limited class of trademarks which are used in foreign commerce or in commerce with the Indian tribes.

The present bill provides—

For a simple form of application for registration, waiving no rights, instead of the complicated description required under the act of 1881, and the limitation to an essential feature required by the rules;

For a short period of registration of ten years instead of the long period of thirty years, under the act of 1881;

For a small fee for registration in place of the large one now exacted.

It more clearly states what marks shall be refused registration and

leaves the determination of questions as to the character of a mark to the courts of the United States for determination after a hearing.

*The present bill provides, in addition to the provisions of the act of 1881—*

For opposition to registration by interested parties;

For cancellation of registration at the instance of an injured party;

For notice of registration attached to the mark;

For legal redress for the wrongful use of registered marks in interstate and territorial commerce.

For punishment as a misdemeanor of the unlawful use or imitation of a registered mark;

For seizure in transit of goods bearing simulated registered marks, etc.;

For seizure of foods and medicines bearing deceptive marks, or false marks of inspection, also for their exclusion from the United States.

It includes obligatory marks heretofore made part of tariff acts, of inspection laws, etc.

#### ARRANGEMENT OF BILL.

##### Section.

- Title stating object of bill.
1. Short title by which act shall be known.
2. Object of act.
3. Country of origin and quantity to be marked.
4. Foods and medicines bearing deceptive marks or false marks of inspection.
5. Persons entitled to exclusive use of mark—Liability for misuse.
6. Registration of certain marks permitted—Of what denied.
7. Form of application for registration—Form of affidavit to accompany the same—Drawing—Register of addresses of nonresidents.
8. Priority under conventions.
9. Examination of application—Publication of mark—Form of certificate of registration—Date of certificate—Duration of registration—Certificate may issue to assignee.
10. Notice of refusal of registration.
11. Notice to interested parties—Opposition to registration.
12. Interference or opposition—Procedure.
13. Cancellation of registration.
14. Appeal from examiner of trademarks to Commissioner.
15. Appeal from Commissioner to court of appeals of District of Columbia.
16. Notice of appeal.
17. Proceedings upon appeal.
18. Determination of appeal and its effects.
19. Appeal from court of appeals of District of Columbia to the Supreme Court of the United States.
20. Registration obtainable by bill in equity.

##### Section.

21. Renewal of registration.
22. New application for registration of mark already registered.
23. Fraudulent registration—Damages.
24. Transfer of trademarks.
25. Registered trademarks must be marked as such.
26. Penalty for falsely marking an unregistered mark.
27. Actions for infringement—Damages.
28. Pleadings and proofs in such actions.
29. Power of court to grant injunction and assess damages—To impanel jury.
30. Application for registration equivalent to use.
31. Offenses against trademarks.
32. Seizure of articles bearing an imitation of a registered trademark or of a commercial name.
33. Articles bearing imitations of a registered trade-mark or of a commercial name forbidden entry.
34. Fees, Costs.
35. Saving clause.
36. Construction of terms—Territory—Person—Number—Gender—Applicant—Registrant—Infringement—Imitation—A fixed—Knowingly—Country of origin.
37. Construction of act.
38. Pending applications.
39. Registrations heretofore made—Act of 1870—Act of 1881.
40. Registration by residents of Hawaii.
41. International registration of trademarks.
42. Amendatory and repealing statutes.
43. Repeal.
44. When act to take effect.



A BILL to regulate and protect marks, trade-marks, commercial names, and symbols used in commerce, and to enforce treaties regarding the same.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,*

#### SHORT TITLE.

SEC. 1. This Act shall be known as the trade-marks Act.

#### OBJECT OF ACT.

SEC. 2. All marks, trade-marks, commercial names and symbols used in commerce with foreign nations or among the several States or with the Indian tribes or in the territory of the United States shall be used and their use protected in the manner herein prescribed.

#### COUNTRY OF ORIGIN AND QUANTITY TO BE MARKED.

SEC. 3. All articles manufactured in foreign countries, upon importation into the United States, shall be plainly marked in legible English words, in a conspicuous place, with the name of the country of their origin, or, when from the character or size of the articles this can not be done, the package in which one or more of such articles are inclosed shall be marked in the same manner with the name of the country of their origin together with a plain statement of the quantity of the contents of such package; in default of which the same shall not be admitted to entry at any custom-house of the United States.

The Secretary of the Treasury may make rules permitting the marking of such articles and packages and the amendment of the statement of quantity, and such prohibition of entry shall, when such rules are complied with, be removed.

#### FOODS AND MEDICINES BEARING DECEPTIVE MARKS OR FALSE MARKS OF INSPECTION.

SEC. 4. Any article commonly used as a food or a medicine, to which is affixed

1. A mark likely to deceive the consumer as to the place of its origin or as to its composition, or

2. A mark falsely indicating inspection under the laws of the United States or of any foreign government

shall be refused entry at every custom house of the United States, and may be seized by the marshal of the proper district under written authority of the district attorney of any district of the United States in which the same or a part thereof may be found, in transit to or from a foreign nation, or Indian tribe, or among the several States, or over the territory of the United States, but not in transit in bond. Any person may file information with the district attorney of the proper district, in which case the proceedings shall be for the joint benefit of such informer and of the United States, in equal parts.

The district attorney by whose authority the seizure was made shall forthwith institute proceedings *in rem* in the name of the United States, in the district court of the district, or in the territorial court of the Territory, or in the Supreme Court of the District of Columbia, within which the said property or any part thereof may be found, for the condemnation and sale of the property seized, which proceedings

shall conform as nearly as may be to proceedings in admiralty or revenue cases. And if it shall be found that the provisions of this section have been violated in respect to the said property, the same shall be condemned and sold or destroyed as the court may decree, and the proceeds thereof, if sold, paid to the Treasurer of the United States to the use of the United States, or one-half to such Treasurer and the other half to the person filing an information therein, as hereinbefore provided.

PERSONS ENTITLED TO EXCLUSIVE USE OF MARK—LIABILITY FOR MISUSE.

SEC. 5. A citizen of the United States, or a person residing therein, a member of an Indian tribe, or a citizen or subject of a government which by treaty or convention affords similar privileges to citizens of the United States, or a person who has a bona fide industrial or commercial establishment in the territory of such government, may adopt for his use in commerce with foreign nations or among the several States or with the Indian tribes or in the territory of the United States a mark to distinguish his produce, his manufacture, or his merchandise or the merchandise over which he has control as a common carrier or in the production of which he has taken part and shall be entitled to the exclusive use of such mark in such commerce on complying with this Act. Another person making use of the same in such commerce shall be liable therefor as hereinafter provided.

REGISTRATION OF CERTAIN MARKS PERMITTED—OF WHAT DENIED.

SEC. 6. A person mentioned in the last section may apply for the registration of a mark adopted by him for use as hereinbefore provided, and the same may be registered on the payment into the Treasury of the United States of the fees prescribed in this Act,

(a) Provided, that there shall not be registered, except as herein otherwise specified:

1. Public arms or decorations, including the national flag.
2. A word or words denoting the nature or quality of the goods, or a geographical name or names, unless the applicant states in his application that he makes no claim of exclusive right to the use of those words or names.
3. The name of a person, unless such name be in a distinctive shape, or consist of the written signature in original or facsimile of the person who makes the application:
4. A mark contrary to good morals.

(b) Provided further, that at the time of making such application no other person entitled to register said mark shall have previously used the same on the same class of goods in commerce with foreign nations, or among the several States, or with the Indian tribes, or in the territory of the United States, and the same shall not have been abandoned; except, however, that whenever it shall appear that an applicant for registration or a registrant, at the time of making the application for registration, believed himself to be the first to adopt and use the mark on the same class of merchandise, registration shall not be refused, nor shall said mark or the registration thereof be held invalid because of its use in a foreign country or within a single State without registration.

- (c) Provided further, that every trade-mark duly registered in a country with which the United States has by treaty or convention provided for the reciprocal registration of trade marks shall be entitled to registration pursuant to the terms of such treaty or convention. But no citizen or subject of a foreign government or person who has a bona fide industrial or commercial establishment in the territory of such government, and not residing in the United States, otherwise entitled to register a mark under this Act, shall be entitled to such registration until the mark sought to be registered shall have been registered by such foreign government as a trade-mark valid within its jurisdiction.
- (d) Provided further, that nothing in this Act shall affect the right of a person resident in a State to the use of a mark used solely within the boundaries of such State.

## FORM OF APPLICATION FOR REGISTRATION.

SEC. 7. Before a mark shall be registered application therefor must be made to the Commissioner of Patents in the following form in duplicate.

To the Commissioner of Patents of the United States of America:

I (we), \_\_\_\_\_, apply for the registration as of (date) \_\_\_\_\_, of the annexed mark as a trade-mark, and state as follows: The principal place of business of applicant(s) is \_\_\_\_\_, and applicant(s) has (have) a bona fide industrial (or commercial) establishment in \_\_\_\_\_. Applicant(s) is (are) resident(s) of \_\_\_\_\_, and a citizen(s) of \_\_\_\_\_: is incorporated and exists under the laws of \_\_\_\_\_.

Applicant(s), when not residing in the United States, authorize(s) service of all papers or process relating to said mark and provided by this Act on the Secretary of the Treasury of the United States with the same force and effect as if served personally.

The mark is used (or, is intended to be used) in commerce with foreign nations or among the several States, or with the Indian tribes or in the territory of the United States, on the following class of goods: \_\_\_\_\_.

(If applicant is not a resident of the United States he must state his foreign registration as follows:) The mark is registered as a trade-mark in \_\_\_\_\_, under the number \_\_\_\_\_, for the period of \_\_\_\_\_, for the following class of goods: \_\_\_\_\_. (If a date of registration prior to date of filing is desired, applicant must state:) The date of first application in any foreign country is \_\_\_\_\_; application filed in \_\_\_\_\_. The registration of said trade-mark in (name country of origin) \_\_\_\_\_ is now in full force, but may expire or become void because of the following (insert causes for which it may expire or become void): \_\_\_\_\_.

The following is a copy of the mark for which registration is sought:

<p>Marks to be inserted.</p>
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Date (place, day, month, and year) \_\_\_\_\_. \_\_\_\_\_.



The application must be signed by the applicant or applicants, who shall annex thereto his or their oath in the following form:

#### FORM OF AFFIDAVIT.

(Place where oath is made), ss.

\_\_\_\_\_, being duly (severally) sworn (affirmed) says (say): I am (we are) (or, if the applicant is a corporation, the president, secretary, or director of) the applicant (s) named in the annexed application; so far as I (we) know and am (are) informed, and to the best of my (our) belief, the applicant (s) or his (their) predecessor (s) in the business was (were) the first to adopt and use or adopt the mark shown in such application to distinguish his (their) produce, his (their) manufacture, or his (their) merchandise, and the same does not so nearly resemble a mark previously adopted and used or adopted by a person, firm, or corporation other than applicant (s) as to be likely to cause confusion or mistake in the minds of the public or to deceive purchasers. The said mark has been used (or is intended to be used) in commerce with foreign nations, or among the several States, or with the Indian tribes, or in the territory of the United States, and the statements made in the annexed application are true.

Subscribed and sworn to (or affirmed) before me this \_\_\_\_\_ day of \_\_\_\_\_.

The oath may be made before any person within the United States authorized by law to administer oaths, or without the United States before any minister, charge d'affaires, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be.

#### DRAWING.

The applicant shall file in addition thereto a drawing of said mark, or a facsimile thereof, or a block for printing the same, one or all, as shall be prescribed by the Commissioner of Patents.

#### REGISTER OF ADDRESSES OF NONRESIDENTS—NOTICE TO THEM.

The applicant, if not a resident of the United States, shall file with the Secretary of the Treasury his name and address for service under such rules as may be made by such Secretary establishing fees and regulations for such filing and the service connected therewith.

The Secretary of the Treasury shall keep a register of names and addresses so filed with him, and shall forthwith forward by mail to each applicant, at his last registered address, every paper or process served upon him in lieu of personal service upon such applicant pursuant to this Act.

#### PRIORITY UNDER CONVENTIONS.

SEC. 8. A person entitled to the registration of a trade-mark under this Act who has applied for the registration of a trade-mark in any foreign country which by treaty or convention affords similar privileges to citizens of the United States, may file the application prescribed in

the last section in the Patent Office of the United States as of the date of filing of his first application in such a foreign country, if four months shall not yet have expired, and such filing shall have the same force and effect as though made on said date. Proof of such filing may be made by a certified copy thereof, or in such other manner as may be required by the Commissioner of Patents.

#### EXAMINATION OF APPLICATION—PUBLICATION OF MARK.

SEC. 9. On the filing of such application and the payment of the fees required by law, the Commissioner of Patents shall cause the application to be examined by the examiner in charge of trade-marks.

If it appear on such examination—

- (a) That the applicant is one of the persons mentioned in section five of this Act; and
- (b) That the mark is entitled to registration as herein provided; and

If no notice of opposition to its registration be filed as herein provided,

the Commissioner shall cause the mark to be published in the Official Gazette of the Patent Office.

At the expiration of thirty days from such publication, unless notice of opposition shall previously have been given as herein provided, the Commissioner shall register the mark as a trade-mark and issue a certificate thereof in the following form, to which shall be attached one of the duplicate copies of the application filed in the Patent Office:

#### FORM OF CERTIFICATE OF REGISTRATION.

The United States of America.

To all to whom these presents shall come:

This is to certify that \_\_\_\_\_ on the \_\_\_\_\_ day of \_\_\_\_\_, made application for the registration of the annexed trade-mark in the form annexed, and that the same has been registered for \_\_\_\_\_ for the term of \_\_\_\_\_ years, unless sooner terminated by provision of law.

In testimony whereof the seal of the Department of the Interior is hereto affixed this \_\_\_\_\_ day of \_\_\_\_\_, and of the independence of the United States the

Given under my hand at Washington, District of Columbia.

\_\_\_\_\_,  
Commissioner of Patents.

#### DATE OF CERTIFICATE.

Each certificate shall bear date as of the day on which the application was filed, or as of the day when the first application was filed in a foreign country if within four months prior to such filing in the United States.

#### DURATION OF REGISTRATION.

The trade-mark shall be registered for the term of ten years, unless the applicant is a nonresident alien entitled to registration under this Act, in which case the trade-mark shall be registered for the same term as in the country of origin if such term be less than ten years.

The registration of a trade-mark of a nonresident alien shall immediately expire in case such registered trade-mark shall be declared invalid or the registration shall expire or become void in the country of origin.

#### CERTIFICATE MAY ISSUE TO ASSIGNEE.

Certificate of registration may be granted to the assignee of the applicant if otherwise entitled to register the mark; but the assignment must first be entered of record in the Patent Office, and shall remain on file therein.

#### NOTICE OF REFUSAL OF REGISTRATION.

SEC. 10. In case of refusal of the application for registration the Commissioner of Patents shall notify the applicant thereof, giving him, briefly, the reasons for such refusal.

#### NOTICE TO INTERESTED PARTIES—OPPOSITION TO REGISTRATION.

SEC. 11. If it appear on the examination directed in section nine that a person other than the applicant, prior to such application—

1. Has registered and is still entitled to the right of a registrant in a mark; or
2. Has pending an application for registration of a mark; or
3. Has previously used in commerce with foreign nations, among the several States, or with the Indian tribes, or in the territory of the United States, a mark

to which, in the opinion of the examiner in charge of trade-marks, the mark for registration of which application is made has so near a resemblance as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, the Commissioner shall give notice thereof before publication of the mark to the prior applicant, registrant, or user, who may file in the Patent Office notice of opposition, stating the grounds therefor, within thirty days, or in the case of a person whose name and address is registered with the Secretary of the Treasury, forty days thereafter, in default of which publication shall be made.

A person who would be injured by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered.

#### INTERFERENCE OR OPPOSITION—PROCEDURE.

SEC. 12. In all cases where notice of opposition has been filed, the Commissioner of Patents shall notify the applicant thereof and of the grounds therefor. The Commissioner shall, in every case of interference between pending applications when demanded by either applicant, or of opposition to registration, direct the examiner in charge of trade-marks to proceed to determine the question of priority between applicants or of the sufficiency of objections to registration, in such manner and upon such notice to those interested as he may by rules prescribe. The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark as a trade-



mark for the person first to adopt and use the mark if otherwise entitled to register the same, unless an appeal is taken from the decision by a party interested in the proceedings within such time, not less than twenty days, as the Commissioner may prescribe.

#### CANCELLATION OF REGISTRATION.

SEC. 13. Whenever a person enumerated in section five of this Act shall deem himself injured by the registration of a trade-mark in the Patent Office he may apply to the Commissioner of Patents to cancel the registration of such trade-mark. The Commissioner shall refer such application to the examiner in charge of trade-marks and give notice thereof to the registrant. If it appear after a hearing before the examiner, that the trade-mark is not used by the registrant or has been abandoned or was not entitled to registration, and if the examiner shall so decide and no appeal be taken from his decision, the Commissioner shall cancel the registration.

#### APPEAL FROM EXAMINER OF TRADE-MARKS TO COMMISSIONER.

SEC. 14. Every applicant for the registration of a mark as a trade-mark, every registrant, every party to any interference, and every person who has filed notice of opposition or has applied to the Commissioner for the cancellation of the registration of a trade-mark, may appeal from the decision of the examiner in charge of trade-marks to the Commissioner in person on payment of the fee prescribed herein and upon compliance with such rules as may be made by the Commissioner.

#### APPEAL FROM COMMISSIONER TO COURT OF APPEALS, DISTRICT OF COLUMBIA.

SEC. 15. If such party be dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia.

#### NOTICE OF APPEAL.

SEC. 16. When an appeal is taken to the court of appeals of the District of Columbia from the decision of the Commissioner of Patents, the appellant shall give notice thereof to the Commissioner and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing.

#### PROCEEDINGS UPON APPEAL.

SEC. 17. The court shall, before hearing such appeal, give notice to the Commissioner of Patents of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal.

## DETERMINATION OF APPEAL AND ITS EFFECTS.

SEC. 18. The court, on petition, shall hear and determine such appeal and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall, unless reversed or modified as hereinafter provided, govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of the registration or of the trade-mark in any court wherein the same may be called in question.

## APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA TO THE SUPREME COURT.

SEC. 19. A party to the proceeding who shall deem himself aggrieved by the decision of the court of appeals of the District of Columbia may appeal from such decision to the Supreme Court of the United States. The court, upon petition, shall hear and determine such appeal and may reexamine and affirm, reverse, or modify the decision of the court of appeals of the District of Columbia. The proceedings upon appeal shall be governed by such rules as the higher court may prescribe. The provisions hereinbefore contained touching the certificate to be returned by the court of appeals of the District of Columbia to the Commissioner, and the recording of the same in the Patent Office, shall apply with like force and effect to the Supreme Court.

## REGISTRATION OBTAINABLE BY BILL IN EQUITY.

SEC. 20. Whenever registration on application is refused, either by the Commissioner of Patents or by the court of appeals of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled according to law to registration of the mark for which he has applied. If such adjudication be in favor of the applicant, the Commissioner shall register the mark as a trade-mark, upon the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the applicant, whether the final decision be in his favor or not.

## RENEWAL OF REGISTRATION.

SEC. 21. At any time within three months before the expiration of the registration of a trade-mark, the Commissioner of Patents shall register the same anew and issue a certificate thereof upon application

in the form prescribed in section seven, and such registration shall be noticed in the Official Gazette of the Patent Office:

Provided as follows:

1. The applicant shall pay to the Commissioner of Patents the fees prescribed in this Act.
2. The applicant, at the time of the application for the renewal of registration, fulfils the conditions required as to the applicant and the trade-mark, on an original registration under this Act.
3. The trade-mark has not fallen into the public domain in the country of origin.

#### NEW APPLICATION FOR REGISTRATION OF MARK ALREADY REGISTERED.

SEC. 22. Whenever a registration is defective or inoperative or invalid for any reason, the party in interest may, on the surrender of the original certificate, apply anew, in the same form or in an amended form, for the registration of the alleged trade-mark, in which case the same proceedings shall be had as on an original application for registration, but a new certificate of registration shall be issued only for the unexpired part of the original term of registration. Such new registration shall take effect upon the issue of the new certificate.

#### FRAUDULENT REGISTRATION—DAMAGES.

SEC. 23. A person who shall procure the registration of a mark, the record of an assignment thereof or of an entry respecting a mark in the office of the Commissioner of Patents by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay to the injured party the damages sustained in consequence thereof, to be recovered in an action on the case in a circuit court of the United States.

#### TRANSFER OF TRADE-MARK.

SEC. 24. Every registered trade-mark and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the good will of the business in which the mark is used. Such assignment must be by instrument in writing, which shall be filed in the Patent Office within three months after it shall take effect by delivery or otherwise, and a notice thereof shall be published in the Official Gazette. In default of such filing, the application or registration shall lapse at the end of three months after the assignment shall take effect. Such assignment may be made in a proper case by a trustee in bankruptcy or by an officer of a court of the United States or of a State having jurisdiction over the person of the registrant, provided always that the good will of the business in which the trade-mark is used is included in such assignment.

If any such assignment shall be acknowledged before any notary public of the several States or Territories or of the District of Columbia, or any commissioner of the United States circuit court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty



of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment.

#### REGISTERED TRADE-MARKS MUST BE MARKED AS SUCH.

SEC. 25. It shall be the duty of the registrant to give notice to the public that the trade-mark is registered, either by affixing thereon the words "Registered in the United States," together with the day and year the certificate of registration was granted, at length, or abbreviated thus: "Reg. U. S. 1, 2, 99," with the day, month, or year indicated by numerals; or when, from the character or size of the trade-mark, or from its manner of attachment to the article to which it belongs, this can not be done, then by affixing a label, containing the like notice, to the package wherein are inclosed one or more of the articles to which the trade-mark is attached; and in any suit for infringement by a party failing so to give notice of registration, no damages shall be recovered by the plaintiff except on proof that the defendant was duly notified of the infringement, and continued the same after such notice.

#### PENALTY FOR FALSELY MARKING AN UNREGISTERED MARK.

SEC. 26. Every person who, for the purpose of deceiving the public, in any manner marks upon or affixes to any unregistered mark, or upon the package containing articles to which unregistered marks are affixed, the words "Registered in the United States," or any words importing that the same is registered in the United States, shall be liable for every such offense to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other half to the use of the United States, to be recovered by any person by suit in a circuit court of the United States within whose jurisdiction such offense may have been committed.

#### ACTIONS FOR INFRINGEMENT—DAMAGES.

SEC. 27. Damages for the infringement of any registered trade-mark may be recovered by action on the case in a circuit court of the United States in the name of the party interested, whether as registrant or assignee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damage sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

#### PLEADINGS AND PROOFS IN SUCH ACTION.

SEC. 28. In any action for infringement of a registered trade-mark, the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney thirty days before, may prove on the trial any one or more of the following special matters:

1. That the registered trade-mark was not properly registrable under this act; or

2. That, for the purpose of deceiving the public, the application for registration, or the oath annexed thereto, or the drawing filed therewith contained a false statement; or
3. That the registered trade-mark is used in an unlawful business or upon an article injurious in itself; or
4. That the registered trade-mark is used with design to deceive the public in the purchase of merchandise; or
5. That the registration has expired because the registration of the same mark in the country of origin has expired or become void.

And in notices as to proof of want of registrability or of false statement, the defendant shall state the names and residences of the persons alleged to have knowledge of the facts showing that the trade-mark was not properly registrable or of the falsity of the statement; and if any one of the special matters alleged shall be found for the defendant, judgment shall be rendered for him, with costs; and the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, with the like effect.

POWER OF COURTS TO GRANT INJUNCTIONS AND ASSESS DAMAGES—TO IMPANEL JURY.

SEC. 29. The several circuit courts of the United States shall have power to grant injunctions according to the course and principles of courts of equity, on such terms as the court may deem reasonable, to prevent the use by another than the registrant or his assignee of a registered trade-mark in commerce with foreign nations or among the several States or with the Indian tribes, or in the territory of the United States, or the violation of any right under any such registered trade-mark; and upon a decree being rendered in any such case against the defendant, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained by reason of the acts of the defendant; and the court shall assess the same or cause the same to be assessed under its direction.

The court shall have the same power to increase such damages, in its discretion, as is given by section twenty-seven of this Act. But, in any suit or action brought for the infringement of any registered trade-mark, there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action.

The said court, when sitting in equity for the trial of such causes, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises, as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient. And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with findings of fact.

APPLICATION FOR REGISTRATION EQUIVALENT TO USE.

SEC. 30. Application for the registration of a mark referred to in section five of this Act shall be deemed to be equivalent to the public use of the mark.

## OFFENSES AGAINST TRADE-MARKS.

SEC. 31. A person who knowingly, for use in commerce with foreign nations, or among the several States, or with the Indian tribes, or in the territory of the United States—

1. Falsely makes or counterfeits a registered trade-mark; or
2. Affixes to any article of merchandise a false or counterfeit registered trade-mark, knowing the same to be false or counterfeit, or the genuine registered trade-mark or an imitation of the registered trade-mark of another, without the latter's consent; or
3. Sells or keeps or offers for sale an article of merchandise to which is affixed a false or counterfeit registered trade-mark, or the genuine registered trade-mark or an imitation of the registered trade-mark of another, without the latter's consent; or
4. Has in his possession a counterfeit registered trade-mark, knowing it to be counterfeit, or a die, plate, brand or other thing for the purpose of falsely making or counterfeiting a registered trade-mark; or
5. Makes or sells, or offers to sell or dispose of, or has in his possession with intent to sell or dispose of, an article of merchandise with such a mark as to appear to indicate the quantity, quality, character, place of manufacture or production, or persons manufacturing or producing the articles, or inspection under the laws of the United States or of any foreign government, but not indicating it truly, shall be deemed guilty of a misdemeanor, and on conviction thereof shall be punished by a fine of not more than five hundred dollars and by deprivation of all benefits and privileges under this Act.

## SEIZURE OF ARTICLES BEARING AN IMITATION OF A REGISTERED TRADE-MARK OR OF A COMMERCIAL NAME.

SEC. 32. An article of merchandise to which is affixed an imitation of a registered trade-mark or of a commercial name, or a false or counterfeit registered trade-mark, may be seized in transit to or from a foreign nation or Indian tribe, or among the several States, or over the territory of the United States, but not in transit in bond.

Any circuit court of the United States may, upon petition duly verified by a party injured setting forth the facts and upon proper security given, direct the seizure of such merchandise by any marshal of the United States. The marshal making such seizure shall forthwith serve upon the owner of such merchandise a copy of such order and of the petition upon which the order was granted, by delivering the same to him personally if he can be found with due diligence, or if he can not be found, then to his agent, if any, from whose possession the said goods were taken, and if neither can be found, then by posting the same in a conspicuous place in or upon the building, vessel, car, or other structure or means of transportation from which the said merchandise was removed, and in either of the last two cases by mailing a copy thereof to the owner at his last known address.



Within ten days thereafter the owner of the said merchandise may apply upon affidavits to the court by which the order was granted for an order to show cause why the original order should not be vacated. Upon the return of such order to show cause the court shall determine whether the facts exist justifying the seizure. If it shall be found that these facts do not exist the court shall vacate the original order and direct the restoration of the merchandise. If it appear that the facts exist justifying the seizure, or if no application for the restoration of the merchandise be made as herein provided, the court shall direct that the same be sold at public auction, after removal of the imitation mark and due advertisement; and the proceeds of such sale, after deducting the expenses of seizure and sale and the fees of the marshal therefor, shall be paid one-half to the Treasurer of the United States and the other half to the party injured.

In any action to recover damages for wrongful seizure or sale under this section the sureties upon the bond of the petitioner may be made parties defendant, and judgment may be rendered against them in said action.

#### ARTICLES BEARING IMITATIONS OF A REGISTERED TRADE-MARK OR OF A COMMERCIAL NAME FORBIDDEN ENTRY.

SEC. 33. No article of imported merchandise to which is affixed

1. An imitation of a registered trade-mark, or
2. An imitation of the commercial name of a resident of the United States or of a citizen or subject of a government which by treaty or convention affords similar privileges to citizens of the United States, or of a person who has a bona fide industrial or commercial establishment in the territory of such government, or
3. A name calculated to induce the public to believe that the article is manufactured or produced in the United States or in a foreign country or a place other than the country or place in which it was in fact manufactured or produced

shall be admitted to entry at any custom-house of the United States.

To aid the officers of the customs in enforcing this prohibition, any registrant of a trade-mark in the Patent Office, and any person enumerated in clause 2, may require his registered trade-mark or his commercial name to be recorded in the Department of the Treasury under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of such trade-mark or commercial name, and thereupon the Secretary of the Treasury shall cause one or more copies of such registered trade-mark or commercial name to be transmitted to each collector or other proper officer of the customs.

The Secretary of the Treasury may make rules permitting, in the case of mistake, the removal of the imitation mark or commercial name or false name of country or place, and such prohibition of entry shall, when such rules are complied with, be removed.

#### FEES.

SEC. 34. There shall be paid to the Commissioner of Patents:

On filing each original application for registration of a mark, ten dollars;

On filing each application for the renewal of the registration of a trade-mark, five dollars;

On an appeal from the examiner in charge of trade-marks to the Commissioner of Patents, ten dollars;

On an appeal from the Commissioner of Patents to the court of appeals for the District of Columbia, ten dollars;

For certified and uncertified copies of certificates of registration and other papers, and for recording assignments and other papers, the same fees as required by law for copies of patents and for recording assignments and other papers relating to patents.

#### COSTS.

In all cases of notice of opposition to registration or of application for an interference, or for the cancellation of a registration or of appeal from a decision therein, the person giving notice, applying, or appealing shall file with the notice, application, or appeal security for costs to be paid to the opposing party if successful, and in default of such security, the Commissioner may refuse to entertain such proceeding and the court may dismiss the appeal.

The Commissioner of Patents shall fix, by rule, the costs to be paid to the successful party in any such proceeding or appeal in the Patent Office and the form of security therefor. The Supreme Court of the United States shall fix, by rule, the costs on appeal to or from the court of appeals of the District of Columbia, and the form of security therefor.

#### SAVING CLAUSE.

SEC. 35. The repeal of a law or any part of it specified in the annexed schedule shall not affect or impair any act done or right accruing, accrued, or acquired, or liability, forfeiture, or penalty incurred, prior to January first, nineteen hundred and three, under or by virtue of any law so repealed, but the same may be asserted, enforced, prosecuted or inflicted as fully and to the same extent as if such law had not been repealed; and all actions and proceedings, civil or criminal, commenced under or by virtue of the law so repealed, and pending on December thirty-first, nineteen hundred and two, may be prosecuted and defended to final effect in the same manner as they might under laws then existing, unless it shall be otherwise specially provided by law.

#### CONSTRUCTION OF TERMS.

SEC. 36. In construing this Act, or an indictment or other pleading in a case provided for by this Act, the following rules must be observed, except when a contrary intent is plainly apparent from the context thereof.

##### *Territory.*

The term "Territory" includes the Territories, the District of Columbia, and all other territory in the possession or under the jurisdiction or control of the United States not included within a State.

##### *Person.*

The term "person" or any word or term used to designate the applicant or registrant or other entitled to a benefit or privilege under this

Act includes a partnership, association, company, corporation, public or private, community, union of persons, or State, as well as a natural person.

*Number—Gender.*

The singular number includes the plural, and the plural includes the singular. The masculine gender includes the feminine and neuter.

*Applicant—Registrant.*

The terms “applicant” and “registrant” embrace the successors and assigns of such applicant or registrant.

*Infringement.*

The term “infringement” includes every wrongful or unauthorized use in commerce with foreign nations or among the several States or with the Indian tribes, or in the territory of the United States, or the reproduction or imitation of any registered trade-mark affixed to goods of substantially the same class as those described in the certificate of registration.

*Imitation.*

An “imitation” of a trade-mark is that which so far resembles a genuine trade-mark as to be likely to induce the belief that it is genuine, whether by the use of words or letters similar in appearance or in sound, or by any sign, device, or other means whatsoever.

*Affixed.*

A trade-mark is deemed to be “affixed” to an article of merchandise when it is placed in any manner in or upon either—

1. The article itself; or,
2. A box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label, or other thing, in, by, or with which the goods are packed, inclosed, or otherwise prepared for sale or disposition.

*Knowingly.*

The term “knowingly” imports a knowledge that the facts exist which constitute the act or omission unlawful, and does not require knowledge of the unlawfulness of the act or omission.

*Country of Origin.*

The words “country of origin” as applied to trade-marks refer to the country in which the trade-mark was first registered and of which the applicant is a citizen or subject, or in which he has a bona fide industrial or commercial establishment.

*Mark.*

The term “mark” includes marks, trade-marks, and symbols.

CONSTRUCTION OF ACT.

SEC. 37. The provisions of this Act, so far as they are substantially the same as those of laws existing on December thirty-first, nineteen hundred and two, shall be construed as a continuation of such laws, modified or amended to the language employed in this Act and not as new enactments; a reference in laws not repealed to provisions of law incorporated into this Act and repealed shall be construed as applying to the provisions so incorporated.



## PENDING APPLICATIONS.

SEC. 38. All applications for registration pending when this Act shall take effect may be proceeded with thereunder subject to its requirements, and for such purpose the applicant shall amend his application to conform to the provisions of this Act.

## REGISTRATIONS HERETOFORE MADE—ACT OF EIGHTEEN HUNDRED AND SEVENTY.

SEC. 39. All trade-marks registered prior to the third day of March, eighteen hundred and eighty-one, shall be deemed abandoned unless application for registration thereof as prescribed in this Act be made prior to the first day of May, nineteen hundred and three, in default whereof the registrant shall not thereafter be entitled to notice from the Commissioner of Patents under section eleven of this Act.

## ACT OF EIGHTEEN HUNDRED AND EIGHTY-ONE.

All registrations made after the third day of March, eighteen hundred and eighty-one, and prior to the first day of January, nineteen hundred and three, shall remain in full force and effect to the end of the term for which originally granted, unless surrendered and re-registered; but the registrants shall be entitled to institute proceedings for infringement provided herein only when such infringement takes place in commerce with foreign nations or with the Indian tribes.

## REGISTRATION BY RESIDENTS OF HAWAII.

SEC. 40. Residents of the Territory of Hawaii, if qualified under section five, may file applications for registration of marks under this Act with the treasurer of the Territory of Hawaii, who shall transmit the same to the Commissioner of Patents. The date of filing of such applications in the United States Patent Office shall, for the purposes of this Act, be deemed to be the same as the date of filing with the treasurer of the Territory of Hawaii.

In proceedings upon applications so filed, the time allowed within which an act may be done, a notice may be given, a document may be filed, or an appeal may be taken, shall be double the time elsewhere provided in this Act.

## INTERNATIONAL REGISTRATION OF TRADE-MARKS.

SEC. 41. Upon and after the adhesion of the United States to the agreement for the international registration of trade-marks concluded at Madrid, April fourteenth, eighteen hundred and ninety-one, all correspondence with the International Bureau at Berne in regard to marks to be registered under such agreement by citizens of the United States or aliens entitled to the advantages of citizens under such agreement shall be conducted by the Commissioner of Patents, and all necessary rules, forms, and orders as to procedure and for carrying this Act into effect shall be prescribed and may be amended by him from time to time.

## AMENDATORY AND REPEALING STATUTES.

SEC. 42. No provision of this Act, or any part thereof, shall be deemed repealed, altered, or amended by the passage of any subsequent statute inconsistent therewith, unless such statute shall explicitly refer thereto and directly repeal, alter, or amend this Act accordingly.

## REPEAL.

SEC. 43. The laws or parts thereof specified in the schedule hereto annexed and all other Acts and parts of Acts inconsistent with the provisions of this Act are repealed.

## SCHEDULE OF LAWS REPEALED.

## REVISED STATUTES.

Date.	Title.	Chapter.	Section.	Subject.
June 22, 1874	XXXIII	-----	2496	Prohibition upon importation of simulated watch movements, etc. Re-enactment of chapter 125, March 3, 1871.
June 22, 1874	LX	2	4937 to 4947	Registration of trade-marks, etc. Re-enactment of chapter 230, sections 77 to 84, July 8, 1870.

## STATUTES AT LARGE.

Date.	Chapter.	Section.	Volume.	Page.	Subject.
July 8, 1870	230	77 to 84	16	210 to 212	Registration of trade-marks, etc.
Mar. 3, 1871	125	-----	16	580	Prohibition upon importation of simulated watch movements.
Aug. 14, 1876	274	All.	19	141	To punish the counterfeiting of trade-marks, etc.
Mar. 3, 1881	138	All.	21	502	Registration of trade-marks, etc.
Aug. 4, 1882	393	All.	22	298	Registration of marks used prior to March 3, 1881.
Aug. 27, 1894	349	5	28	547	Marks on foreign-made goods.
Aug. 27, 1894	349	6	28	547	Foreign-made goods bearing domestic marks excluded.
July 24, 1897	11	8	30	205	Marks on foreign-made goods. Re-enactment of chapter 349 August 27, 1894.
July 24, 1897	11	11	30	207	Foreign-made goods bearing domestic marks excluded. Re-enactment of chapter 349 August 27, 1894.

## WHEN ACT TO TAKE EFFECT.

SEC. 44. This Act shall take effect January first, nineteen hundred and three. When construed in connection with other statutes, it must be deemed to have been enacted on the                  day of                  , nineteen hundred and two, so that any statute enacted after that day is to have the same effect as if it had been enacted after this statute.

*Notes.*

The title of the bill is so drawn as to express the intention of Congress to act within the powers granted to it by article 1, section 8, of the Constitution.

Section 1 follows the practice established by Congress when it gave the short title "The National Bank Act" to the act entitled "An act to provide a national currency secured by a pledge of the United States bonds, and to provide for the circulation and redemption thereof," approved June 3, 1864. (Act approved June 20, 1874.)

The practice is followed in the State of New York and elsewhere.

Section 2 states the scope of the bill. The trademark act of 1881 refers to trademarks used "in commerce with foreign nations or with the Indian tribes only." The bill refers in addition to "commerce among the several States." It also provides for the use of marks in commerce in the vast territory of the United States not included within the boundaries of the several States.

The act of 1881 refers to trademarks only. The present bill refers to "marks," "trademarks," "commercial names," and "symbols," which words seem to cover all the means of identification used in commerce. It is intended to exhaust the power of Congress to legislate on the subject.

Section 3 provides for the marking of articles of foreign manufacture with the name of the country of origin. This section is taken from the tariff act of 1897 (sec. 8), modified. (See sec. 5, tariff act of 1894.) As this bill includes the regulation of marks used in commerce, it is presumed that the marking required under the tariff act should be included also.

Section 4 provides that foods and medicines bearing deceptive marks or false marks of inspection may be excluded at the custom-houses if foreign, and may be seized if found in the territory of the United States, not included within a State, or in commerce among the several States or with the Indian tribes. This is a regulation of commerce in which the mark plays the most important part. In a scheme for the regulation of commerce in the matter of marks all marks whether producing a beneficial or harmful effect have a place.

Section 5 extends the right to register marks to "a person who has a bona fide industrial or commercial establishment in the territory" of a government which, by treaty or convention, affords similar privileges to citizens of the United States, in addition to those who may now register. This is included to make the law comply with article 3 of the Convention for the Protection of Industrial Property, as amended at Brussels. The bill further extends the right to register to public corporations, to common carriers, communities, unions of persons, and to States. (See definition of person, sec. 36.)

The section also widens the class of marks which may be registered, over the law of 1881, so as to include marks used in commerce among the several States and in the territory of the United States not within any State, and primarily within the jurisdiction of the United States.



The word "mark" is used advisedly. It is intended to make a distinction between a mark unregistered but used, and the same mark when registered. It is then designated a trademark. The mark, however, must have the qualities of a trademark and is not changed in character or purpose by registration. Its quality as a distinguishing mark is that which makes it a necessary part of commerce.

Section 6 inhibits the registration of certain marks excluded from registration by sections 2, 3, and 4 of the act of 1881.

It requires that the mark be new to the class of goods to which applied, but use without registration in a foreign country or within a single State will not prevent its registration nor invalidate it when registered, in case the applicant believed himself, at the time of making the application, to be the first to adopt and use the mark.

It permits the registration of marks registered abroad in order to conform to article 6 of the Convention for the Protection of Industrial Property.

It excludes marks used solely within the boundaries of a single State. This is made necessary by the extension of registration to marks used in interstate commerce. It is, however, not understood to give a right to infringe a registered mark within the limits of a single State.

Section 7 provides a form of application after the manner prescribed in the trademark laws of other adherents to the Convention for the Protection of Industrial Property.

The use of a form has a precedent in the copyright act and will cause a great saving of expense in applications as well as in the administration of the registration office.

This section retains the oath as a safeguard against the registration of a mark by one not the owner, and the provision for a drawing for the purpose of the publication of the mark. (The attempt is being made in countries where publication of notice of application for registration is required to substitute a representation for a description of the mark.)

The form provides for the service on a nonresident registrant by service on the Secretary of the Treasury. There is always a Secretary, but an individual designated by the registrant might die or move away. Notice to the registrant by the Secretary is provided for.

Section 8 is intended to fulfill the requirements of priority prescribed by article 4 of the Convention for the Protection of Industrial Property, concluded at Paris March 20, 1887. The "period of priority" referred to in the Convention is a period of time during which a merchant, manufacturer, or other person may apply for registration in other countries after the first application. It is a provision to render possible the obtaining of the right to use a mark in all of the countries adhering to the Convention.

Section 9 specifically prescribes an examination to be followed by publication. This is intended to keep off the record any mark not the subject of registration by the applicant, either because of his residence in a country which does not grant reciprocal rights, etc., or its inhibition by section 6 or its ownership by another. The publication, when not developing opposition, adds greatly to the probability of the novelty of the mark and its right to registration.

The act of 1881 does not in terms provide for examination and it makes no provision for publication anterior to registration.

A form of certificate of registration is provided as in the case of copyright. (Rev. Stat., sec. 4957.)

The certificate is made to bear the date of the application and may be antedated in case of prior application for registration abroad.

The term of the registration is fixed at ten years, except in the case of registration by citizens or subjects of foreign countries, etc., in which case registration here expires with registration there, but can not exceed ten years. The register of trade-marks is now clogged with a multitude of abandoned marks and marks which, under the present practice, would not be registered. A shorter registration than the thirty years provided by the act of 1881 will prevent these evils in part.

The certificate may issue to the assignee of the mark. Under the law of 1881, as construed by the Commissioner, this is not now allowed. The result is that in case of the transfer of a mark, pending application for its registration, either the certificate issues to one who is not the owner or the owner must apply anew and pay a new fee.

Section 10 provides that notice of refusal of registration shall be given to applicant, and follows present practice.

Section 11 provides for opposition to registration. This is not contained in the act of 1881. It is a feature of several foreign trade-mark laws. A party who may be injured by the registration of the mark should have the right to prevent its registration by one not lawfully entitled to it.

Section 12 provides for the determination of priority of use of a mark or the sufficiency of an objection to its registration. The act of 1881 provides only for disputes between an applicant and a previous registrant, or between applicants, "when he [the Commissioner] shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases." This language is exceedingly vague and the practice prescribed does not conform to that rule of certainty in a statute which should prevail.

Section 13 provides for the cancellation of registration. Under the existing practice of many foreign countries, registration here must precede registration by a citizen of the United States there. The registration here is evidenced in the foreign country by a certified copy, and nothing except the refusal of the Commissioner of Patents to furnish a certified copy stands in the way of the use by a wrongful registrant of his registration here to obtain registration abroad; besides the wrongful registration may be made use of to deceive.

This is new.

Sections 14 to 19 provide for appeals from the examiner in charge of trademarks to the Commissioner in person, and from the Commissioner to the court of appeals of the District of Columbia, and from the court of appeals to the Supreme Court of the United States.

The use of marks in commerce and their regulation in this matter has become so important that it seems that questions involving marks should be allowed the highest judicial judgment. No appeal was provided for in the act of 1881. Sections 14 to 18 follow the language of the patent statute. (Rev. Stat., secs. 4909-4914.)

Section 20 provides for obtaining registration by suit in equity. This is substantially a copy of a similar provision for compelling the grant of a patent for an invention. (Rev. Stat., sec. 4913.)

Section 21 grants the privilege of a renewal of the registration, on the payment into the Treasury of the fee prescribed, if the applicant fulfills the conditions required for an original registration. This seems



entirely just. A foreigner, for example, who has allowed his registration to lapse in his own country, should not be allowed to renew his registration here, nor should a resident of the United States be allowed to re-register a trademark which has ceased to be used in commerce other than that within the boundaries of a single State. This section provides means for finding out whether this has occurred.

The act of 1881 allows re-registration if application therefor is made at any time within six months prior to the expiration of the original registration.

Section 22 provides for the amendment of a registration. There is no provision in the act of 1881 for amendment, and it has therefore been the practice to apply one or more times for registration of the same mark and pay a fee each time as on an original application. The result of this practice is to leave in force two or more registrations which are antagonistic to each other.

This is new.

Section 23, providing for the recovery of damages from one who surreptitiously secures for himself the registration of the mark of another, is substantially a copy of section 9 of the act of 1881.

Section 24 provides that a registered mark shall be assignable, together with the good will of the business; that an assignment may be made by a trustee in bankruptcy or by an officer of the court, and that notice of the transfer shall be published. The assignment may be acknowledged as in the case of patents to make it *prima facie* evidence. (See amendment to sec. 4898, Rev. Stat., approved March 3, 1897.)

The act of 1881 permits the Commissioner of Patents to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers.

Section 25 provides for notice of registration. If the counterfeiting or imitation of a mark carries a penalty, then notice should be given to the public of its existence. The simplest manner of giving such notice seems to be by affixing it to the mark directly or to the goods or their envelopes, as in the case of notice of letters patent.

This is new. It follows the language of the patent statute. (Rev. Stat., sec. 4900.)

Section 26 provides a penalty for falsely using such notice. As the notice will carry weight because of the rights created by registration, the unauthorized use of the notice should be prevented.

This is new. It follows the language of the patent statute. (Rev. Stat., sec. 4901.)

Section 27 provides that damages may be recovered for the infringement of the registered mark of another. As Congress has power to regulate the use of the mark, it has power to provide for recompense to the party injured by the infringement.

Under the act of 1881, two things must concur to entitle the injured party to damages—the counterfeiting, or copying, or colorable imitation of a trade-mark, and the act of affixing the same to merchandise. This limitation is removed and the registrant is given the right to sue for damages for any infringement. (See definition sec. 36.)

No provision is made in the act of 1881 for increasing the damages. By this section the court is given power to treble the damages. The section follows the language of the patent statute. (Rev. Stat., sec. 4919.)

Section 28 recites certain defenses which may be made in a suit for damages for the infringement of a registered trade-mark.



This is new. It follows the patent statute (Rev. Stat., sec. 4920).

Section 29 contains a more definite statement of the powers of the circuit court to grant injunctions and to take an account and assess damages than is contained in the act of 1881. It gives the court power to increase the damages as in actions at law.

The section provides for the impaneling of a jury, to which may be submitted questions of fact in the manner provided in suits under letters patent for inventions.

This is new in trade-mark legislation, but follows the language of the patent statute. (Rev. Stat., sec. 4921.)

Section 30 provides that application for registration shall be equivalent to use. This is necessary to carry out the convention of 1883 in its spirit. (See note to sec. 8.) The foreigner is granted the privilege of finding out whether he can legally use his foreign mark here, through the Patent Office rather than through use, which may be an infringing use for which he will be liable to suit for damages. It will further be of great aid to our own citizens, in that it will minimize the risk now accompanying the adoption of a mark.

Section 31 provides for the punishment of a person who knowingly, for use in commerce with foreign nations, or among the several States, or with the Indian tribes, or in the territory of the United States, (1) counterfeits a registered trade-mark; (2) affixes such mark to merchandise; (3) sells or offers for sale an article of merchandise to which such mark is affixed; (4) has in his possession such a mark or a die, etc., for the purpose of counterfeiting the same; (5) has an article of merchandise with such a mark as to appear to indicate the quantity, quality, character, place of manufacturing or production of the article or inspection, but not indicating it truly, by a fine of not more than \$500 and the deprivation of all rights under the act.

This section is quite distinct from the penal act of 1876, which was not limited to commerce with foreign nations, or among the several States, or with the Indian tribes, or in the territory over which Congress alone has control.

This section is further limited in the punishment meted out to the offender to a fine of not more than \$500 and the deprivation of rights under this act, instead of the fine of not more than \$1,000 and imprisonment for not more than two years provided in the act of 1876.

The section is limited to those who "knowingly" do the acts forbidden. It may well be said that in view of the fact that no unregistered mark can form the basis of proceedings under the act that all persons should be presumed to know the contents of the register of trade-marks, but this section does not go so far. It provides for the punishment of those intentional wrong-doers who imperil the health and property of the community by attempted substitution of bad articles for good. The section is based on section 364 of the penal code of New York, which has been in force since the adoption of the code in 1887, and has been found to work well.

Section 32 is intended to provide a summary remedy for offenses against the trade-mark act analogous to that provided by the tariff law. It authorizes the seizure of goods bearing marks that simulate registered trade-marks and the sale thereof after proceedings duly had to determine the legality of the seizure. It observes the constitutional limitations of Congress in the regulation of commerce, and protects the owner of goods against illegal seizure by requiring security from the petitioner, the amount and character of which is to be determined

by the court in accordance with the circumstances of the case. It simplifies the remedy of the person injured by an unlawful seizure, giving a single action against the petitioner and the sureties upon his bond.

Section 33 prohibits entry at any custom-house of the United States of imported merchandise to which is affixed a mark or name which imitates a registered trade-mark or a commercial name, etc., thus extending the protection accorded to our own citizens to citizens of foreign countries which grant reciprocal rights. This is based on section 11 of the tariff act of 1897 (which superseded section 5 of the tariff act of 1894 and section 2496, Revised Statutes), but simplifies the duties of the Department of the Treasury prescribed by that section by limiting its records to registered marks and to commercial names. This is now the practice under the rules prescribed by the Secretary of the Treasury, except as to commercial names. These can readily be identified, and under the convention for the protection of industrial property are exempt from registration.

Section 34 prescribes the fees to be paid under the act. The fee on filing the application has been placed at \$10 instead of the present fee of \$25, which seems to work a hindrance to registration. A fee of \$5 on filing an application for renewal of registration is required. There is no fee under the act of 1881. The fee on appeal to the Commissioner of Patents is fixed at \$10, in analogy to patent practice. There is now no fee for a proceeding before the Commissioner to review the action of the examiner in charge of trade-marks. The fees for appeals from the Commissioner are made the same as on patent appeals.

The section also provides for costs to the successful party in all proceedings under the act in the nature of a contest. No reason is apparent why a different rule as to costs should prevail in proceedings connected with the registration of trade-marks than in litigation over the same after registration.

Section 35 provides for the saving of rights under laws repealed by this act, and for the continued prosecution of all pending actions, suits, and proceedings, civil and criminal. This is wholly distinct from the provision of the act of 1881, which expressly states that it takes away no remedy at law or in equity. Such provision is omitted as not required, since nothing is taken away by this act except intentionally and expressly to make it more effective.

Section 36 construes terms used in the act—viz, Territory, person, applicant, registrant, infringement, imitation, affixed, knowingly, and country of origin—and prescribes that the singular shall include the plural and the masculine the feminine. It has enabled the text of the act to be materially abbreviated.

Section 37 requires that the act shall be construed as a continuation of the laws repealed. This is intended to refer more especially to the sections of the tariff act than to the trade-mark laws of 1870, 1876, 1881, and 1882, with which this act has little in common.

Section 38 provides that applications pending at the time this act goes into effect shall be amended to conform thereto and shall thereafter be proceeded with thereunder. It is desirable that one form of procedure only shall be employed in the Patent Office at a time, and, further, that all trade-mark registrations for the same period shall be uniform.

Section 39 practically casts into oblivion all registrations prior to the act of 1881. The commissioner is not required to give notice to any registrant prior to that act. These marks, if in such general use



that the Commissioner would take notice of them on that account, are not strengthened by the void registration under the act of 1870. The registrants of trade-marks under the act of 1870 have had for nearly twenty years the right to register under the act of 1881 without fee. It is to be presumed that they have availed themselves of that privilege.

This section provides that registrations of trade-marks under the act of 1881 shall continue for their full terms, but limits the remedy for infringement to that taking place in commerce with foreign nations and the Indian tribes. As the remedies granted to trade-marks registered under this act are more extensive, it is expected that all registrations of marks actually in use will be surrendered by making new registrations limited to the shorter term. The act is drawn on the lines of permitting only one registration of the same mark at a time.

Section 40. A curious anomaly exists at the moment in that the registration of trade-marks and the regulation of their use in commerce in Hawaii is under a local law. This section is intended to bring these marks into the United States Patent Office.

Section 41 provides for the contingency of the adhesion of the United States to the Agreement concerning the international registration of trade-marks concluded at Madrid April 14, 1891. It is evident that the correspondence between the International Bureau at Berne in regard to the registration of trade-marks may be conducted with greater facility by the Patent Office directly than through the Department of State. It is understood that the practice of direct communication between the bureau immediately concerned with trade-marks and the International Bureau at Berne is usual in foreign countries.

It further seems to us that the Commissioner of Patents should be required to make rules, forms, and orders to carry the section into effect, following the method adopted in the bankruptcy act, which requires rules, etc., for such purposes to be made by the Supreme Court. The reasons applicable in that case apply to this case also, but with greater force, since the agreement of Madrid may be changed and modified when Congress is not in session.

Section 42 provides that no amendment of this act shall be made without special reference thereto. Considering the importance of the subject, it is intended that the act shall not be amended indirectly and without adequate notice to the people.

Section 43 enumerates laws repealed. The substance of all the acts mentioned may fairly be said to be included in this act, except the act of 1882, which excepted from the limitations of the act of 1881 all marks used before the passage of the latter act. No adequate reason appears why any distinction should be made in this country between marks used at one period or another. In Great Britain such a distinction is made because prior to 1876 the common-law rules governed, whereas after that date a statutory definition came into force. It was only just that trade-marks good under the law when adopted should remain valid, whatever was required for the validity of new marks. This condition of things has never prevailed here. Section 13 of the act of 1881, relating to foreign registration, is omitted as unworkable.

Section 44 provides that the act shall take effect on the 1st day of January, 1903, and that all statutes enacted after ——— shall be deemed to have been enacted subsequent to this act. A trade-mark statute is one of such supreme importance, not only to our own people, but also to those with whom we have commercial relations, that it seems just that ample notice should be given of its requirements.



## DISSENTING REPORT OF MR. GREELEY WITH REFERENCE TO THE REVISION OF THE TRADEMARK LAW.

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Patents are the creation of statute law, and the existing laws concerning patents are readily determined from an inspection of the statute books. Trademarks, as well as other marks, trade and commercial names, on the other hand, do not owe their origin to statutes. The right of property in a trademark is recognized by the common law, and civil remedies for its protection existed long prior to any legislation by Congress and have remained in full force since such legislation. In order to determine what changes should be made in the existing laws concerning trade and other marks and trade or commercial names it is important to consider not only the acts of Congress relating to this subject and the causes which led to their enactment, but also the origin and extent of the protection afforded by the unwritten law. This can best be done by reviewing the history of trademarks and trademark protection in the United States from the earliest times.

### NO REFERENCE TO TRADEMARKS IN THE CONSTITUTION.

While it is expressly provided in the Constitution that Congress shall have power "to promote the progress of Science and Useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries,"<sup>1</sup> no provision giving Congress in express terms the power to provide for the protection of the distinctive marks used in commerce by manufacturers and traders to distinguish their goods from other goods of the same class—in other words, trademarks—is there found.

The omission from the Constitution of all reference to so important a subject as the protection of trademarks has become to modern commerce a subject not less important to the public interest at the present time than the protection of inventors by patents or the protection of authors by copyright, and a subject of vital importance to the growing export trade in manufactures, might properly be taken as significant of an intent on the part of the framers of the Constitution that Congress should not have the power to legislate on the subject if, at the time of the adoption of the Constitution, this subject had been recognized as one of importance to the commerce of the United States, either internal or foreign. That it was not so recognized at the date of the adoption of the Constitution or for many years thereafter, and the reasons why it was not and could not be so recognized without a more than human insight into the future, are clear from a consideration of the industrial and commercial conditions of the time.

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<sup>1</sup> Art. I, sec. 8, eighth clause.

## COMMERCIAL CONDITIONS IN THE COLONIES.

The three millions of people then in the United States were "for the most part exclusively addicted to agriculture and likely from local circumstances to remain in this condition." (Federalist, No. XI.) In a country so newly settled and so well adapted to agriculture, manufacturing industries and commerce would from natural conditions have been of slow growth if their development had been unhindered by other causes. Their development, however, had not been unhindered. Throughout the colonial period the settled policy of Great Britain had been to secure for her own manufacturers the monopoly of every branch of consumption in the colonies, to discourage all attempts to manufacture in the colonies such articles as could be provided for them by the manufacturers of the mother country. The colonies were held under restraint so absolute that, beyond the common domestic industrial and the most ordinary mechanical employments, no kind of manufactures was permitted. Every form of industry which could compete with British manufactures was discouraged or forbidden. Even Lord Chatham declared that if he had his way he would not allow the colonists to make so much as a hobnail for themselves. Adam Smith in his *Wealth of Nations*, says of the attitude of Great Britain toward certain industries in the American colonies that—

She prohibits the exportation from one province to another by water, and even the carriage by land upon horseback or in a cart, of wools and woolen goods, of the produce of America, a regulation which effectually prevents the establishment of any manufacture of such commodities for distant sale, and confines the industry of her colonists in this way to such coarse and household manufactures as a private family commonly makes for its own use, or for that of some of its neighbors in the same province.

The legislation of Great Britain adopted with the purpose of preventing the development of manufacturing industry and commerce in the colonies is all a matter of record and a review of it may be found in the *History of Iron in All Ages*, by Swank (Philadelphia, 1892), also in *Our Country*, Senate Document, No. 438, Fifty-sixth Congress. That it was effective for its purpose is a matter of history. At the time of the adoption of the Constitution, the commerce of the United States is said to have been "at the lowest point of declension" (Federalist, No. XV), and it appears from the Report on Manufactures, ("particularly the means of promoting such as will tend to render the United States independent of foreign nations for military and other supplies"), submitted to the Second Congress by Alexander Hamilton, then Secretary of the Treasury, that "the expediency of encouraging manufactures in the United States was not long since deemed very questionable," and though he says that the expediency of encouraging manufactures "appears at this time to be pretty generally admitted," he felt obliged in his report to recognize the fact that there were "nevertheless, respectable patrons of opinions, unfriendly to the encouragement of manufactures," and to recognize this fact to the extent of stating fully and fully answering the arguments by which such opinions were defended.

## PURPOSE OF THE UNION.

While it is also to be said that one of the principal purposes to be answered by the union was "the regulation of commerce with other nations and between the States" (Federalist, No. XXIII), and, in the

words of Mr. Webster in his argument in the case of *Gibbons v. Ogden* (9 Wheaton, 1), quoted by the Supreme Court in *Guy v. Baltimore* (100 U. S., 434), "it had its immediate origin in the necessities of commerce, and for its immediate object the relief of these necessities by removing their causes, and by establishing a uniform and steady system," it is clear from the then existing conditions that the commerce of the time between the States was in a very small degree concerned with commodities of domestic manufacture.

As late as 1829 it was said of the manufacturing interests of this country that—

The manufacturing operations in the United States are all carried on in little hamlets, which often appear to spring up in the bosom of some forest, gathered around the waterfall that serves to turn the mill wheel. These villages are scattered over a vast extent of country—from Indiana to the Atlantic, and from Maine to North Carolina—instead of being collected together, as they are in England, in great manufacturing districts.<sup>1</sup>

#### DEVELOPMENT OF TRADEMARK LAW OF GREAT BRITAIN.

In Great Britain, prior to the date of the adoption of the Constitution of the United States and for many years thereafter, the importance of the protection of trademarks was little understood, notwithstanding that the importance of the development of manufacturing industries and commerce was fully recognized and every effort was made to stimulate and encourage its growth, with the result that at that time Great Britain was recognized as the leading nation of the world in manufactures and in commerce, and the fact that even then the importance of trademarks was not understood is significant, since it was to Great Britain, the parent country, that the framers of the Constitution mainly looked for information and suggestions to guide them in determining the provisions to be incorporated in that document. Great Britain not only had then no special law on the subject, but it had not then been recognized by the courts of that country that there could be any property right in the distinctive mark used by a manufacturer or trader on goods sold by him. But three cases, so far as can be ascertained from the reports, involving the right to the use of a trademark (one in 1590, concerning the use of a mark on cloth; one in 1742, concerning the use of the Great Mogul stamp on cards, and one in 1783, concerning the use of a mark for a medicinal preparation) had come before the courts of Great Britain for decision. In the most important one of these cases (*Blanchard v. Hill*, 1742, 2 Atk., 484, *Cox Manual*, 2), so little was the subject then understood, an injunction was refused on a state of facts on which an injunction would certainly be granted to-day. (*Amoskeag Mfg. Co. v. Spear*, 2 Sand., S. C., 599; *Cox Am. Trademark Cases*, 87.) As the conditions of commerce improved, particularly the facilities for intercommunication between distant places, by which it was made possible for manufacturers to compete with others than those in their immediate neighborhood, the importance of the protection of trademarks began to be recognized and the British courts found it necessary to the protection of honest trade and the prevention of fraud to interpose by injunction to prevent their infringement. It was not, however, until 1838 that an English court (in the case of *Millington v. Fox*, 3 My. & Cr., 338;

<sup>1</sup> Science of Mechanics, Allen, 1829.



Cox Manual, 63) held that the owner of a trademark was entitled to injunction against the use of his mark by those who used it without fraudulent intent; in other words, recognized the right to the exclusive use of a trademark as a property right. Not until 1862 was any special law on the subject of trademarks enacted in England, and up to that time the only remedies against infringers in that country were the common-law remedies of damages and injunction. Not until 1875 was any provision made by law in Great Britain for the registration of trademarks.

#### JEFFERSON'S REPORT ON TRADEMARK PROTECTION.

The first suggestion of the desirability of the protection of trademarks by statutory law which is of record in this country was contained in a petition presented to the Second Congress by Samuel Breck and others, of Boston, asking that they be given the exclusive right to use certain marks for designating the sailcloth of their manufacture, on which petition Thomas Jefferson, then Secretary of State, made the following report:

DECEMBER 9, 1791.

The Secretary of State, to whom was referred by the House of Representatives the petition of Samuel Breck and others, proprietors of a sail-cloth manufactory in Boston, praying that they may have the exclusive privilege of using particular marks for designating the sail-cloth of their manufactory, has had the same under consideration, and thereupon

Reports, That it would, in his opinion, contribute to fidelity in the execution of manufacturers to secure to every manufactory, an exclusive right to some mark on its wares proper to itself.

That this should be done by general laws, extending equal right to every case to which the authority of the Legislature should be competent.

That those cases are of divided jurisdiction: Manufactures made and consumed within a State being subject to State legislation, while those which are exported to foreign nations, or to another State, or into the Indian Territory, are alone within the legislation of the General Government.

That it will, therefore, be reasonable for the General Government to provide in this behalf by law for those cases of manufacture generally, and those only which relate to commerce with foreign nations, and among the several States, and within the Indian Tribes.

And that this may be done by permitting the owner of every manufactory to enter in the records of the court of the district wherein his manufactory is the name with which he chooses to mark or designate his wares, and rendering it penal in others to put the same mark to any other wares. (Jefferson's Complete Works, Washington, 1854, vol. 7, 563; Am. State Papers, vol. 14, p. 48.)

The report indicates very clearly that the question of the protection of trademarks was one which was wholly new to Jefferson. It also shows that with wonderful foresight he not only clearly grasped the importance of the question to the growing manufacturing industries of the country, but was fully satisfied that the provisions of the Constitution were ample to warrant Congress in passing laws which should provide in the interests of the citizens of the United States for the protection of trademarks used in interstate and foreign commerce. The essential features of the law he suggests—the requirement of notice of the claim of right to the mark by registering it with an officer of the Government and provision for the punishment of infringers of registered marks—are to-day the essential features of the trademark laws of all foreign countries which have such laws, practically all countries which have any pretension to commercial importance.

## DEVELOPMENT OF TRADEMARK LAW IN THE UNITED STATES.

The commercial conditions of the time were not such as to create any general demand for such a law as was suggested in Jefferson's report and it does not appear that any attempt was made to pass such a law. No bill on the subject appears to have been introduced in Congress until nearly three-quarters of a century later<sup>1</sup> and then rather for the purpose of carrying into effect the provisions of certain treaties with foreign nations than in response to any demand from the manufacturing interests of the United States.<sup>2</sup> That there was no general recognition of the importance of the protection of trademarks appears from the fact that not until 1837 was any controversy respecting the right to a trademark on articles of merchandise (*Thomson v. Winchester*, supreme court of Massachusetts, 1837, 19 Pick., 214; *Cox Am. Trademark Cases*, 7) brought before any court of record in the United States, and not until 1844 (*Taylor v. Carpenter*, circuit court of the United States, district of Massachusetts, 1844, 3 Story, 458; *Cox Am. Trademark Cases* 14), was any such case brought before a United States court. It is to be noted that in this latter case the suit was brought by an English manufacturer for infringement of his trademark by citizens of the United States.

These two cases were followed by one in each of the years 1845, 1846, 1847, 1848, two in 1849, one in 1850, one in 1851, one in 1853, three in 1854, two in 1855, three in 1856, six in 1857, one in 1859, seven in 1860, one in 1861, two in 1862, one in 1863, one in 1864, four in 1865, seven in 1867, seven in 1868, four in 1869, and three in 1870, a total up to 1870 of sixty-two cases, all but six of which were in the State courts of the following States: In the courts of the State of New York, forty cases; of Massachusetts, two; of Rhode Island, two; of Pennsylvania, seven; of California, two; of Connecticut, two; of Missouri, one.

Not until 1871 was any case involving the right to a trademark brought before the Supreme Court of the United States (*Canal Co. v. Clark*, 13 Wall., 311).

The fact that it was not until many years after the adoption of the Constitution that the importance of the protection of trademarks began to be appreciated is clearly shown by the decision of the supreme court of New York in the case of *Clark v. Clark*, decided in 1857 (25 Barb., 76; *Cox Am. Trademark Cases*, 206). In this decision the court says:

The law of trademarks is of recent origin and may be comprehended in the proposition that a dealer "has a property in his trademark." The ownership is allowed to him, that he may have the exclusive benefit of the reputation which his skill has given to articles made by him, and that no other person may be able to sell to the public, as his, that which is not his.

See also the case of *Phalon v. Wright*, decided in 1864 in the court of common pleas of the county of Philadelphia (5 Philadelphia, 464; *Cox Am. Trademark Cases*, 307), in which the court says:

It is somewhat strange that in the State of Pennsylvania, whose people are so largely engaged in manufactures, the subject of "trademarks" should not have been more frequently presented to our courts for decision.

The case of *Colladay v. Baird*, reported in fourth Phil. Rep., 139, decided in this court, in which my brother Ludlow delivered an elaborate and well-considered opinion, seems to be the only reported decision in this State upon the subject.

In New York the subject of trademarks has been frequently presented for judicial consideration, and in the decisions of the courts of that State and of the English tri-

<sup>1</sup> Appendix, Chap. XXV, p. 380.

<sup>2</sup> Appendix, Chap. XXV, p. 382.



bunals, with one or two from other States, we find the sources of the information required for the investigation of the case before us.

It is well settled that a court of equity will exercise its power for the protection of the owner of a *trademark* in the exclusive enjoyment of that device or symbol chosen by him to *designate* his goods or manufactures, and to distinguish them from those of others.

Every man has a right to the products of his own labor, and is entitled so to distinguish them, that persons dealing in or purchasing his commodities may be readily able to recognize them as his. The maker may therefore either with or without the use of his name adopt a word, title, symbol, or figure to designate the ownership or manufacture of the goods. In the use of such "*trademark*" he is to be protected from the efforts of others who would take advantage of his enterprise or skill, and, by imitation, endeavor to impose upon the public and to deprive him of the just reward of his industry.

The adoption of a trademark or device to indicate the manufacture or origin of a certain article does not give any right to the exclusive production of the article so marked. Any article of manufacture, unless it be protected by a patent, may be made and sold by any person. There is no such thing as an exclusive right to any particular branch of industry. The only restriction is that each party shall stand upon his own merits, and none shall be permitted, by the use of marks or symbols, to pretend that the goods offered by him are the products of another. (6 Beav., 72; *Perry v. Truefitt*, *Coffeen v. Brunton*, 4 McLean, 516.) This rule has even been applied to cases where there was no intentional deception, as where the manufacturer of steel was prohibited from stamping upon his manufacture certain words which he supposed were descriptive of a particular quality of steel, but which were, in fact, the name of the original manufacturer, and indicated his ownership. (*Millington v. Fox*, 3 Myl. & Cr., 338.)

And it was well said of the growth of the importance of the trademark by Judge Paxson in the case of *Dixon Crucible Co. v. Guggenheim* (3 Am. Law Times R. (St.), 288, and 2 Brewster, 321; *Cox Am. Trademark Cases*, 559), that—

In a rude age, when manufacturers were few, and those of only useful and indispensable articles, trademarks were but little known and seldom, if ever, violated. It was when wealth and luxury increased, and manufactures multiplied accordingly, that the use and value of a trademark became distinctly recognized. In the present age (1870), with the vast extension of the manufacturing interest, the law upon this subject is of necessity frequently invoked; and it is settling down into a consistent theory.

#### EARLY TRADEMARK LAWS OF THE STATES.

While during the interval between the report made by Mr. Jefferson and the passage of the national trademark law, approved July 8, 1870, many laws were passed by the legislatures of the several States for the inspection of foods for men and animals and other products, and their obligatory marking, for the purpose of preventing fraud upon the public, it was not until 1845 that a law was passed in any one of the States of the United States for the protection of trademarks or other marks by which goods may be distinguished on the market.

The legislature of New York enacted a penal law in that year to "punish and prevent fraud in the use of false stamps and labels." (Laws of 1845, chap. 279.) This law was amended in 1850 (chap. 123), and repealed in 1862 (chap. 306) by a new law entitled "An act to prevent and punish fraud in the use of false stamps, brands, labels, and trademarks." The new law was amended in 1863 (chap. 209). A penal law relating to the marking of bottles used by manufacturers of mineral waters was passed in 1847.

In 1847 a penal law was passed in Connecticut providing for the punishment of every person who shall use, forge, or counterfeit the individual stamp or label of any mechanic or manufacturer with intent to defraud another, etc.



In the same year a penal law was enacted in Pennsylvania "to punish and prevent frauds in the use of false stamps and labels." (Law No. 140.) This was amended in 1855 (Law No. 534), and finally incorporated with slight changes into an act to consolidate the penal law. (1860, secs. 173, 174, 175.) Mineral-water manufacturers were protected in their marks by law in 1849 (Laws of 1849, pp. 524, 680) and the manufacturers of malt liquors in 1865 (Laws of 1865, p. 58).

In 1850 a penal act (chap. 50) was passed in Massachusetts to punish the counterfeiting of a private label or trademark, etc. In 1853 (chap. 156) a civil remedy by injunction and in 1859 (chap. 50) in damages was given to owners of trademarks. In 1870 "An act to prevent fraud in the sale of watches" was passed.

In Ohio a penal act was passed in 1859 "to prevent and punish fraud in the use of false stamps, brands, labels, or trademarks."

In Iowa, in 1860, punishment was provided for the counterfeiting of any mark.

In Michigan an act was approved February 6, 1863, "to prevent and punish the counterfeiting and fraudulent use of trademarks, labels, stamps, etc."

In Oregon "An act to provide for the registration and protection of trademarks" was approved October 21, 1864. Registration was provided for; also the forfeiture to the owner of the trademark of one-half of the infringing goods, or their value, for the first offense, and the whole for the second offense; and in 1864 the punishment of infringement was provided for in the Criminal Code (sec. 583.)

In Nevada a penal law was passed in 1865. Registration was provided for; fees, \$20. Infringement was punished as a misdemeanor.

In Kansas "An act to prevent the counterfeiting, changing, or destroying trademarks, devices, and brands" took effect May 31, 1866. It provided that the infringer should pay to the owner of the trademark not exceeding \$25 for each offense.

In Maine a law was passed in 1866 (chap. 10) making infringers liable to damages and giving power to the supreme court to grant injunctions.

In Missouri "An act to protect mechanics, manufacturers, and others in their trademarks" was approved March 6, 1866. It provided for registration, which should be notice. A second act with the same title was approved February 22, 1870, which provided for penalties for infringement.

These are all the State statutes on the subject prior to the first national statute approved July 8, 1870. Eight States provided for the punishment of the improper intentional use of a trademark by fine or imprisonment; two provided both criminal and civil remedies, and two provided a civil remedy only.

#### TRADEMARK TREATY WITH RUSSIA.

In 1868 a treaty providing for the reciprocal protection of trademarks was concluded by the United States with Russia.<sup>1</sup> This was in the form of an article additional to the treaty of commerce and navigation of December 6-18, 1832, and was concluded January 27, 1868. The substance of this article is as follows:

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that

<sup>1</sup>Appendix, Chap. XVIII, sec. 11, p. 335.

any counterfeiting in one of the two countries of the trademarks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured party to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trademarks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other must be lodged exclusively, to wit: The marks of citizens of the United States in the Department of Manufactures and Inland Commerce at St. Petersburg, and the marks of Russian subjects at the Patent Office in Washington.

The importance of trademarks had been long recognized in Russia. A law as early as 1667 required manufacturers of certain kinds of goods to place certain marks on their goods, but did not require the use of individual marks. A law of 1774 required the use of individual marks, rather, however, as a means of distinguishing goods on which, under the law, a tax was due to the Government from those which were not liable to the tax, and to distinguish such goods from foreign goods in case of reimportation, than for any such purpose as that for which trademarks are now used. A little later, in 1778, an order was issued requiring manufacturers of paper to use distinguishing marks "in order to determine more readily the quality of the paper and the honesty of the dealer." In 1830 a law was adopted establishing general rules for the protection of marks and doing away with the requirements of the use of marks. Under this law, which remained in force until the present law was adopted in 1896, the owners of trademarks, in order to secure the advantage of its provisions, were required to register their marks in the department of commerce and manufactures. The infringement of registered marks was made a criminal offense, punishable by loss of civil rights and transportation. In short, the law was, in its essential features, such a law as was suggested in Jefferson's report in 1791, above referred to.

#### TRADEMARK TREATY WITH BELGIUM.

Also in the year 1868, and also in the form of an addition to a treaty of commerce and navigation, that of 1858, was concluded by the United States under date of December 20, a similar treaty with Belgium.<sup>1</sup> In that country, as in Russia, the importance of the protection of trademarks had been long recognized, and the laws then and for many years in force provided for the registration of trademarks, at least those used in certain important lines of industry, and provided for the punishment of infringers of trademarks by fine and imprisonment. The laws relating to the registration and protection of trademarks were, owing to the changes in the political status of Belgium during the present century, derived from various sources and were in consequence inharmonious and in many respects unsatisfactory. This condition of affairs was remedied by the adoption, in 1879, of the present trademark law. Article 17 of this law, by its enumeration of the laws repealed, indicates not only the unsatisfactory condition of the laws, but from the date of these laws shows that the question of the protection of trademarks had been long recognized as of great importance. This section is as follows (translation):

ART. 17. The provisions actually in force respecting trademarks are repealed, especially the ordinance of the 23d Nivose, year IX, the law of the 22d Germinal, year XI, the decrees of February 20 and September 5, 1810, the royal ordinance of

<sup>1</sup>Appendix, Chap. XVIII, sec. 2, p. 326.



December 25, 1818, the ordinance of June 1, 1820, and the provisions of article 50 of the law of February 7, 1859, and of articles 184, 213, and 214 of the penal code in so far as they apply to such marks.

#### THE TREATIES WITH RUSSIA AND BELGIUM.

That these treaties were within the constitutional power of the President under section 2 of Article II has never been questioned. Only through such treaties could protection be secured for the rights of citizens of the United States to the exclusive use of their trademarks in these countries—rights which are now recognized as essential to the establishment of trade with these countries upon a permanent basis. In exchange for the assurance of such protection in these countries the President, with the advice and consent of the Senate, in accordance with the provisions of the Constitution, gave assurance to these nations that the rights of their subjects to the exclusive use of their trademarks should be protected in the United States. These treaties having been concluded in accordance with the provisions of the Constitution, it follows that it was incumbent upon Congress to provide, by law, for giving to them full force and effect in so far as they were not self-executing and to provide by appropriate legislation for the protection of the rights of citizens of the United States in so far as such rights might be in conflict with the claims of subjects of these nations.

In both of these treaties it was expressly provided that citizens of the United States and subjects of these foreign nations should give notice of their claim to the exclusive property in their marks by registration, the subjects of the foreign nations being required as conditional to protection for their marks to register them in the Patent Office at Washington, citizens of the United States being required to register the marks claimed by them in the Government offices provided for that purpose in the several countries.

As at the time these treaties were concluded there was no law authorizing the Patent Office to register trademarks, it was clearly necessary that legislation be enacted to provide for such registration, certainly so far as the registration of marks claimed by subjects of these countries as their property was concerned.

These treaties not only stipulate that the marks of the subjects of these foreign nations should be admitted to registration and be given thereby the color of protection which the mere fact of registration necessarily implies, but also stipulate that any counterfeiting of such marks in the United States should be "strictly prohibited and repressed," as well as that such counterfeiting should "give ground for an action of damages."

Damages for infringement of trademarks were given under the common law, but under the common law infringements could not be "strictly prohibited and repressed." Infringers could be enjoined from further infringement, but up to the issuance of the injunction the infringer incurred no penalty, could not be punished even by confiscation or destruction of the goods bearing the infringing mark. Continuance of the infringement after injunction issued was contempt of court for which the punishment was not always adequate. Clearly a statutory provision was needed if the treaty stipulations which provided that infringements should be "strictly prohibited and repressed" were to be carried out in good faith. The foreign owners



of trademarks entitled to the benefits of their treaties undoubtedly expected, and it is not unreasonable that they should expect, to have in the United States protection for their trademarks in some degree commensurate with the protection afforded by the laws of their own country to their trademarks, laws which "strictly prohibited and repressed" the infringement of trademarks by making such infringement an offense punishable by fine and imprisonment, the benefit of which laws was assured under these treaties to United States citizens.

#### PROPOSED LEGISLATION TO GIVE EFFECT TO TRADEMARK TREATIES.

For the purpose of giving effect to the first of these treaties, that concluded with Russia, on April 7, 1869, Mr. Trumbull, from the Committee of the Judiciary, reported a bill in the Senate of the United States as follows:<sup>1</sup>

A BILL to execute the provisions of a certain treaty between the United States and His Majesty the Emperor of all the Russias, concluded on the twenty-seventh day of January, anno Domini eighteen hundred and sixty-eight.

*Be it enacted by the Senate and the House of Representatives of the United States of America in Congress assembled,* That any person who, with intent to defraud, shall falsely make, alter, forge, or counterfeit, in the United States, any trademark affixed in the dominions of His Majesty the Emperor of all the Russias, on any merchandise to show its origin or quality, which trademark shall have been lodged in the Patent Office of the United States in Washington, by any subject of the said Emperor, or any corporation existing in the said Emperor's dominions, or who shall in the United States utter and publish as true any such trademark, knowing the same to be false, altered, or forged, with intent to defraud any person, shall be deemed guilty of a misdemeanor, and, on conviction thereof, shall be punished by imprisonment at hard labor not more than three years, in the discretion of the court; and shall be liable to an action for damages in favor of the party injured thereby, to be prosecuted in any court having jurisdiction to hear and determine the same. (Bill S. 264, Forty-first Congress, first session.)

This bill was indefinitely postponed in favor of a bill reported on the same day (April 7, 1869) by Mr. Sumner, from the Committee on Foreign Relations, which was as follows:<sup>1</sup>

A BILL to prevent the counterfeiting of foreign trade-marks protected by treaty stipulations.

Whereas treaties have been concluded between the United States and certain foreign powers, by which the contracting parties have mutually bound themselves to prevent their citizens or subjects from counterfeiting trademarks used by citizens or subjects of the other, and other similar treaties are proposed: Therefore, in order to carry into effect the stipulations which have been or may hereafter be made by the Government of the United States,

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* Whenever any citizen or subject of a foreign power uses any trademark on merchandise to show its origin and quality, and has taken the steps prescribed by the treaty to secure the right of property in such trademark, no person anywhere within the United States shall counterfeit the same.

SEC. 2. *And be it further enacted,* That whoever violates the provisions of the previous section, or knowingly sells or exposes for sale any article having such counterfeited trademark, shall be liable to the injured party in an action at law or equity, to be prosecuted in any court of the United States having jurisdiction thereof. (Bill S. 265, Forty-first Congress, first session.)

This bill on April 22, 1870, was passed by the Senate after a discussion in which the defects of the bill were clearly pointed out by Mr. Carpenter in the following language:

I wish to call the attention of the chairman of the Committee on the Judiciary and also of the chairman of the Committee on Foreign Relations to the fact that the bill reported by the Committee on Foreign Relations seems to me to add nothing to the existing law. It simply says that whoever shall violate a trademark shall be liable to an action of damages. He is so without any statute. If any action what-

<sup>1</sup> Appendix, Chap. XXV, p. 382.

ever is needed on the part of Congress, it is to make the law more stringent than is the common law. If any man should use a trademark fraudulently that is a misdemeanor; that is obtaining money under false pretenses. It is not like the case of an infringement of a patent, which a man may do without knowledge that a patent exists; but if a man violates the trademark of another man and puts it on goods to sell for the purpose of defrauding, that is a misdemeanor and should be punished. The bill reported by the Committee on the Judiciary adds to the existing law, and I think the other bill does not.<sup>1</sup>

The bill was reported to the House of Representatives, but was not acted on.

On February 7, 1870, Mr. Trumbull asked and, by unanimous consent, obtained leave to bring in the following bill, which was read twice, referred to the Committee on the Judiciary, and ordered to be printed:<sup>2</sup>

A BILL more effectually to provide for the execution of treaties for the protection of the owners of trade-marks.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the circuit courts of the United States, concurrently and not exclusive of the courts of the several States and Territories, shall have and exercise the same jurisdiction to protect and enforce the rights of subjects of foreign nations with which the United States have made or may hereafter make treaties or conventions for the reciprocal protection of trademarks, as if the said foreign subjects were citizens of the United States. (Bill S. 501, Forty-first Congress, first session.)

This bill was indefinitely postponed by the Senate.

#### LEGISLATION FOR THE PROTECTION OF DOMESTIC TRADEMARKS AGAINST INFRINGEMENT BY FOREIGNERS.

On April 19, 1870, Mr. Banks, of Massachusetts, introduced in the House of Representatives a bill to prevent the importation from foreign countries of articles fabricated in imitation of and bearing the trademarks of articles of American manufacture.<sup>2</sup> This was referred to the Committee on Ways and Means and ordered printed, but does not appear to have been reported to the House. Its essential features are embodied in section 11 of the tariff act of 1897, as hereinafter noted.

On April 21, 1870, Mr. Morrill, of Vermont, introduced in the Senate a bill in relation to fraudulent trademarks upon foreign watches, which provided—<sup>2</sup>

That no foreign watches or watch movements should be admitted to entry at the custom-houses in the United States, unless there shall be legibly and distinctly engraved or stamped upon the works or movements the maker's name or distinguishing trade-mark, and in connection therewith, and as a part thereof, the name of the place and country where manufactured; but existing trademarks of foreign manufacturers of watches need not be changed if they distinctly show that the watch movements are of foreign production. If any watches or watch movements of foreign manufacture shall be offered for entry at any custom-house in the United States which shall copy or simulate the name or trade-mark of any domestic manufacturer, they are to be forfeited to the United States.

This bill passed the Senate on May 3, 1870, was reported to the House of Representatives, and was referred to the Committee on Finance, but was not reported from that committee. Substantially the same bill passed both Houses as the act of March 3, 1871 (sec. 2496, Rev. Stat.), and with an amendment making its provisions applicable to "any other articles of foreign manufacture," as well as "watches, watch cases, watch movements, or parts of watch movements," thus making it cover substantially what was intended to be covered by the bill introduced by Mr. Banks, above referred to, was reenacted in 1883 as a part of the act of March 3 of that year.

<sup>1</sup> Appendix, Chap. XXV, p. 383.

<sup>2</sup> Appendix, Chap. XXV, p. 386.



In slightly modified form the same provision respecting articles of imported merchandise was reenacted as section 7 of the act of October 1, 1890, again as section 6 of the act of August 27, 1894, and yet again as section 11 of the act of July 24, 1897. This law as it now stands is as follows:

SEC. 11. That no article of imported merchandise which shall copy or simulate the name or trade-mark of any domestic manufacture or manufacturer, or which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom-house of the United States. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of such trade-marks, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs. (S. T. D. (1897), p. 669.)

It is to be noted that this law provides for the protection of owners of trademarks against interference with their rights by infringers located in foreign countries and against would-be infringers located in this country in so far as importation by them of goods manufactured in a foreign country and bearing the infringing mark, but does not give the same protection to the subjects or citizens of any foreign country.

It was evident from the introduction of so many bills having reference to the protection of trademarks, both foreign and domestic, that, at least in some lines of manufacture, American manufacturers had begun to feel the need of some protection for their trademarks against infringers located in foreign countries. At that time (1870) the question of a much-needed revision of the patent and copyright laws was before Congress, a bill for the revision of such laws having been introduced in the House of Representatives by Mr. Jenckes, of Rhode Island, from the Committee on Patents, on April 7. This bill having been recommitted, the Committee on Patents again reported it with certain sections added, providing for the registration and protection of trademarks. These sections (72 to 84, inclusive), with some amendments, were adopted and were subsequently referred to as the trademark law of 1870 (secs. 4937-4947, Rev. Stat.)<sup>1</sup>

It is clear from the discussions of these sections of the bill<sup>1</sup> that it was supposed that the power of Congress to provide for the registration and protection of trademarks was derived from the clause of section 8 of Article I of the Constitution, which provides for the promotion of "the progress of Science and Useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries." Nowhere in the discussion is found any reference to the clause of section 8, which gives Congress the power "to regulate Commerce with foreign Nations and among the several States and with the Indian Tribes." So far as appears from the discussion of the bill, trademarks were regarded as analogous to patents and copyrights and their relation and importance to commerce appear to have been little understood. The act permitted the registration of trademarks by person or firms domiciled in the United States who were entitled to their exclusive use or who intended to adopt and use them, without limitation to the kind of com-

<sup>1</sup>Appendix, Chap. XXV, p. 398.



merce in which they were used or intended to be used, and while the act so far as the protection to be given to registered trademarks added practically nothing to the existing law beyond giving a kind of governmental sanction to the use of trademarks, a step toward a provision for their adequate protection, it provided for giving this sanction to trademarks used in commerce within a State, as well as those used in such commerce as, under the Constitution, was within the power of Congress to regulate.

Under this act and notwithstanding that it added little to the existing law so far as protection of trademarks was concerned, a considerable number of trade-marks were registered, 121 in 1870, 486 in 1871, 491 in 1872, 493 in 1873, 559 in 1874, 1,136 in 1875, and 959 in 1876. Previous to the passage of this law, 17 marks of foreigners entitled to protection under the provisions of the treaties with Russia and Belgium, above referred to, had been deposited in the Patent Office.

#### TRADEMARK CONVENTION WITH FRANCE.

Subsequent to the introduction of the first of the above bills regarding the protection of trademarks, introduced April 9, 1869, by Mr. Trumbull, a convention concerning trademarks was concluded under date of April 16, 1869, with France.<sup>1</sup> The substance of this convention is as follows:

ARTICLE I. Every reproduction in one of the two countries of trademarks affixed in the other to certain merchandise to prove its origin and quality is forbidden, and shall give ground for an action for damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven, just as if the plaintiff were a subject or citizen of that country.

The exclusive right to use a trademark for the benefit of citizens of the United States in France, or of French subjects in the territory of the United States, can not exist for a longer period than that fixed by the law of the country for its own citizens.

If the trademark has become public property in the country of its origin, it shall be equally free to all in the other country.

ART. II. If the owners of trademarks, residing in either of the two countries, wish to secure their rights in the other country, they must deposit duplicate copies of those marks in the Patent Office at Washington, and in the clerk's office of the Tribunal of Commerce of the Seine, at Paris.

#### TRADEMARK CONVENTIONS WITH OTHER FOREIGN NATIONS.

Subsequent to the passage of the act of 1870, under date of November 25, 1871, a trademark convention, practically the same in terms with that concluded with France, was concluded with Austria-Hungary.<sup>2</sup> December 11, 1871, a similar convention was concluded with Germany. March 28, 1874, a declaration respecting previous treaty stipulations in regard to trademarks with Russia was signed.<sup>3</sup> March 5, 1875, a new treaty of commerce and navigation was concluded with Belgium,<sup>4</sup> containing as article 15 a restatement of the stipulation regarding the reciprocal protection of trademarks contained in the additional article concluded in 1868.

#### THE TRADE-MARK LAW OF 1876.

On April 16, 1876, Mr. Conkling introduced in the Senate a bill entitled "A bill to punish the counterfeiting of trademark goods

<sup>1</sup>Appendix, Chap. XVIII, sec. 5, p. 330.

<sup>3</sup>Appendix, Chap. XVIII, sec. 11, p. 335.

<sup>2</sup>Appendix, Chap. XVIII, sec. 1, p. 325.

<sup>4</sup>Appendix, Chap. XVIII, sec. 2, p. 326.

and the sale or dealing in of counterfeit trademark goods." This bill having passed the Senate, was reported to the House of Representatives. In reporting this bill from the Committee on Patents, to whom it had been referred, Mr. Sampson, of Iowa, said:<sup>1</sup>

It is generally conceded that there is not at present sufficient protection to trademarks. The public generally, the honest manufacturers, and honest dealers throughout the country are being constantly swindled by counterfeit trade-marks. The law of 1870, providing a general system for the registration of trade-marks and designed to afford better protection by giving right of action in United States courts to recover damages for counterfeiting and providing the remedy by enjoining counterfeiters, has not proved sufficient. Worthless parties engaged in such dishonest practices are not prevented by civil actions. A judgment for damages has no terrors for them. If enjoined, some relatives soon own the goods and the business goes on. The plaintiff in such action (the measure of damages being the profit) has to depend mainly on the testimony and books of the defendant; and it is found generally that he who will counterfeit will testify falsely to avoid the consequences. Thus the action for damages amounts to but little.

Nearly 400 of the leading manufacturers, merchants, and dealers of New York, Boston, and Philadelphia have petitioned Congress very earnestly at this session to enact such a law as that contained in this Senate bill; and they state their reasons in this forcible language:

"The use of trade-marks on every species of merchandise and manufactures, both foreign and domestic, has greatly increased with the expansion of modern trade and commerce, and has become a powerful interest throughout the United States of America.

"The nefarious but lucrative business of pirating or counterfeiting genuine trademark goods has too long flourished unchecked to the incalculable injury of every consumer, of every honest merchant, manufacturer, and trader, and has extensively multiplied costly and tedious litigation.

"No United States statute yet exists providing penal remedies to punish the counterfeiting of trade-mark goods or the sale or dealing in the same. The evils and injuries to long-suffering commercial and manufacturing interests consequent upon this omission imperatively demand prompt relief and a speedy application of searching remedies.

"We therefore respectfully petition for relief, and request that Senate bill No. 846, introduced into the Senate on the 18th of May, 1876, entitled 'A bill to punish the counterfeiting of trade-mark goods and the sale or dealing in of counterfeit trademark goods,' may be made law at this session of Congress."

This bill as amended, having passed both Houses, was approved August 14, 1876.<sup>2</sup>

#### THE TRADEMARK LAW AS DEFINED BY THE ACTS OF 1870 AND 1876.

This act, whatever may be its defects, supplied what was lacking in the act of 1870; that is, provided a protection for trademarks beyond that given by the common law as understood and applied by the courts, by making the willful counterfeiting of registered trademarks a misdemeanor punishable by fine or imprisonment. The trademark law as it then stood, taking the two acts, that of 1870 and that of 1876 together, was in its essential features the law suggested by Jefferson in his report in 1791, differing from the law then suggested in one important particular only, but one which was of such importance as to render it impossible to uphold the law as valid and constitutional; that is, in not being limited in its application to the registration and protection of trademarks used in commerce which Congress, under the Constitution, had the power to regulate. In these essential features, making full protection conditional upon registration of the mark, and making the infringement of a registered mark a misdemeanor punishable by fine or imprisonment, the trademark law as it then stood

<sup>1</sup> Appendix, Chap. XXV, p. 404.

<sup>2</sup> Appendix, Chap. XXV, p. 412.



corresponded with the trademark laws of the foreign countries with which the United States had entered into treaty agreements respecting the protection of trademarks.

#### TRADEMARK CONVENTIONS WITH FOREIGN NATIONS.

Subsequent to the passage of the law of 1876 a declaration for the reciprocal protection of marks of manufacture and trade was concluded with Great Britain, October 24, 1877,<sup>1</sup> and on September 24, 1878, an agreement for the reciprocal protection of marks of manufacture and trade was concluded with Brazil.<sup>2</sup> These were substantially indetical in form and contained substantially the same stipulations that were contained in the treaties and conventions with other foreign countries.

#### THE DECISION OF THE SUPREME COURT IN THE TRADEMARK CASES.

Criminal prosecutions being had under the statutes of 1870 and 1876 in the southern district of New York and the southern district of Ohio, and a difference of opinion having been certified to the Supreme Court on the question whether these acts of Congress on the subject of trademarks were founded on any rightful authority in the Constitution of the United States, the cases came before the court for review at the October term of 1879. (*Trademark Cases*, 100 U. S., 82.)<sup>3</sup> The court showed with admirable clearness that because of the distinction between patents and copyrights and trademarks, pointed out in the decision, the power of Congress to enact the law could not be derived from that paragraph of Article I, section 8, of the Constitution which relates to authors and inventors, since the right of ownership in trademarks is created by adoption and not by authorship or invention. Neither could the law be supported by the commerce clause of the same article and section of the Constitution, because it was not limited to commerce among the States, but, on the contrary, was extended to trademarks generally, embracing marks used wholly within a State. The court held that, because the act usurped jurisdiction over trademarks used wholly within a State, it was so far void that the court could not separate the good from the bad without creating a new law, different perhaps from that which Congress would have passed, and that therefore the whole law must fall. The court, however, said:

The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, we propose to leave undecided. (100 U. S., 95.)

The court further said:

In what we have here said we wish to be understood as leaving untouched the whole question of the treaty-making power over trade-marks, and of the duty of Congress to pass any laws necessary to carry treaties into effect. (*Ibid.*, 99.)

#### EFFECT OF THE DECISION OF THE SUPREME COURT.

This decision of the Supreme Court caused great anxiety to trade mark owners, who sent many petitions to Congress; and great publicity was given to the subject by the press of the country.

<sup>1</sup>Appendix, Chap. XVIII, sec. 7, p. 331.

<sup>2</sup>Appendix, Chap. XVIII, sec. 8, p. 332.

<sup>3</sup>Appendix, Chap. XXV, p. 413.



The scope of the decision was not understood, and within a few days after it was handed down, Mr. McCoid, of Iowa, introduced a joint resolution in the House proposing the following amendment to the Constitution:<sup>1</sup>

Congress, for promotion of trade and manufacture, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks.

The resolution was referred to the Committee on Manufactures, which reported it favorably December 11, 1879. A part of the report is as follows:

The business men of the world have awakened to the fact that manufacture and trade require national and international control and protection of genuine commercial signatures to identify and distinguish property made and marketed by cosmopolitan tradesmen.

On December 9, 1879, Mr. Armfield, of North Carolina, introduced in the House "A bill to authorize the registration of trademarks,"<sup>2</sup> which substituted for the first clause of the act of 1870, which made no distinction as to the use of the trademarks registered, the following:

Owners of trademarks used in commerce with foreign nations, or among the several States, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements.

The bill, as drawn, provided for a trademark bureau. It was referred to the Committee on Commerce. but does not appear to have ever been reported by the committee.

#### THE TRADEMARK ACT OF 1881.

On March 12, 1880, Mr. Hammond, from the Committee on the Judiciary, reported a bill as a substitute for the preceding resolution and bill. It was in substantially the form of the present law.<sup>3</sup>

The report accompanying the bill says:<sup>4</sup>

The bill seeks to reenact substantially the trade-mark legislation of 1870 (Rev. Stat., secs. 4937-4947, inclusive), save that it is confined to foreign and interstate commerce. Its theory is that, by thus separating them from interstate commerce, the objections of the Supreme Court as to constitutionality will be removed.

The bill passed the House April 27, 1880, was referred to the Committee on the Judiciary of the Senate April 29, 1880, and passed the Senate and was thereafter approved March 3, 1881.<sup>5</sup>

By an act approved August 5, 1882,<sup>6</sup> which was in the nature of an amendment to the act of 1881, provision was made for the registration "of any lawful trademark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act," notwithstanding any provision of the act which would otherwise prevent its registration.

This law has been in some way referred to in the following cases without its constitutionality being questioned: *Menendez v. Holt* (128 U. S., 514, 516), *Ryder v. Holt* (128 U. S., 525), *Corbin v. Gould* (133 U. S., 308), *South Carolina v. Seymour* (153 U. S., 353), *Luyties v. Hollender* (21 Fed. Rep., 281), *Schumacher v. Schwencke* (26 Fed. Rep.,

<sup>1</sup> Appendix, Chap. XXV, p. 417.

<sup>2</sup> Appendix, Chap. XXV, p. 426.

<sup>3</sup> Appendix, Chap. XXV, pp. 432, 491.

<sup>4</sup> Appendix, Chap. XXV, p. 428.

<sup>5</sup> Appendix, Chap. XXV, p. 491.

<sup>6</sup> Appendix, Chap. XXV, p. 499.

818), *Pratt M. Co. v. Astral O. Co.* (27 Fed. Rep., 492, 493), *Luyties v. Hollender* (30 Fed. Rep., 632), *United States v. Koch* (40 Fed. Rep., 250), *Hiram Holt Co. v. Wadsworth* (41 Fed. Rep., 34, 36), *Graveley v. Graveley* (42 Fed. Rep., 265), *L. H. Harris D. Co. v. Stucky* (46 Fed. Rep., 624), *Brower v. Boulton* (53 Fed. Rep., 389), *Brower v. Boulton* (58 Fed. Rep., 888, 890), *Kohler M. Co. v. Beeshore* (59 Fed. Rep., 572, 575), *Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co.* (65 Fed. Rep., 424), *Burt v. Smith* (71 Fed. Rep., 161), *Saxlehner v. Eisner & Mendelson Co.* (88 Fed. Rep., 61).

The number of registrations made under this law by years is as follows: For 1881, 834; for 1882, 947; for 1883, 902; for 1884, 1,021; for 1885, 1,067; for 1886, 1,029; for 1887, 1,133; for 1888, 1,059; for 1889, 1,229; for 1890, 1,415; for 1891, 1,782; for 1892, 1,737; for 1893, 1,677; for 1894, 1,806; for 1895, 1,829; for 1896, 1,813; for 1897, 1,671; for 1898, 1,238; for 1899, 1,649.

#### TRADEMARK ARRANGEMENTS WITH FOREIGN NATIONS.

Since the approval of the trademark act of 1881, the following diplomatic arrangements respecting the reciprocal protection of trademarks have been entered into between the United States and foreign nations: A treaty with Serbia for facilitating and developing commercial relations, concluded October 2-14, 1881, in which article 12 provides for the reciprocal protection of trademarks;<sup>1</sup> a declaration with Italy for the reciprocal protection of marks of manufacture and trade, concluded June 1, 1882;<sup>2</sup> a convention with Spain for securing reciprocal protection for trademarks and manufactured articles, concluded June 19, 1882;<sup>3</sup> a convention with Belgium for securing reciprocal protection for trademarks and trade labels, concluded April 7, 1884;<sup>4</sup> a convention with Denmark for the reciprocal protection of trademarks and trade labels, concluded June 15, 1892;<sup>5</sup> a treaty of commerce and navigation with Japan, concluded November 22, 1894,<sup>6</sup> of which article 16 relates to the protection of trademarks, and a convention with the same country securing immediate reciprocal protection for trademarks, concluded January 13, 1897.<sup>6</sup> In addition, diplomatic notes with regard to the reciprocal protection of trademarks were exchanged with Netherlands under dates of February 10 and 16, 1883,<sup>7</sup> and with Switzerland under dates of April 27 and May 14, 1883.<sup>8</sup>

The United States under date of May 30, 1887, adhered to the International Convention for the Protection of Industrial Property concluded between certain countries at Paris, March 20, 1883,<sup>9</sup> by such adhesion entering into treaty agreements for the reciprocal protection of trademarks with the following countries: Belgium, Brazil, Dominican Republic, France with Algeria and the French colonies, Great Britain, Italy, Netherlands, Norway, Portugal, Servia, Spain, Sweden, Switzerland, and Tunis. Since the adhesion of the United States, Denmark with the Faroe Islands, New Zealand, and Queensland, Japan, the Dutch East Indies, Surinam, and Curaçao have adhered to this convention, and its provisions are therefore effective between the United States and these countries also.

<sup>1</sup> Appendix, Chap. XVIII, sec. 12, p. 336.

<sup>2</sup> Appendix, Chap. XVIII, sec. 8, p. 332.

<sup>3</sup> Appendix, Chap. XVIII, sec. 13, p. 337.

<sup>4</sup> Appendix, Chap. XVIII, sec. 2, p. 326.

<sup>5</sup> Appendix, Chap. XVIII, sec. 4, p. 329.

<sup>6</sup> Appendix, Chap. XVIII, sec. 9, p. 332.

<sup>7</sup> Appendix, Chap. XVIII, sec. 10, p. 334.

<sup>8</sup> Appendix, Chap. XVIII, sec. 14, p. 337.

<sup>9</sup> Appendix, Chap. II, sec. 1, p. 146.

## PRESENT TRADEMARK LAWS OF THE STATES.

Since the approval of the act of 1881 many of the separate States of the United States have adopted laws providing for the registration and protection of trademarks or have amended such laws previously adopted. The State laws, including those adopted prior to 1881, are thus given in a recent publication:<sup>1</sup>

The following States provide by law for the registration of trademarks by any person, or association, or union of workmen, and for the punishment by fine or imprisonment of infringers:

Delaware, act of March 29, 1893.  
 Georgia, act of December 20, 1893.  
 Idaho, act of March 12, 1897.  
 Illinois, act of June 13, 1895.  
 Indiana, acts of March 6, 1891, and March 8, 1897.  
 Iowa, act of March 26, 1892.  
 Louisiana, act of July 8, 1898.  
 Maine, act of March 28, 1893.  
 Maryland, act of April 4, 1892.  
 Massachusetts, act of June 4, 1895.  
 Michigan, act of May 24, 1895.  
 Minnesota, act of February 23, 1895.  
 Missouri, act of March 20, 1893.  
 Montana, Sander's Penal Code, 1895.  
 New Hampshire, act of March 13, 1895.  
 New Jersey, act of March 15, 1898.  
 Ohio, acts of March 30, 1892, and May 1, 1894; Revised Statutes, 1890.  
 Oklahoma, act of March 11, 1897.  
 Tennessee, act of February 3, 1897.  
 Utah, act of March 8, 1894.  
 Wisconsin, act of April 9, 1895.

The following States provide by law for the registration of trademarks by any person and for the punishment of infringers by fine or imprisonment, but do not expressly provide by law for registration by associations or unions:

Arkansas, act of March 31, 1883.  
 California, act of March 12, 1885; chapter 157 of Laws of 1897.  
 Colorado, Hill's Annotated Statutes, 1891.  
 Connecticut, Statutes of 1888, chapter 93 of Laws of 1895.  
 Nevada, Statutes of 1885.  
 North Dakota, act of March 9, 1891.  
 Oregon, Hill's Annotated Laws, 1892.  
 Washington, acts of February 21, 1891, and March 20, 1895.  
 West Virginia, Code of 1897, act of 1882.

The following States provide by law for the registration of trademarks only by associations or unions of workmen and for the punishment of infringers by fine or imprisonment:

Kansas, act of March 11, 1891.  
 Kentucky, acts of April 16, 1892, and March 8, 1894.  
 Nebraska, Laws of 1891, chapter 15.  
 Pennsylvania, act of May 21, 1895.  
 South Dakota, act of March 7, 1890.

The following States provide by law for the registration of trademarks only by manufacturers or dealers in beverages in bottles, etc., and for the punishment of persons who make fraudulent use of the bottles, etc., so marked:

Alabama, act of February 14, 1891.  
 New York, act of May 27, 1894, R.  
 Rhode Island, act of May 13, 1892.  
 Virginia, act of February 17, 1890, and February 12, 1892.

#### PROVISIONS OF THE TRADEMARK ACT OF 1881—THE COMMON LAW OF TRADEMARKS.

The act of 1881<sup>2</sup> provides for the registration of trademarks used in commerce with foreign nations or with the Indian tribes and by pro-

<sup>1</sup> Appendix, Chap. XIX, p. 340.

<sup>2</sup> Appendix, Chap. XXV, p. 491.



viding that the owners of trademarks domiciled in any foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States may register their marks gives effect to the treaty obligations which the United States has entered into with foreign countries so far as the registration of trademarks is concerned. It also provides that the registration of a trademark shall be *prima facie* evidence of ownership. In other respects it practically does nothing more than give effect to the common law of trademarks as it existed at the time of its enactment, created by the courts of Great Britain and the United States, indefinite and indistinct as a law must be which has to be ascertained from a mass of decisions rendered by many different courts, many of them contradictory in their dicta on the question and all of them concerned with doing justice in the particular case before them rather than with legislating into existence a distinct and definite law. The following statement, taken from the decision of Judge Potter in the case of *Gillott v. Esterbrook* in 1864 (Cox American Trademark Cases, 340), may be accepted as indicating the difficulty in ascertaining the law with respect to trademarks, the decision being subsequently affirmed on appeal by the supreme court of New York. (47 Barb., 455; Cox Am. Trademark Cases, 363.) This statement is as follows:

The law in relation to trademarks in late years has been much discussed in our courts, still, however, leaving many questions unsettled, so that what is proper to be done in cases of this kind depends more or less upon the circumstances that attend them. The questions presented in the adjudicated cases have been variant in their features, and partially so conflicting that we are compelled to look at a few general principles that seem to be settled, and then resort to analogies, in order to determine from them what should be held in the particular case, and then deal with it according to the nature of its peculiar circumstances.

See also the case of *Dixon Crucible Company v. Guggenheimer*, above referred to.

#### DECISIONS FROM WHICH THE COMMON LAW OF TRADEMARKS IS DETERMINED.

From a consideration of a few of the early decisions in trademark cases the difficulty in determining even the fundamental principles of the so-called common law of trademarks will be apparent.

In the case of *Blanchard v. Hill*, above referred to,<sup>1</sup> decided by Lord Hardwicke in 1742, a motion having been made on behalf of the plaintiff for an injunction to restrain the defendants from making use of a trademark which had been appropriated by the plaintiff, the learned chancellor said:

I do not know any instance of granting an injunction here to restrain one trader from using the same mark with another, and I think it would be of mischievous consequence to do it.

This decision, which, in effect, held that there could be no right of property in a trademark, stood as determining the law of trademarks for nearly a hundred years. Prior to that time the owner of a trademark was compelled to establish and vindicate his right at law. His right to his mark was not protected by a court of equity.

Not until the case of *Millington v. Fox*, above referred to,<sup>2</sup> was decided in 1838, was it held by any court in Great Britain or the United States that there could be a property right in a trademark. And it should be said that the doctrine enunciated in that decision

<sup>1</sup> Page 91.

<sup>2</sup> Page 91.

was not at once universally accepted, the Master of the Rolls in 1842, in the case of *Perry v. Truitt* (6 Beav., 66), stating that it did not seem to him that a man could acquire a property merely in a name or mark, and, commenting on the case of *Millington v. Fox*, said that "I am not aware that any previous case carried the principle to that extent." Judge Robertson, of the superior court of the city of New York, in his decision in the case of *Corwin v. Daly* (7 Bos., 222, Cox Am. Trade-mark Cases, 265, 1860), states that this doctrine was repudiated in *Crawshay v. Thompson* (4 Man. & Gr., 357, Cox Manual, 72, 1842), and even asserts that it will be found on examination that no such doctrine was sustained in the case of *Millington v. Fox*. The learned judge quotes from the decision of the Vice-Chancellor of England in *Collins Co. v. Cowen* (3 Kay & J., 428, Cox Manual, 152, 1857), the assertion that "There is no such thing as property in a trademark as an abstract name," and says that "This principle will be found not to have been swerved from in any case." The case of *Millington v. Fox* is, however, generally taken to have been the case in which the now universally accepted doctrine of a property right in a trademark was for the first time announced. Certainly that doctrine was not announced in any prior decision. The change in the attitude of the courts toward trademarks and the desirability of statute law on the subject is well stated by the supreme court of California in the case of *Derringer v. Plate* (29 Cal., 292, Cox Am. Trademark Cases, 324, 1865), in the following language:

It was at one time thought that no man could acquire a right to a particular trademark (*Blanchard v. Hill*, 2 Atk., 284), but as the true interests of manufacturers and commerce were more fully developed and appreciated the right of property in trademarks was recognized, and the doctrine has been uniform for many years that the manufacturer or merchant does possess an exclusive property in the trademark adopted and used by him. The right of property does not in any manner depend for its inceptive existence or support upon statutory law, though its enjoyment may be better secured and guarded, and infringements upon the rights of the proprietor may be more effectually prevented or redressed by the aid of the statute than at common law. Its exercise may be limited or controlled by statute, as in case of other property, but the title to the good will of a trade, which it in some respects resembles, the right of property in a trademark accrues without the aid of the statutes.

And if the decisions respecting the fundamental proposition on which the law of trademarks rests are contradictory, it is to be expected that the decisions on other questions would be also contradictory and conflicting. Such is the case. On perhaps no question have the decisions been more conflicting than on the question of what may constitute a trademark. As late as 1869, in the case of *Ferguson v. Davol Mills* (2 Brewster, 314, Cox Am. Trademark Cases, 516), it was not only stated that "the simplest case of a trademark is the name and address of the claimant," but it was held that "it is absolutely requisite that a device or symbol should perform the office of a finger board; should indicate the name and address of the manufacturer to invest it with the attributes and entitle it to the protection of a trademark." This decision, though unfortunately followed in a number of cases, is to-day recognized as radically and absolutely incorrect, as is clear from the decision of the Supreme Court in *Manufacturing Co. v. Trainer* (101 U. S., 51), in which it is said that "a trade-mark may consist of a name, symbol, figure, letter, form, or device." The mere name and address of a person is so far recognized as not in itself a trademark in the technical sense that it is expressly excluded from registration as such in the United States by the trademark act of March 3, 1881,



and in Great Britain by the law of 1875, as well as by the law at present in force. And it is to-day well settled that neither the name nor address is requisite to the validity of a trademark. On many other questions the decisions are equally conflicting.

#### CLASSES OF TRADEMARK CASES—UNFAIR COMPETITION.

From a consideration of the cases involving the right to use a trademark which have been brought before the courts, it is clear that there are two clearly defined classes of these cases; first, cases of unfair competition; and, second, cases in which the question of the property right in the mark is involved between two persons who have independently adopted and used the same mark. The first class of cases presents little difficulty. It is obvious that the counterfeiting or imitation of a mark known to be the distinguishing mark borne by the goods of a particular trader is attended by injurious consequences of a serious character from two points of view. The rightful owner of the mark suffers by the diminished sale of his goods, and incurs also the risk of serious injury to the reputation of his goods, since the goods placed upon the market under a false mark are almost invariably inferior in quality to those sold by the rightful owner. And the purchaser is injured as well, for the public is induced by the false mark to believe that it is purchasing something different from what it actually receives.

The deliberate and willful imitation of the mark known to belong to another is so plainly a fraud upon his rights that from very early times the courts have not hesitated to protect the rightful owner against those who knowingly counterfeited or imitated his mark. It does not, however, appear, as has been above stated, that the right of the owner of the mark to the protection of the courts of equity was recognized until long after his right to the protection of the law courts had been recognized. But it is clear that the remedies which could be afforded by even the courts of equity were far from adequate to effectually prevent or redress the infringement upon the rights of the proprietor of a trademark. An award of damages against a willful infringer is clearly an inadequate punishment of the fraud of which he has been guilty, and is not sufficient to deter others from infringement. An injunction against further infringement is not greatly feared by those who deliberately counterfeit another's mark, and at best is effective only as to the future and as to the persons specially named in it. The willful counterfeiter of another's mark is entitled to no better treatment than the criminal who takes the goods of another. This is now widely recognized, as is evident from the fact that in all foreign countries which have trademark laws, and indeed in nearly all of the States of the United States, the willful infringement of a trademark is by express provision of statute law made an offense punishable by fine and imprisonment. Yet under the common law of trademarks, as it is understood to-day by the United States courts, the owner of a trademark is afforded no protection against infringers, save that of damages and injunction.

To entitle the user of a mark to such remedies as may be afforded under the common law, it is, generally speaking, necessary only to show that the infringer has knowingly copied or imitated his mark, whatever that mark may be. It is of comparatively little importance in what the mark may consist, whether it be a trademark in the tech-



nical sense or the mere dress and appearance of an article as put upon the market, a word which primarily was clearly descriptive, or even the name of the manufacturer or dealer. The question is as to the intent of the infringer, and if the circumstances show that the intent was fraudulent, the rightful user of the mark is entitled to damages and injunction.

It is clear that cases of this class, cases of unfair competition, are reached by the common law of trademarks, but it is equally clear that the common-law remedies are insufficient to adequately protect the rightful owner of the mark.

#### CASES INVOLVING THE PROPERTY RIGHT TO A TRADEMARK.

To the other class of cases, and such cases often arise and are usually of even more importance than cases of unfair competition, belong those in which it being found that two manufacturers or dealers have adopted and used the same or similar marks, each without knowledge of use of the mark by the other, suit is brought by the party claiming the better right to its exclusive use to enjoin the other from using it. There is in such cases no element of fraud, but it is evident that it may be of quite as much importance to the legal owner of the mark to prevent its use by another who may have used it in good faith as to prevent its fraudulent use by others.

That a manufacturer or dealer engaged in a particular line of business should unintentionally select as a mark for a particular class of goods sold by him the same mark which has previously been used by another for the same class of goods as a matter of fact has repeatedly happened. So many instances of the adoption by two or more traders of substantially the same mark were found when the trademark registration act of 1875, of Great Britain, went into effect that it was found necessary to frame a rule known as the "three-mark rule," under which identical or similar "old marks," i. e., marks in use before the date of the act, might be registered by different persons up to the number of three, but not more; the rule providing that if the mark had been used *bona fide* by more than three persons it must be treated as common to the trade and no registration at all allowed. This seems remarkable without a clear understanding of what sort of devices are used as trademarks.

It is the exception that there is anything novel or elaborately artistic about a trademark. There is seldom anything which involves study or invention or skill of any sort in the trademark itself. The larger proportion of those in use consist of a single simple device or a single word. It is generally considered that a mark to be effective for its purpose should be as simple and striking as possible, should either consist of or have as a prominent feature some representation or word which will be readily caught by the eye of the purchaser and retained in his memory, so that when he comes to make a second purchase he will look for and readily recognize that particular mark. Such a trademark is, for instance, the representation of a star, an arrow, anchor, crescent, crown, cross, diamond, seal, triangle, or the word "star," "arrow," etc.

The representation of a star or the word "star" has been registered in the United States Patent Office as a trademark for nearly every recognized class of goods, having been registered nearly 400 times,

indicating that, leaving out of consideration reregistrations to the same owner, made necessary by a change in the law, several hundred manufacturers and dealers have adopted and used that mark on some class of goods. In about 150 instances, the representation of an anchor or the word "anchor" has been registered.

It will, of course, be understood that a star or an anchor or any other mark may be used by manufacturers of or dealers in different classes of goods without conflict. For instance, the use of a star as a mark for tobacco does not conflict with the use of a star as a mark for matches or dress braid. It is only when two persons put upon the market goods of the same class bearing the same mark that confusion in the mind of the public is liable to be caused or purchasers are deceived.

Comparatively few such cases arose under the commercial conditions which prevailed up to the middle of the present century. No doubt under the conditions then prevailing the same mark was used by different manufacturers and dealers, but from the fact that the cost of transportation precluded the sending of goods any considerable distance from the locality of their production, competition was necessarily restricted to those who necessarily knew the trademarks used by their rivals in trade. Whether the holding in the case of *Blanchard v. Hill*, above referred to, was correct or not was of comparatively little importance at the time that decision was rendered or for many years thereafter.

As manufacturing increased and the facilities for transportation were improved, competition became less restricted and it was found that the goods of a manufacturer or dealer must be sold in competition not only with others in his immediate locality, whose marks were well known to him and to whom his marks were well known, but with those located at a great distance, even in a foreign country, of whose very existence he was not aware and of whose trademarks he could know nothing. In the wider market made accessible by the reduction in the cost of transportation, not only was the value of a distinctive trademark vastly increased by reason of the increased sale of goods, but the possibility that such mark had been used by others was greatly increased. It therefore happened that the question of the right of ownership in a distinctive mark between those who had adopted and used it in good faith and had made it valuable was frequently raised before the courts of England and the United States. With no statutory provision to guide them, without precedent to sustain them, in the face of a decision which had stood unchallenged for nearly a century, the courts of England and the United States, recognizing the necessities of the case, met these necessities by creating the so-called common law of trademarks. First, it was necessary to hold that there could be a property right in the exclusive use of a particular mark. It was so held in *Millington v. Fox*, above referred to, although to so hold was contrary to the holding in *Blanchard v. Hill*. It was then necessary to determine how this property right could be acquired, under what circumstance it was lost and what kinds of marks could and what could not be the subject of such property right.

#### THE NECESSITY FOR REGISTRATION OF TRADEMARKS.

The way in which this so-called common law of trademarks arose and the reasonable objections which exist to this law as it is applied to



this class of cases, is well stated in the dissenting opinion of Judge Robertson, of the court of appeals of New York, in the case of *Burnett v. Phalon* (9 Bos., 192, 5 Abb. Pr. R. N. S., 212, 3 Keyes, 594, Cox Am. Trade-mark Cases, 376, 1867), in which, after referring to the common liability of every one who palmed off upon the public his commodities as those of another man, to the deceived customer, and indirectly to the supplanted competitor, he says:

Equity seized on jurisdiction to prevent repetitions of the wrong and, with its customary eagerness to amplify such jurisdiction and model the relief granted by it to every phase of such wrong, created the doctrine of what are called trademarks. In doing so, it has nearly established a common law copyright of perpetual duration, permitting an injunction without a trial at law, calling upon the defendant for an account of his profits, and even attempting to reach what are claimed to be instruments prepared for future fraud. This may be a very healthful jurisdiction, but, without great care, its searching character may be made an instrument of wrong. Much is said of the injustice of allowing one man to avail himself of the skill and expenditure of another by false representations, which is well founded; but where, instead of using the name of the owner or vendor, strange devices and insignia are employed to indicate such ownership or source, which do so but ambiguously, and require considerable familiarity and experience with them to connect them therewith, no great sympathy is created for those using such devices.

Were they the subjects of copyrights, or other modes of warning mankind against trespassing on a settled right, there would be greater justice in punishing the trespasser; but the most innocent may be caught unwarily in a litigation where a word is employed as a device originating in some measure from the materials used in forming a composition, as in this case, where one of the plaintiffs admits that he framed Cocaine as a word, and that it was suggested by the cocoanut oil employed in the manufacture of the article, while the discoverer of the word Cocaine claims that is a word framed according to the genius of the French language, to express the extract of that oil.

While it is a general principle of the common law that a property right can not be acquired without notice of such right, and trespassers can not be held liable unless they have reasonable notice of such claim, particularly if the thing in which the property right is one which is not to be necessarily presumed to be the property of another, the courts were compelled to hold, not only that the user of a trademark acquired by such use a right to the mark, but that such right was an exclusive right and could be enforced against another who used the mark without actual notice of the claim of right. That the notice, which consists merely in the use of the mark on goods is in many cases, particularly to others located at a great distance, not actual notice of the claim of the first user to the exclusive property in the mark, has been found to be a fact in many cases. To hold that the mere use of the mark is a sufficient notice to warrant the courts in depriving another who never saw, and from the circumstances of the case could not have seen, the goods bearing the mark, is recognized by Judge Robertson as seriously objectionable and undoubtedly may, and frequently does, work a great hardship. Yet as the common law did not provide any way other than use of the mark on goods by which notice could be given of the claim of exclusive property in the mark, it was necessary in order to hold that trademarks could be the subject of a property right that such notice was sufficient, whatever of hardship such holding might involve.

The right of property was, however, limited by the courts to marks which were of an arbitrary character, distinctly different from those which it must be presumed would naturally be used by others who produce or deal in the class of goods to which the mark is applied. As was said by the United States Supreme Court in the case of *Canal Co. v. Clark* (13 Wallace, 311), a case which arose under the common



law, quoting from the opinion of Judge Duer, in the case of *Amoskeag Mfg. Co. v. Spear* (2 Sandf., S. C., 599):

(One) has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose.

#### TRADEMARK LEGISLATION IN GREAT BRITAIN.

The fact that the remedies afforded by the common law were insufficient to adequately protect the owners of trademarks from willful fraudulent use of their marks by others led in Great Britain to the adoption of the merchandise marks act of 1862 which provided that—

Every person who, with intent to defraud, or to enable another to defraud, any person, shall forge or counterfeit, or cause or procure to be forged or counterfeited any trademark \* \* \* shall be guilty of a misdemeanor,

and provided that every person found guilty of such misdemeanor should be liable to punishment “by imprisonment for not more than two years with or without hard labor or by fine, or both by imprisonment with or without hard labor and fine.”

This statute supplied, as far as Great Britain was concerned, what was lacking in the common law as to protection of trademarks against willful infringers; that is, those who had actual knowledge of the use of a particular mark by its owner, and deliberately and with intent to defraud made use of such mark. Nothing more was needed so far as the cases of unfair competition in which actual knowledge of prior use of the mark could be proved were concerned. It did not reach the cases in which such actual knowledge could not be proved, since it provided no means by which the owner of the mark could give such notice, “such warning against trespassing on a settled right,” that others could be legally presumed to have knowledge of his claim to the exclusive property in his mark and for the same reason it was not calculated to give any relief in the second class of cases above referred to, those in which there was no knowledge by the latter user of the claim of the first user to the property right in the mark and no intent to defraud.

Under the law as it then stood in Great Britain, it was almost impossible for a manufacturer to ascertain whether any particular mark which he might wish to adopt as a distinguishing mark for his goods was one which he was free to adopt and make his own or had been already appropriated. He could not be certain that after he had used a mark for a considerable time and had made it valuable, he would not be compelled to yield his right to its use, and with it in great part the business which he had built up, to some one whose use of the mark perhaps in a merely local market was prior in date. The same difficulties were found to exist in this country with the difference that at the time there was no statute punishing willful infringement of a trademark.

These difficulties led in Great Britain in 1875 to the adoption of an act which not only created an office for the registration of trademarks and permitted owners of trademarks to register their marks, but made such registration essential to the protection of such marks by the courts. The first section of this act is as follows:

1. A register of trade-marks as defined by this act and of the proprietors thereof shall be established under the superintendence of the commissioner of patents, and from and after the first day of July, one thousand eight hundred and seventy-six, a

person shall not be entitled to institute any proceeding to prevent the infringement of any trademark as defined by this act until and unless such trademark is registered in pursuance of this act.

In thus adopting a compulsory registration law Great Britain was following the example of other commercial nations, all of the more important European countries having adopted prior to that date, some of them long prior thereto, similar laws. In some of these countries not only is registration of trademarks required as a prerequisite to the recognition of his legal right to its exclusive use, but registration, which is in this country public notice of the claim of an exclusive right to a particular mark and nothing more, is considered of such importance that the first to file the mark for registration is by law the owner of the mark. Such laws, of which that of Germany<sup>1</sup> is a good example, are known as attributive laws, while that of France<sup>2</sup> under which registration, though necessary to obtain the full benefit of the law, is not essential to ownership, is, like the United States law so far as that law can be said to afford any protection to trademarks, known as a declaratory law.

#### ADVANTAGE OF REGISTRATION OF TRADEMARKS TO THE PUBLIC.

The necessity and advantages to the public of providing for the registration of trademarks is well set forth in the explanatory statement made by the Ministers of Justice and of Commerce, etc., and annexed to a bill respecting trademarks presented to the chamber of the States-General of the Netherlands in 1879, which bill was subsequently passed and became the law of May 25, 1880, of the Netherlands, as follows (translation given in a commercial report No. 12 of 1879, presented to the British Parliament):

The State should afford an opportunity to the public to acquire authentic information with regard to those marks, for the exclusive right to which application may have been made. The means afforded for depositing and reporting marks in places accessible to the public conduce to this object. By this means the precise nature of the mark itself, as well as the date from which the general employment of such work ceases to be allowed, will be exactly determined. In this way it will be possible for persons interested to prove their right in a simple and inexpensive manner, while other persons can secure themselves against the unintentional assumption of a mark similar to one already used by another person.

#### PROTECTION TO TRADEMARKS UNDER THE ACT OF 1881.

The trademark act of March 3, 1881, is not only merely declaratory in that it does not make the right of property in any trademark depend for its inceptive existence or support upon the requirements contained therein, but, as has been above pointed out, it adds nothing to the common law so far as concerns the prevention or redress of infringements of trademarks registered in compliance with its provisions. The law thus contains nothing which is effective to induce, much less compel, the owners of trademarks to register them. It gives at most a mere color of protection. It provides a means by which owners of certain trademarks may, if they choose, give notice of their claims to an exclusive right in such marks, warning mankind against trespassing upon such rights, but does not make such notice effective to give the registrant any substantial advantage against infringers which he may not have without registration. It permits registration without requiring it.

<sup>1</sup> Appendix, Chap. XXII, p. 352.

<sup>2</sup> Appendix, Chap. XXIII, p. 363.



Further, this act provides for the registration only of trademarks used in commerce with foreign nations or with the Indian tribes, not even permitting owners of trademarks used in the internal commerce of this country to give notice to their claim of an exclusive right in their marks, to warn others against trespassing upon such rights. As was pointed out in the explanatory statement made by the Ministers of Justice and of Commerce, etc., of the Netherlands, above referred to, this notice is of distinct importance to the general public. In fact, it is of quite as much importance as to the owner of the mark, of so much importance that the justice of holding a mark to be the exclusive property of such owner as against another who uses it without notice has been seriously questioned. (See the dissenting opinion of Judge Robertson in *Burnett v. Phalon*, above referred to.)<sup>1</sup>

#### CONSTITUTIONAL POWER OF CONGRESS WITH RESPECT TO TRADEMARKS.

That Congress has no power under the Constitution to provide for the registration or protection of trademarks used in commerce carried on wholly within one of the States of the Union has been decided by the Supreme Court in the Trademark Cases (100 U. S., 82).<sup>2</sup> But that court has not held that Congress is without power under the Constitution to provide by law for the registration and protection of trademarks used in commerce among the several States. That trademarks used in such commerce, but not in commerce with foreign nations or with the Indian tribes, are much more numerous than the marks entitled to be registered under the act of 1881 can not be doubted. The commerce of the United States with foreign nations, so far as manufactures are concerned (and it is to be remembered that trademarks are practically not used to any considerable extent except upon manufactures), has, up to very recent years, been inconsiderable in comparison with the commerce in manufactures among the several States. That trademarks are used in interstate commerce to a very great and rapidly increasing extent is apparent to anyone who has considered the subject. Even if it could be assumed that all trademarks entitled to registration under the act of 1881—that is, trademarks used in commerce with foreign nations and with the Indian tribes—were registered, it is evident that the register of trademarks, which had become by adoption and use the subject of an exclusive property, would be far from complete and would not enable the public to acquire authentic information as to the marks in use, such as would enable persons to secure themselves against the unintentional assumption of a mark similar to one already used by another. While it may be that even to provide for the registration of marks used in interstate commerce would not result in placing upon the register all marks which have become the subject of an exclusive property, since no doubt some marks are used in commerce which is carried on exclusively within a single State, there can be no doubt that it would result in making the register far more nearly complete, and it is believed would make it practically complete, since with modern methods of transportation there is little difficulty in extending the trade in any manufactured article of substantial merit beyond the confines of the State in which its manufacture is carried on. In the interests of the public the owner of a trademark used in interstate commerce should be permitted to give notice of his claim of property in his mark by registering it in

<sup>1</sup> Page 112.

<sup>2</sup> Appendix, Chap. XXV, p. 413.



the Patent Office, if Congress has under the Constitution the power to provide for the registration of such marks.

That the power of Congress to provide for the registration of trademarks used in interstate commerce—and the same is true as regards trademarks used in foreign commerce and commerce with the Indian tribes—must be derived, if it exists at all, from the third clause of section 8 of Article I of the Constitution, which, read in connection with the granting clause, is as follows:

The Congress shall have power to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes,

is clear from the decision of the Supreme Court in the Trademark Cases (100 U. S., 82), before referred to.<sup>1</sup> Whether Congress has this power depends, as stated by the Supreme Court in that decision, upon the question “whether the trademark bears such a relation to commerce in general terms as to bring it within Congressional control where used or applied to the classes of commerce which fall within that control.”

#### THE RELATION OF TRADEMARKS TO COMMERCE.

That the trademark is generally accepted as bearing a close relation to commerce is evident from its very name. And this is true as well if the French term “mark of manufacture and of commerce” (*marque de fabrique et de commerce*) is considered. So, too, if the German term, “merchandise mark” (*Waaren-zeichen*) is considered. And though a trademark may be the property of a manufacturer as well as of a trader, he acquires and retains the right to the exclusive use of the mark only by placing his goods which bear it upon the market. In other words, the manufacturer can be an owner of a mark only by reason of the fact that he is necessarily a trader to the extent of disposing of his goods to others, whether those to whom he sells his goods are consumers or are traders who buy to sell again. The ownership of a mark is inseparable from its use in trade. No one who does not actually use the mark can have a right of property in it. It is like the good will of a business, absolutely inseparable from the business. Its close relation to commerce has been recognized by the courts from the earliest times. In the case of *Blanchard v. Hill*, before referred to, Lord Hardwicke in 1742 refused to recognize a right of property in a trademark on the ground that to do so would, in his opinion, “be of mischievous consequence;” that is, would have the effect of creating monopolies in trade; and while this view is to-day recognized to be wrong, the very fact that he considered that an exclusive right to a trademark would operate as a restraint upon trade shows that he recognized the intimate relation which the trademark bears to commerce. In one of the earliest trademark cases which came before a United States court, the case of *Taylor v. Carpenter* (circuit court U. S., dist. of Mass., 1846; 2 Wood & M. I.; Cox, Am. Trademark Cases, 32), the right to protection of a trademark is recognized as inseparable from the right to trade. In this decision Judge Woodbury says:

We are under treaty obligations to Great Britain and most other European powers to admit their merchandise on favorable terms and to allow their merchants to trade here as those of favored nations. But it would be a mockery of such provisions and enjoyments if we prevented them from selling their goods after arriving

<sup>1</sup>Page 103.

here (Ch. J. Marshall in *Brown v. State of Md.*, 12 Wheat., 447), unless noxious to health or morals; or if we made onerous discriminations against them or prevented their receiving the proceeds of their goods or abstained from *yielding protection against injuries to them or to their marks.*

The report made by Thomas Jefferson, above referred to, is such as to leave no doubt of his opinion as to the intimate relation which the trademark bears to commerce, or as to the power of Congress under the commerce clause of the Constitution to provide for the registration and protection of trademarks used in interstate as well as foreign commerce.

The experience of the commercial world has demonstrated the practical importance, the absolute necessity to a proper regulation of commerce of the recognition of a property right in trademarks and the protection of this right. No country other than the United States has in its constitution a provision limiting the power of the General Government to regulate commerce generally, and all countries which have any pretension to commercial importance provide in their trademark laws for the registration and protection of the trademarks of their citizens or subjects without regard to the kind of commerce in which they are used, and no question of the constitutionality of such laws appears to have arisen in any foreign country. The universal recognition of the intimate relation between the trademark and commerce appears from the fact that in the laws of all of the more important countries the right of property in a trademark is accorded only to manufacturers or traders, is dependent on its use on the goods of its owner, and is transferable only with the transfer of the business in which it is used or so much of it as relates to the manufacture and sale of the goods to which it is applied. The right to the mark may be perpetual, provided the manufacture and sale of the goods continue. If the business is abandoned the right to the trademark ceases to exist.

#### TRADEMARK TREATIES.

All of the countries of the world which are large exporters of manufactured articles have found it of vital importance to their export trade to secure through diplomatic action from the countries in which their manufactures find a market assurance that the trademarks of their citizens or subjects should be protected against infringement. Great Britain, France, and Germany, in fact all of the more important European nations, have been most energetic in their endeavors to secure such assurances from all countries in which there was opportunity for trade with the result that to-day the trademarks of the manufacturers and exporters of these countries are, under reasonable conditions of registration, entitled to protection throughout the world. The diplomatic agreements by which these advantages are secured are in many cases made a part of treaties of commerce and navigation, as in the treaties on these subjects concluded between the United States and Russia, 1868;<sup>1</sup> the United States and Belgium, 1868;<sup>2</sup> the United States and Germany, 1871;<sup>3</sup> the United States and Serbia, 1881;<sup>4</sup> and the United States and Japan, 1894,<sup>5</sup> and in many of the treaties between European nations and between European and other nations.

<sup>1</sup>Appendix, Chap. XVIII, sec. 11, p. 335.

<sup>2</sup>Appendix, Chap. XVIII, sec. 2, p. 326.

<sup>3</sup>Appendix, Chap. XVIII, sec. 6, p. 331.

<sup>4</sup>Appendix, Chap. XVIII, sec. 12, p. 336.

<sup>5</sup>Appendix, Chap. XVIII, sec. 9, p. 332.



## SECTION 11 OF THE ACT OF JULY 24, 1897.

The Congress has distinctly recognized the relation of the trademark to commerce and the necessity for protecting domestic manufactures against infringements of their rights by foreigners by repeatedly reenacting, as has been above pointed out, the law which now stands as section 11 of the act of July 24, 1897, under which is prohibited the admission to entry at any custom-house of the United States of any articles of imported merchandise which copy or simulate the name or trademark of a domestic manufacturer, a law which commends itself as just and necessary to the protection of the manufacturing industries of this country, but which must rest for its constitutionality solely on the clause of the Constitution which gives to Congress the power to regulate commerce with foreign nations, and on such a construction of that clause as brings the regulation of trademarks a part of the general regulation of commerce. That this law is valid as being within the power of Congress under the Constitution is not doubted.

## IMPORTANCE TO COMMERCE OF THE PROTECTION OF TRADEMARKS.

That the protection of trademarks used in commerce among the several States is necessary if honest competition is to be encouraged, and it can hardly be questioned that it is as important to the public interest that honesty in competition should be encouraged, a competition which stimulates effort and leads to excellence, as it is that contracts in restraint of trade should be prohibited, is not open to doubt. The only question necessary to be considered is by what authority they should be regulated and protected.

In the case of *Addyston Pipe & Steel Co. v. U. S.* (175 U. S., 211), decided by the Supreme Court at the October term, 1899, it was said, in the opinion of the court, delivered by Mr. Justice Peckham, in reference to private contracts which were intended to operate to prevent fair and open competition, that:

It is, indeed, urged that to include private contracts of this description within the grant of this power to Congress is to take from the States their own power over the subject, and to interfere with the liberty of the individual in a manner and to an extent never contemplated by the framers of the Constitution, and not fairly justified by any language used in that instrument. If Congress has not the power to legislate upon the subject of contracts of the kind mentioned, because the constitutional provision as to the liberty of the citizen limits to that extent its power to regulate interstate commerce, then it would seem to follow that the several States have that power, although such contracts relate to interstate commerce and more or less regulate it. If neither Congress nor the State legislatures have such power, then we are brought to the somewhat extraordinary position that there is no authority, State or National, which can legislate upon the subject of or prohibit such contracts. This can not be the case.

If it should be held that Congress has no power and the State legislatures have full and complete authority to thus far regulate interstate commerce by means of their control over private contracts between individuals or corporations, then the legislation of the different States might and probably would differ in regard to the matter, according to what each State might regard as its own particular interest. One State might condemn all kinds of contracts of the class described while another might permit the making of all of them, while still another might permit some and prohibit others, and thus great confusion would ensue and it would be difficult in many cases to know just what law was applicable to any particular contract regarding and regulating interstate commerce. At the same time contracts might be made between individuals or corporations of such extent and magnitude as to seriously affect commerce among the States. These consequences would seemingly necessarily follow if it were decided that the State legislatures had control over the subject to the extent mentioned.



Applying the language of the court in this decision to the question of the prevention of unfair competition in interstate commerce by providing for the protection of trademarks used in such commerce, may it not be said that—

If neither Congress nor the State legislatures have the power to protect such trademarks, then we are brought to the somewhat extraordinary position that there is no authority, State or National, which can legislate upon the subject of or protect such trademarks. This can not be the case.

#### DECISIONS OF UNITED STATES COURTS ON TRADEMARKS.

If it should be held that Congress has no power and the State legislatures have full and complete authority to regulate interstate commerce by determining the conditions under which trademarks used in such commerce are to be protected, then it must be said that the condition of affairs with respect to such trademarks, which in respect to certain contracts is pointed out in this decision of the Supreme Court as seriously objectionable, has already arisen. Nearly all of the several States have already, as has been above set forth, adopted laws providing for the registration and protection of trademarks. These laws are far from uniform, and if they are to be taken as applying to trademarks used in interstate and foreign commerce (for, as stated in the above decision of the Supreme Court, "when we speak of interstate we also include in our meaning foreign commerce"), a condition which is far from desirable is presented. The right to the ownership of a trademark, the question of what constitutes a trademark, and the other important questions on which the protection of trademarks depends would be, and to some extent are to-day, subject to inconsistent and contradictory decisions among the courts of the different States, and that, too, upon matters which pertain to the regulation of interstate commerce. Numerous cases involving trademarks between citizens of different States and even between subjects of foreign nations and citizens of the United States have been brought before State courts, and such courts have taken jurisdiction of and decided such cases. The plaintiff in the case of *Amoskeag Mfg. Co. v. Spear* (2 Sand., S. C., 599, Cox Am. Trade-mark Cases, 67), decided in 1849 in the superior court of the city of New York, which is recognized as a leading case on the subject of trademarks and has been repeatedly cited with approval by the Supreme Court, was a corporation engaged in the manufacture of cotton goods at Amoskeag Falls in the State of New Hampshire. The complainants in the case of *Taylor v. Carpenter* (11 Paige, 392, and 2 Sand., Ch. R., 603; Cox Am. Trademark Cases, 45), decided in 1846 by the court for the correction of errors of New York, were British subjects of the borough of Leicester, England. In *Coats v. Holbrook* (2 Sand., Ch. R., 586, Cox Am. Trademark Cases, 20) decided in 1845 in the court of chancery of New York, the complainants were British subjects located at Paisley, Scotland. In *Derringer v. Plate* decided by the supreme court of California (29 Cal., 292, Cox Am. Trademark Cases, 324) the plaintiff was a resident of Pennsylvania.

Cases in which the same conditions, as to residence of the parties, obtained have been decided by courts of the United States. Not a few of these cases have by appeal been brought before the Supreme Court. Nearly all of the later cases involving a controversy as to the right to a trademark between citizens of different States or between an alien

and a citizen of the United States have been brought before United States courts under the provision of the Constitution which extends the judicial power of the United States courts to "controversies \* \* \* between citizens of different States \* \* \* and between a State, or the citizens thereof and foreign States, citizens or subjects." (Article III, sec. 2.)

#### COMMON LAW OF THE UNITED STATES.

The United States courts in deciding the trademark cases brought before them have applied the principles of the so-called common law of trademarks. The right to entertain jurisdiction of such cases or to decide them in accordance with the so-called common law of trademarks was assumed in the first trademark case brought before a United States court, the case of *Taylor v. Carpenter*, before referred to,<sup>1</sup> decided in 1844 by Judge Story in the circuit court for the district of Massachusetts) 3 Story, 458, *Cox Am. Trade-mark Cases*, 14), and no question of the right of the United States courts to apply in such cases this common law of trademarks appears to have been raised in any of the numerous cases thereafter decided by such courts, notwithstanding that this common law of trademarks was not the common law as it was held to exist prior to the separation of this country from Great Britain, but was the law derived from decisions rendered in the courts of Great Britain long subsequent to such separation, and notwithstanding that in a case involving copyright, a subject in many respects analogous to that of trademarks, it had been distinctly held by the Supreme Court that:

It is clear there can be no common law of the United States. The Federal Government is composed of 24 sovereign and independent States, each of which may have its local usages, customs, and common law. There is no principle which pervades the Union and has the authority of law that is not embodied in the Constitution or laws of the Union. The common law could be made a part of our Federal system only by legislative adoption.

When, therefore, a common-law right is asserted, we must look to the State in which the controversy originated; and in the case under consideration, as the copyright was entered in the clerk's office of the district court of Pennsylvania, for the first volume of the book in controversy, and it was published in that State, we may inquire whether the common law as to copyrights, if any existed, was adopted in Pennsylvania.

It is insisted that our ancestors when they migrated to this country brought with them the English common law as a part of their heritage.

That this was the case to a limited extent is admitted. No one will contend that the common law as it existed in England has ever been in force in all its provisions in any State in this Union. It was adopted so far only as its principles were suited to the condition of the colonies, and from this circumstance we see what is common law in one State is not so considered in another. The judicial decisions, the usages, and customs of the respective States must determine how far the common law has been introduced and sanctioned in each. (*Wheaton et al. v. Peters et al.*, 33 U. S.; 8 Peters, 791.)

Notwithstanding this decision the United States courts, as well as the State courts, clearly recognizing the necessity of some law under which the right of the owner of a trademark to an exclusive property in its use could be protected, have not hesitated to so far apply the so-called common law of trademarks that it seems to be to-day recognized by the Supreme Court as the law of the land. In the decision of the Supreme Court in the *Trademark Cases* (100 U. S., 82), before cited, it is said:

The right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other



persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the States. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.

These propositions are so well understood as to require neither the citation of authorities nor an elaborate argument to prove them.

So, too, in *Manufacturing Co. v. Trainer* (101 U. S., 51), the court says:

The general doctrine of the law as to trade-marks, the symbols or signs which may be used to designate products of a particular manufacture, and the protection which the courts will afford to those who originally appropriated them, are not controverted. Everyone is at liberty to affix to a product of his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of the same general nature manufactured or sold by others, and thus secure to himself the benefits of increased sale by reason of any peculiar excellence he may have given it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trade-mark, and the courts will protect him in its exclusive use, either by the imposition of damages for its wrongful appropriation or by restraining them to account for profits made on a sale of goods marked with it.

See also *Manhattan Co. v. Wood* (108 U. S., 218), *Menendez v. Holt* (128 U. S., 514), and *Richmond Nervine Co. v. Richmond* (159 U. S., 293), in all of which the right of property in a trademark and the right of the owner of the mark to the protection of the courts is distinctly recognized.

The Supreme Court while intimating in the Trademark Cases (100 U. S., 82), above referred to, that "the property in trademarks and the right to their exclusive use rest on the laws of the States, and, like the great body of the rights of person and of property, depend on them for security and protection," in its decisions in other trademark cases rendered both before and since the decision in the Trademark Cases have followed the circuit courts of the United States in looking not to the State in which the controversy arose to determine, from the judicial decisions, the usages and customs of that State, how far the common law had been there introduced and sanctioned, as was distinctly held should be done in *Wheaton et al. v. Peters et al.*, above referred to, but to the decisions of the courts of Great Britain of recent date, and even decisions of the courts of France, as well as decisions of the State courts of States other than that in which the controversy arose.

#### THE BASIS OF THE COMMON LAW OF TRADEMARKS.

In the first trademark case brought before a United States court, the case of *Taylor v. Carpenter*, above referred to<sup>1</sup> (suit in equity), decided in 1844 by Judge Story in the circuit court for the district of Massachusetts (3 Story, 458, Cox Am. Trademark Cases, 14), the court relied for its authorities, by referring to 2 Story Eq., sec. 951, on decisions of the English courts rendered in 1837 and 1838. In the second trademark case brought before a United States court, the case of *Taylor v. Carpenter* (suit at law), decided in 1846 by Judge

<sup>1</sup> Page 93.



Woodbury in the circuit court for the district of Massachusetts (2 Wood & M., 1, Cox Am. Trademark Cases, 32), the court based its decision almost exclusively on decisions of the English courts, referring also to the statutes of the State of New York. In the case of *Fowle v. Spear*, decided in 1847 by Judge Kane in the circuit court for the eastern district of Pennsylvania (7 Penn. L. J., 176, Cox Am. Trademark Cases, 67), the court applied the principles of the English case of *Pidding v. How*, decided in 1837, this being the only authority cited. In other cases decided by the circuit courts of the United States, substantially the same condition is found, the decisions mainly relied on being the decisions of the English courts.

In the case of *McLean v. Fleming*, decided by the Supreme Court in 1877 (96 U. S., 245), the authorities on the question of trademarks were fully reviewed and the rules determined from them were applied to the case, the right of the complainant to protection for his trademark being affirmed. The authorities cited as determining the principles of the trademark law were for the most part decisions of the English courts, many of them of comparatively recent date, and decisions of the State courts of the State of New York, and of the State courts of Massachusetts, Pennsylvania, and Connecticut, and though the controversy appears to have arisen in the State of Missouri, no judicial decisions rendered in that State are cited.

In the case of *Singer Mfg. Co. v. June Mfg. Co.*, decided by the Supreme Court in 1896 (163 U. S., 169), decisions of State courts of Massachusetts and New York, as well as decisions of the United States circuit courts rendered in several different circuits, are cited as determining the principles of the law applicable to the cases before the court, and in support of these principles English decisions are cited. The opinions of French writers and decisions of French courts are also cited, and it is stated, as having a distinct bearing on the question before the court, that the "French writers and courts recognize the doctrine to be substantially like that which is enforced in America and England."

#### NECESSITY FOR A GENERAL TRADEMARK LAW.

It would seem from these decisions that the United States courts recognizing the necessity of a law for the protection of trademarks which should be uniform throughout the length and breadth of the land, finding no statute law on the subject and finding that the common law as determined by the judicial decisions, usages, and customs of Great Britain, and of certain of the States in which the common law has been accepted, commended itself as just and reasonable, have given to such law the force and effect of statute in all trademark cases brought before them without regard to the question of the judicial decisions, usages, and customs of the particular State in which the controversy arose. The attitude of the Supreme Court toward the question of the protection of trademarks as shown by their decisions, and this is true as well of the attitude of the circuit courts, seems to be indicated in the decision of that court in the case of the *Addyston Pipe & Steel Co. v. U. S.*, above referred to,<sup>1</sup> in which it is said:

But upon the matter of interstate and foreign commerce and the proper regulation thereof, the subject being not alone national, but international in its character, the great importance of having but one source for the law which regulates that commerce throughout the length and breadth of the land can not in our opinion be overestimated.

That this view of the question is fully warranted and that a clear necessity exists for a uniform law for the protection of trademarks used in interstate and foreign commerce is apparent. Not only are the rights of owners of trademarks located in the United States to be considered, but also the rights of alien owners of trademarks, especially since the United States is bound under the conditions of the treaties above referred to, which have been entered into with foreign nations on this subject, to afford to such owners of trademarks as are subjects or citizens of such foreign countries protection for their trademarks. To compel such alien owners of trademarks to go into the State courts and to comply with the conditions of State laws with respect to registration is manifestly unreasonable. Yet this is practically required under present conditions. The State laws, as has been above stated, very generally protect trademarks registered in accordance with their provisions, by providing that willful infringers of trademarks so registered may be punished by fine and imprisonment, thus giving a protection far more adequate than that given by the so-called common law of trademarks which is applied by the United States courts. In order to secure this additional protection, the foreign owner of a trademark must not only comply with the requirements of the treaty which requires him to deposit his mark at the Patent Office in Washington, paying the fee and complying with the requirements of the act of 1881, but must also pay the fees required for registration in the several States and comply with the various requirements of the several laws. Unless he does so, he is not to-day given the protection for his trademark which is given to citizens of the United States.

That this is a serious difficulty and one which has resulted in material embarrassment to foreign owners of trademarks, and has given rise to an impression among them that the United States is not disposed to carry out its treaty obligations in good faith, since they are unable to believe that it is powerless under the constitutional limitations to do so, is well known. At the several conferences held under the International Convention since the adhesion of the United States thereto, this matter has been brought up by the delegates from foreign nations. At the recent conference at Brussels in 1897, the French delegates presented the following resolution:

That the Government of the United States of America attempt in every way to provide as soon as possible Federal legislation which will replace local legislation in reference to trademarks, and will insure an easier and more efficient suppression of trademark infringements.

While it may be that this difficulty can not be wholly overcome, since the laws adopted by State legislatures on the subject may not and undoubtedly will not be uniform in all respects with the laws which may be adopted by Congress as regards the protection of trademarks and the remedies against infringers, and local—that is, State—legislation on the subject of trademarks in so far as regards the commerce which may be regulated by the States can not, under the Constitution, be replaced by legislation by Congress, there is no question that this difficulty would be largely done away with by the adoption by Congress of a law which should adequately provide for the registration and protection of trademarks used in commerce among the several States, as well as commerce with foreign nations and the Indian tribes.



## POWER OF CONGRESS TO REGULATE TRADEMARKS.

That Congress may enact into law the so-called common law of trademarks, which is now given the force and effect of statutory law by the United States courts making that law applicable to controversies respecting trademarks, of which the United States courts have jurisdiction under the provisions of the Constitution—that is, controversies arising between citizens of different States and between citizens of the United States and citizens or subjects of foreign States—seems clear. That the United States courts have no jurisdiction over controversies with respect to trademarks arising between citizens of the same State, except as jurisdiction as to such cases has been or may be given by act of Congress, is also clear. (See *Ryder v. Holt*, 128 U. S., 525, and *Trade-mark Cases*, 100 U. S., 82, before referred to.<sup>1</sup>)

That manufactures made and consumed within a State are subject to State legislation and are not subject to regulation by Congress is clear from the opinion of Jefferson above referred to, and from numerous decisions of the courts. There is, however, a clear distinction between manufacture and commerce, as was pointed out in the decision of the Supreme Court in the case of the *United States v. E. C. Knight Co.* (156 U. S., 1.) The holding in this case is thus stated in the decision of the Supreme Court in the case of *Addyston Pipe & Steel Co. v. U. S.*, before referred to:<sup>2</sup>

\* \* \* The case was decided upon the principle that a combination simply to control manufacture was not a violation of the act of Congress, because such a contract or combination did not directly control or affect interstate commerce, but that contracts for the sale and transportation to other States of specific articles were proper subjects for regulation, because they did form part of such commerce.

the court thus clearly indicating that Congress has the power under the Constitution to regulate contracts for the sale and transportation to other States of specific articles.

In the decision in *Addyston Pipe & Steel Co. v. U. S.* the court further holds:

Where the contract is for the sale of the article and for its delivery in another State, the transaction is one of interstate commerce, although the vendor may have also agreed to manufacture it in order to fulfill his contract of sale. In such a case a combination would be properly called a combination in restraint of interstate commerce, and not one relating only to manufacture.

If trademarks related solely to manufactures, under these decisions they would not be subject to regulations by Congress. But, as has been above pointed out, while trademarks may be the property of manufacturers, the right to their exclusive use can be acquired only through the sale of the manufactured articles, either directly to consumers or to others through whom they are sold to the consumers. Trademarks pertain distinctively to the sale of articles, their sole purpose and function being to enable the buyer to distinguish the goods of one manufacturer from goods of the same kind made by another.

## REGULATION OF INTERSTATE TRADEMARKS WITHIN CONGRESSIONAL CONTROL.

If, as held by the Supreme Court in the above case, contracts for the sale of an article and for its delivery in another State are so far within the constitutional power of Congress to regulate that it may enact legislation to prohibit and punish combinations affecting them as

<sup>1</sup>Page 103.<sup>2</sup>Page 118.



being in restraint of interstate commerce, it seems clear that contracts "for the sale of an article and its delivery in another State, although the vendor may have also agreed to manufacture it in order to fulfill his contract of sale," are within the power of Congress to regulate in so far as may be necessary to prevent the carrying out of any such contracts which involve unfair competition with others engaged in interstate commerce. In other words, if Congress has power to prevent combinations in restraint of competition in the sale and exchange of commodities among the several States, it seems clear that it has also the power to prevent unfairness in competition in such sale and exchange by providing for the protection of trademarks used in commerce among the several States. The direct tendency of the protection of trademarks is, as stated by Judge Duer in the well-known case of *Amoskeag Mfg. Co. v. Spear*, before referred to:<sup>1</sup>

\* \* \* To produce and encourage a competition by which the interests of the public are sure to be promoted; a competition that stimulates effort and leads to excellence, from the certainty of an adequate reward.

In the same decision it is clearly pointed out that the imitator of a trademark by which the goods of another are distinguished and known—

\* \* \* Commits a fraud upon the public, and upon the true owner of the trademarks. The purchaser has imposed upon him an article he never meant to buy, and the owner is robbed of the fruits of the reputation that he has successfully labored to earn.

That the use of a trademark by others than its rightful owner may injuriously affect the commerce in which it is used, even to the extent of practically destroying the trade in the article on which it is used by destroying the confidence of the public in the article bearing the trademark, is obvious and has, without doubt, repeatedly happened. It thus directly obstructs and thus regulates the commerce in which it is used, whether this be commerce within a State or commerce with foreign nations or Indian tribes or commerce among the several States. Looked at from this standpoint, the use of a trademark in interstate commerce by others than its rightful owner is within the power of Congress to regulate under the decision of the Supreme Court in *Addyson Pipe & Steel Co. v. U. S.*, above referred to,<sup>2</sup> in which it is held that—

Anything which directly obstructs, and thus regulates, that commerce which is carried on among the States, whether it is State legislation or private contracts between individuals or corporations, should be subject to the power of Congress in the regulation of that commerce.

The regulation of trademarks used in interstate commerce, as well as foreign commerce, being, as has been pointed out, within the constitutional authority of Congress, it is important to the commercial interests that this authority be exercised to the extent of providing in the interest of the public that all persons engaged in interstate or foreign commerce shall be permitted to give notice, by registration, of their claim of right to the marks used by them in such commerce and by affording to registrants a measure of protection greater than that afforded by the common law without the necessity for registration, in order to induce general registration of marks used in commerce within Congressional control. As to the extent of the additional protection which should be afforded by statute there is serious question. There is no doubt that to provide a criminal remedy against deliberate and willful infringement is logical and in many respects desirable, yet the

<sup>1</sup> Page 113.

<sup>2</sup> Page 118.

expediency of such a provision is open to serious doubt. In view of this doubt, and in view of the further fact that the question of such a remedy is a question of criminal law rather than trademark law, I am of opinion that it should be left to the consideration of the commission intrusted with the revision of the criminal laws of the United States.

The proposed bill which follows gives to registrants advantages over those given by the common law in respect to the extent of damages (secs. 19 and 21); in respect to the delivery up for destruction of copies of infringing marks, etc. (sec. 22); in respect to the enforcement of an injunction granted in one of the circuit courts (sec. 22); in respect to the jurisdiction of the United States courts in controversies arising between citizens of the same State (sec. 20), and in respect to the exclusion from entry at custom-houses of merchandise falsely bearing a registered trademark (sec. 26).

The proposed bill in its general plan conforms in many respects to the trademark law of France,<sup>1</sup> in that it provides for registration of practically all marks, whatever their character, in use in commerce within Congressional control, provided they have not been already appropriated by another, and provides for giving to registrants advantages as regards remedies against infringers not enjoyed by nonregistrants, without at the same time making registration the basis of ownership in the mark. The common-law rights of owners of marks are by the express terms of the bill in no respect abrogated or lessened. (Sec. 24.)

The proposed bill is intended rather to remedy existing defects in the present trademark law than to introduce into the law the principle of attributive trademark laws, such as the trademark laws of Germany,<sup>2</sup> under which ownership is determined by priority in applying for registration, instead of by priority of use.

In respect to the provisions for carrying into effect treaty obligations, the bill which I propose is substantially the same as the bill proposed by the majority of this commission, as will appear from a comparison of sections 1, 6, and 26 of the bill proposed by me with sections 5, 8, and 33 of the majority bill. So, too, as regards the question of what marks should be registered, the term of registration, fees, appointment of representatives by nonresident registrants, appeals, and transfer of registered marks, the two proposed bills are in substantial agreement. (Compare sections 5, 15, 16, 4, 11, 12, and 24 of the bill proposed by me with sections 6, 9, 34, 7, 14, 15, and 25 of the majority bill.)

The bill proposed by me follows.

Respectfully submitted.

ARTHUR P. GREELEY.

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A BILL to revise the laws of the United States relating to trade-marks

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That any person claiming to be the owner of a trademark used in commerce among the several States, or in commerce with foreign nations or with the Indian tribes,

<sup>1</sup>Appendix, Chap. XXIII, p. 363.

<sup>2</sup>Appendix, Chap. XXII, p. 352.



provided such person is domiciled within the territory of the United States, and any person claiming to be the owner of a trademark, who is located in any foreign country, which by treaty, convention, or law, affords similar privileges to citizens of the United States, may, upon payment of the prescribed fees and otherwise complying with the requirements of this act, obtain registration therefor.

The first paragraph of section 1 of the present trademark law (act of March 3, 1881) is as follows:

*Be it enacted by the Senate and House of Representatives of the United States in Congress assembled,* That the owners of trademarks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribes, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trademark by complying with the following requirements:

The proposed section provides for the registration of trademarks used in interstate commerce, as well as those used in foreign commerce, and commerce with the Indian tribes. It was the opinion of Thomas Jefferson, expressed in a report made by him to the Second Congress, that the regulation of trademarks used in commerce "among the several States" was within the power of Congress. The latest decision of the Supreme Court bearing upon the subject of what constitutes interstate commerce, and the constitutional power of Congress in respect to the regulation of such commerce, seems to warrant the belief that there can be no serious question of the power of Congress to provide for the registration of trademarks used in the interstate commerce.

The desirability of securing the registration of all marks which are claimed as exclusive property, so that the public generally and particularly other manufacturers and dealers may be enabled to secure such information as will enable them to avoid the adoption of trade-marks already in use, is recognized by students of the trademark question in this country and abroad. And while, by reason of constitutional limitations, it is impossible for Congress to provide for the registration of trademarks used wholly within a State, no reason appears why the full power of Congress in this matter should not be exerted.

By the provision that "any person claiming to be the owner of a trademark" may register, instead of the provision of the present law that "owners of trademarks" may register, it is intended to relieve the Commissioner of Patents of the necessity of considering in *ex parte* cases the question of ownership.

The proposed section follows the present law in limiting the right of registration by foreign owners of trademarks to those located in countries with which reciprocal arrangements in this regard have been established. It is desirable and important in the interests of foreign trade that such arrangements be entered into with any and every foreign country in which American manufacturers may seek a market for their goods, but such arrangements can be secured only on the basis of reciprocity. To give to foreigners generally the same rights as are given to American owners of trademarks would make it possible for foreign countries to exclude our manufacturers from the advantages of their trademark laws without detriment to the interests of their own manufacturers.

SEC. 2. That before any owner of a trademark shall be entitled to registration thereof he shall make application therefor in writing to the Commissioner of Patents, and shall file in the Patent Office a statement signed by him specifying his name, domicile, and citizenship, and the location of his industrial or commercial establishment, the class of merchandise and the particular description of goods comprised in such class to which the particular trademark has been appropriated, a description of the trademark itself, if considered necessary by the applicant or required by the Commissioner in the particular case, a statement of the mode in which the trademark is applied to goods, and a statement of the length of time during which it has been used. With this statement shall be filed a facsimile drawing of the trademark, signed by the applicant or his attorney in fact, and such number of specimens of the trademark as actually used as may be required by the Commissioner of Patents.



This is in substance paragraph 2 of section 1 of the trademark law of 1881. It is, however, redrawn on the lines of sections 4888 and 4889 of the Revised Statutes relating to applications for patents. The requirement as to description is so modified as to permit description to be omitted where it is obviously not necessary, as in case of a trademark which is so simple that it shows itself precisely what it is. The requirement as to drawing is in accordance with the present practice of the Patent Office under the Rules of Practice. Specimens of the mark as actually used are now required when deemed necessary by the Commissioner of Patents.

The second paragraph of section 1 of the act of March, 1881, is as follows:

"First. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with facsimiles thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used."

Sections 4888 and 4889 of the Revised Statutes are as follows:

"SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

"SEC. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing to be furnished by the Patent Office, shall be attached to the patent as a part of the specification."

The Rules of Practice relating to drawings and specimens in trademark applications are as follows:

"27. If for any reason a drawing does not constitute a satisfactory facsimile of the trade-mark, two copies of the trade-mark as actually used must be deposited in accordance with the required drawing, to be preserved in the office for reference.

"28. (1) The drawing must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

"(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches."

SEC. 3. That the application required by section 2 of this act, if made by an owner of a trademark domiciled within the territory of the United States, shall be accompanied by a written declaration verified by the applicant that he believes himself to be the owner of the trademark sought to be registered and that no other person, firm, corporation, or association has a right to use such trademark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trademark is used in commerce among the several States, or in commerce with foreign nations or with the Indian tribes, and that the facsimile drawing and specimens, if any, truly represent the trademark sought to be registered. The application if made by an owner of a trademark located in a foreign country shall be accompanied by a written declaration verified by the applicant that he believes himself to be the owner of the trademark sought to be registered; that he has registered the same or has regularly filed an application for registration thereof in the foreign country in which he is located, of which registration or application, as the case may be, he

shall state the date; that no other person, firm, corporation, or association has the right to use such trademark either in the identical form or in any such near resemblance thereto as might be calculated to deceive, and that the facsimile drawing and specimens, if any, truly represent the trademark sought to be registered.

In case the owner of the trademark is a firm, corporation, association, State, or municipality the declaration may be made by a member of the firm or an officer of the corporation, association, State, or municipality.

The declaration required by this section may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal of the foreign country in which the applicant may be.

The first paragraph of this section is substantially the present law as found in section 2 of the act of March 3, 1881, which is as follows:

"SEC. 2. That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated; and that the description and facsimiles presented for registry truly represent the trade-mark sought to be registered."

The second paragraph prescribes the declaration to be made by a foreign owner of a trademark. As the right of a foreign citizen or subject to the protection for his trademark is secured to him by treaty, while the right of the applicant who is domiciled in the United States to protection necessarily depends upon his use of the mark in such commerce as is within Congressional control, it is evident that the facts necessary to be shown in the one case are not the same as in the other. The requirement that the foreign applicant show affirmatively that he has regularly filed an application for registration of his trademark in the country in which he is located is necessary as a *prima facie* showing that he is in fact the owner of the mark. Such a requirement is found in the laws of nearly all foreign countries, as is recognized in section 13 of the act of March 3, 1881.

While it is believed that it would be desirable to dispense with the requirement that an applicant for registration make oath as to the facts which entitle him to be considered the owner of the trademark for which he seeks registration, it does not appear that this can be done in view of the fact that only those trade-marks which are used in interstate or foreign commerce or commerce with the Indian tribes are within the regulating power of Congress. It therefore appears that in order to be entitled to registration the applicant must make a *prima facie* showing that he has satisfied the conditions necessary to bring his trademark within the class of trademarks which may be registered.

The section as drawn recognizes as entitled to registration trademarks used by associations, States, and municipalities, following in this respect the laws of many of the foreign countries as well as the laws of many of the States of the United States.

The final paragraph of the section specifies before whom the declaration may be made, following in its language section 4892 of the Revised Statutes, which specifies before whom the oath to an application for patent may be taken, amended to provide that in foreign countries the declaration may be made before officers other than notaries or United States officers.

SEC. 4. That every applicant for the registration of a trademark not domiciled in the United States shall, before the issuance of the certificate of registration, designate by a notice in writing filed in the Patent Office some person residing within the United States on whom process or notice of proceedings affecting the right of ownership in the trademark of which he may claim to be the owner, brought under



the provisions of this act or under other laws of the United States, may be served with the same force and effect as if served upon the applicant or registrant in person.

The purpose of this section is to require applicants for registration of trademarks who reside out of the jurisdiction of the United States courts to place themselves constructively within such jurisdiction. Being given the advantages of the laws of the United States so far as bringing suits against others for the protection of their rights to their trademarks, they should submit to the jurisdiction of the courts of the United States in case suits affecting their rights to their trademarks are brought against them.

Such a provision is contained in the trademark laws of many, in fact nearly all, of the countries of commercial importance.

SEC. 5. That no mark by which the goods of the person claiming to be the owner of the mark may be distinguished from other goods of the same class, shall be refused registration as a trademark on account of the nature of such mark, unless such mark—

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation.

*Provided*, That marks which are identical with a registered or known trademark owned and in use by another, and appropriate to the same class of merchandise, or which so nearly resemble a registered or known trademark owned and in use by another, and appropriate to the same class of merchandise, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered. And

*Provided*, That marks which consist merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner, or which consist merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or which consist of the name of a locality, shall not be registered, unless the applicant for registration states in his application that he makes no claim to the exclusive use of such mark as against others who may use the same without fraudulent or deceptive intent.

It is the purpose of this section, as drawn, to provide for the registration of all marks which would or could, under the law, as construed by the Supreme Court, be held to be capable of being appropriated as the exclusive property of the person using them as trademarks.

The first proviso recognizes the statutory bar stated in section 3 of the present trade-mark law in the following words:

“But no alleged trade-mark shall be registered \* \* \* which is identical with a registered trade-mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some other person's trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers,”

and is intended to prevent duplication of registration.

The second proviso is in recognition of the statement made by the Supreme Court in *Canal Co. v. Clark* (13 Wall. 311), quoting from the opinion of Judge Duer, in the case of *Amoskeag Mfg. Co. v. Spear*, that—“(one) has no right to appropriate, a sign, or symbol, which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose” and at the same time recognizing the right of the users of such marks to protection against others who make use of them without right and for the purpose of unfair competition. (See *Pillsbury Washburn Mills Co. v. Eagle*, 85 O. G., 1397; *Fuller v. Huff*, 104 Fed. Rep., 141.)

SEC. 6. That any application for registration of a trademark filed in this country by any person who has previously regularly filed in any foreign country which by treaty, convention, or law affords similar privi-



leges to citizens of the United States, an application for registration of the same trademark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trademark was first filed in such foreign country, provided such application is filed in this country within four months from the date on which the application was first filed in such foreign country.

This is intended to provide for giving full force and effect to article 4 of the International Convention, which, so far as it relates to trademarks, is as follows:

"ART. 4. Anyone who shall have regularly deposited an application for a \* \* \* trade or commercial mark in one of the contracting States shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

"In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods can not be invalidated by acts performed in the interval, especially by another deposit, \* \* \* by the employment of the mark.

"The periods of priority above mentioned shall be \* \* \* three months for trade or commercial marks. They shall be augmented by one month for countries beyond the seas."

SEC. 7. That on the filing of any application for registration of a trademark which complies with the requirements of sections 2 and 3 of this act, and the payment of the fees required by this act, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to registration under the provisions of this act, the Commissioner shall issue a certificate of registration therefor.

This is drawn to correspond in terms with section 4893 of the Revised Statutes relating to the examination of applications for patent, which is as follows:

"SEC. 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

The only provision in the present law respecting the examination of applications for registration of trademarks is contained in section 3 of the act of March 3, 1881, and is as follows:

"In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark."

As above drawn this section corresponds with the present practice in regard to examination of trademark applications. Rule 30 of the Rules Governing the Registration of Trade-marks prescribes this practice as follows:

"30. All applications for registration are considered in the first instance by the trade-mark examiner. Whenever on examination of an application registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application."

SEC. 8. That whenever, on examination, an application for registration of a trademark is refused, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such refusal, together with such information and references as may be useful in judging of the propriety of persisting in, modifying, or abandoning his application; and if, after receiving such notice, the applicant persists in his claim of right to registration, either with or without modifying his application, his application shall be reexamined.

This is drawn to correspond in terms with section 4903 of the Revised Statutes relating to the examination of applications for patent, which is as follows:

"SEC. 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for

such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a reexamination of the case."

There is nothing in the present trademark law corresponding with this section. It defines the present practice of the Patent Office. See Rule 30 of the Rules Governing the Registration of Trade-marks, which is as follows:

"30. All applications for registration are considered in the first instance by the trade-mark examiner. Whenever on examination of an application registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application."

SEC. 9. That upon failure of the applicant to complete his application for registration within one year after the filing of any part thereof, or upon his failure to prosecute his application within one year after any action therein, of which notice shall have been given to the applicant, such application shall be regarded as abandoned, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable; but the abandonment of such application shall not be construed to be an abandonment of any right to the trademark for the registration of which such application was made.

The purpose of this section is to provide for clearing the files of the Patent Office of applications for registration which have been refused and in which no appeal has been taken within a reasonable time or in which the requirements of the law have not been complied with within a reasonable time after they have been pointed out by the Patent Office.

Without such provision the files of the Patent Office will become, and in fact are already, choked with an accumulation of applications which, though practically abandoned, must, under the law, be considered as pending.

This section corresponds in terms with section 4894 of the Revised Statutes relating to applications for patent, which is as follows:

"4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

By the last part of this section the distinction is recognized between the right to register, which, with the benefits arising from registration, is created by statute, and the right of ownership in a trademark, which accrues under the common law and exists independent of registration.

SEC. 10. That whenever application is made for the registration of a trademark which is substantially identical with a trademark appropriated to the same class of goods for which a certificate of registration has been previously issued to another, and is still in force, or for registration of which another has previously made application, or which so nearly resembles such trademark as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, and the applicant shall show to the satisfaction of the Commissioner that he used the trademark of his application prior to the date of filing of the application on which such previous registration was granted, or the date of filing of such prior application, as the case may be, or shall show to the satisfaction of the Commissioner that the registrant or prior applicant has abandoned the use of such trademark, the Commissioner shall suspend such later application and give notice thereof to the registrant or prior applicant, as the case may be. If within such time, not less than thirty days from such notice as the Commissioner shall prescribe, the registrant or prior applicant files in



the Patent Office notice of opposition to the grant of such application, stating the reasons therefor, the Commissioner shall declare that an interference exists as to such trademark and shall direct examiner in charge of interferences to determine the question of ownership of such trademark. And the Commissioner may issue a certificate of registration to the party who is adjudged to be the owner of the trademark, unless the adverse party appeals from the decision of the examiner in charge of interferences within such time, not less than twenty days, as the Commissioner shall prescribe. If the registrant or prior applicant, after due notice, shall fail to file notice of opposition within thirty days, the Commissioner may issue a certificate of registration to the later applicant.

In so far as the practice prescribed by this section differs from the present practice of the Patent Office, it is intended to facilitate the registration by the later applicant, in cases in which a registrant or prior applicant has ceased to claim an exclusive right in the mark.

The only provision in the present law with reference to interferences in respect to trade-marks is found in section 3 of the act of March 3, 1881, and is as follows:

"In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases."

So far as declaration and determination of interferences is concerned, this section is merely declaratory of the present practice in the Patent Office as defined in rule 37 of the Rules Governing the Registration of Trade-marks, which is as follows:

"37. In case of conflicting applications for registration, or in any dispute as to the right to use which may arise between an applicant and a prior registrant, the office will declare an interference, in order that the parties may have an opportunity to prove priority of use and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents."

SEC. 11. That every applicant for the registration of a trademark or for the renewal of the registration of a trademark whose application has been twice refused, and every party to an interference as to a trademark, may appeal from the decision of the examiner in charge of trademarks, or of the examiner in charge of interferences, as the case may be, to the Commissioner in person, having once paid the fee for such appeal.

This corresponds in terms with sections 4909 and 4910 of the Revised Statutes relating to appeals in applications for patent, which are as follows:

"SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief; having once paid the fee for such appeal.

"SEC. 4910. If such party is dissatisfied with the decision of the examiners in chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

This section provides for an appeal direct to the Commissioner instead of to the examiners in chief and from them to the Commissioner, as provided in the law relating to appeals in applications for patent. Except that it requires a fee for appeals, it is merely declaratory of the present practice as defined in rule 38 of the Rules Governing the Registration of Trade-marks, which is as follows:

"38. From an adverse decision of the examiner of trade-marks upon an applicant's right to register a trade-mark, or upon any interlocutory matter, or from a decision of the examiner of interferences, the case will be reviewed by the Commissioner, on petition or appeal, without fee."

SEC. 12. That if an applicant for registration of a trademark, or such party to an interference as to a trademark, is dissatisfied with the decision of the Commissioner of Patents he may appeal to the court of appeals of the District of Columbia on complying with the



conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent or a party to an interference as to an invention.

This section corresponds in terms with section 4911 of the Revised Statutes relating to appeals from the decision of the Commissioner of Patents in applications for patent as modified by the act of February 9, 1893, creating the court of appeals of the District of Columbia:

"Sec. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc."

"R. S. U. S., Sup., vol. 2, c. 74, Feb. 9, 1893. *Be it enacted, etc.*, That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the court of appeals of the District of Columbia. \* \* \*

"Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the supreme court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia shall hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals."

The present law does not provide for an appeal from the decision of the Commissioner of Patents in trademark cases. As such cases often involve interests quite as valuable as are involved in applications for patent, it would seem that appeals if provided for in the one class of cases should be provided for in the other class.

SEC. 13. That the Commissioner of Patents is authorized to record in the Patent Office the transfer of the property right in any registered trademark, or in any trademark for which application for registration has been made. But no such transfer of a trademark shall be recorded unless it shall appear that such transfer was made with, or as a part of, a transfer of the good will of the business in which such trademark was used. Any transfer of the good will of the business in which a particular trademark is used shall be deemed a transfer of such trademark, and shall be so recorded unless the parties thereto expressly stipulate to the contrary.

Section 12 of the present law authorizes the Commissioner to record transfers of the right to use trademarks. This is as follows:

"Sec. 12. That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office."

This recording is provided for in rule 43 of the Rules Governing the Registration of Trade-marks, which is as follows:

"Sec. 43. The right to the use of any trade-mark is assignable by an instrument in writing, and provision is made for recording such instrument in the Patent Office. But no such instrument or conveyance will be recorded unless it is in the English language, and unless an application for the registration of a trade-mark shall have first been filed in the Patent Office, and such instrument must identify the application by serial number and date of filing, or, where the mark has been registered, by its certificate number and the date thereof. No particular form of instrument is prescribed."

There is no restriction upon such transfers in the present law. But it is well settled that the property right to a trademark is not transferable except with the transfer of the right to manufacture or sell the particular merchandise to which the trademark has been attached. (See *Filkins v. Blackman*, 13 Blatchford, 440, quoting *Dixon Crucible Company v. Guggenheim*, Am. Trademark Cases, 559.)

That the transfer of the good will of the business carries with it the transfer of the trademark used in connection with it, unless expressly stipulated to the contrary, is also well established. (See *Pepper v. Labrot*, 8 Fed. Rep., 29.)

This section as drawn is merely declaratory of the present law as determined by the courts.

The law of Great Britain provides (sec. 70, Patents, etc., acts 1883-1888) that—

"A trade-mark, when registered, shall be assigned and transmitted only in connection with the good will of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that good will."

SEC. 14. That certificates of registration of trademarks shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the drawing, statement of the applicant, and description, if any, shall be kept in books for that purpose. The certificate shall state the date on which the application for registration was deposited in the Patent Office. Certificates of registration of trademarks may be issued to the assignee of the applicant; but the assignment must first be entered of record in the Patent Office. Written or printed copies of any records, books, papers, or drawings, relating to trademarks, belonging to the Patent Office, and of certificates of registration, authenticated by the seal of the Patent Office and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor and paying the fee required by law shall have certified copies thereof.

Section 4 of the present trademark law is as follows:

"SEC. 4. That certificates of registry of trade-marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith, and certificates of registry so signed and sealed shall be evidence in any suit in which such trade-marks shall be brought into controversy."

The words "seal of the Department of the Interior" have been changed to "seal of the Patent Office." Patents are issued under the seal of the Patent Office and signed by the Secretary of the Interior and by the Commissioner of Patents (Rev. Stat., sec. 4883), while under the present law certificates of registry of trademarks are signed by the Commissioner only and bear the seal, not of the Patent Office, which is under his control, but the seal of the Department of the Interior. Evidently this should be corrected.

The provision that certificates shall state the date of application is merely declaratory of the present practice. The provision with respect to issuance of the certificate to the assignee of record, is in accord with the following provisions of the law relating to patents.

"SEC. 4895. Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office."

The last sentence of this section is drawn to correspond in terms with the provision of section 892 of the Revised Statutes, in reference to certified copies of the records of the Patent Office. This is as follows:

"SEC. 892. Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor and paying the fee required by law shall have certified copies thereof."

SEC. 15. That a certificate of registration shall remain in force for ten years, except that in case of trademarks previously registered in a foreign country, such certificate shall cease to be in force on the date on which the trademark ceases to be protected in such foreign country and shall in no case remain in force more than ten years, unless renewed. Certificates of registration may be, from time to time, renewed for like periods on payment of the renewal fees required by this act, upon request by the registrant, his legal representatives or transferees of record in the Patent Office, provided such request is made prior to the expiration of the term for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this act takes effect shall remain in force for the term for which they were issued, but shall be renewable on the



same conditions and for the same periods as certificates issued under the provisions of this act, and when so renewed shall have the same force and effect as certificates issued under this act.

Section 5 of the present trademark law is as follows:

"SEC. 5. That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years, such registration may be renewed on the same terms and for a like period."

The change in the term is coupled with a reduction of the fee for registration, from \$25 to \$10, with a fee of \$5 for renewal. (See sec. 16.) The term of years is the term for which registration is granted in most countries, with, of course, the right to renewal from time to time, as long as the registrant continues to claim an exclusive right in the mark. Failure to renew registration is, in foreign countries, taken to mean abandonment of the claim of right to the mark. While failure to renew need not be taken as abandonment of whatever rights the registrant may have under the common law, it should be taken as an abandonment of whatever rights may accrue from registration. Many trademarks are, as a matter of fact, abandoned within a few years after their first adoption, and it is believed to be in the interest of the public that marks which have thus ceased to be the subject of a claim of exclusive right should be dropped from the register within a much shorter period than the thirty years for which certificates of registration are granted under the present law.

The provision with respect to trademarks previously registered in a foreign country, is substantially the same in effect as the provision contained in the section of the present law above quoted. The right of foreign trademark owners to the benefits of the laws of the United States rests on treaty agreements, and it is expressly stipulated in many of these treaties that trademarks shall cease to be protected here when they cease to be exclusive property in the country in which they originate. Substantially the same provision is contained in the trademark laws of most foreign countries.

The final sentence of this section preserves whatever rights are secured by certificates of registration now in force, but there is nothing in this or any section of this proposed act to prevent the owner of a trademark registered under the present law from registering under this act, and thereby securing the advantages provided for therein.

SEC. 16. That the following shall be the rates for trademark fees:

On filing each original application for registration of a trademark, ten dollars.

On filing each application for renewal of registration of a trademark, five dollars.

On an appeal for the first time from the examiner in charge of trademarks to the Commissioner of Patents, ten dollars.

On an appeal for the first time from the decision of the examiner in charge of interferences, awarding ownership of a trademark, to the Commissioner of Patents, fifteen dollars.

For certified and uncertified copies of certificates of registration and other papers, and for recording transfers and other papers, the same fees as required by law for such copies of patents and for recording assignments and other papers relating to patents.

This is drawn to correspond in terms with section 4934 of the Revised Statutes prescribing patent fees, which is as follows:

"SEC. 4934. The following shall be the rates for patent fees:

"On filing each original application for a patent, except in design cases, fifteen dollars.

"On issuing each original patent, except in design cases, twenty dollars.

"In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

"On filing each caveat, ten dollars.



"On every application for the reissue of a patent, thirty dollars.

"On filing each disclaimer, ten dollars.

\* \* \* \* \*

"On an appeal for the first time from the primary examiners to the examiners-in-chief, ten dollars.

"On every appeal from the examiners-in-chief to the Commissioner, twenty dollars.

"For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

"For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

"For copies of drawings, the reasonable cost of making them."

The fee required for registration under the present law is \$25, as stated in the third paragraph of section 1 of the act of March 3, 1881, which states as a requirement for registration as follows:

"Second. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents."

A fee of \$25 is excessive, and is virtually a tax upon registrants. The fee of \$10 is ample to cover the expenses of examination of the application and issuance of the certificate of registration in all cases in which no appeal is taken. With the fee placed at \$10, registration would be more generally sought, and a much more nearly complete registration of all trademarks in use would be secured. As this is one of the principal purposes of a registration law, the reduction of the fee seems to be clearly necessary.

The present law does not require a fee for appeal to the Commissioner. In fact it does not provide for an appeal. The rules governing the registration of trademarks, however, provide for such appeal. Rule 38 is as follows:

"38. From an adverse decision of the examiner of trade-marks upon an applicant's right to register a trade-mark, or upon any interlocutory matter, or from a decision of the examiner of interferences, the case will be reviewed by the Commissioner, on petition or appeal, without fee."

The wisdom of requiring a reasonable fee for appeal, in view of the work involved, particularly in view of the reduction of the registration fee, hardly needs demonstration. Nor does it seem open to question that the fee in interference cases should be somewhat larger than in *ex parte* appeals from the decision of the examiner in charge of trademarks.

So far as the fees for copies and recording are concerned, this section is merely declaratory of the present practice. See rule 47 of the rules governing the registration of trademarks, which is as follows:

"47. On filing an application for registration of a trade-mark .....	\$25. 00
For abstract of title:	
For the certificate of search.....	1. 00
For each brief from the digests of assignments.....	.20
For copies of matter in any foreign language, for every 100 words or fraction thereof .....	.10
For translation, for every 100 words or fraction thereof .....	.50
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less .....	1. 00
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words and less than 1,000 words .....	2. 00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words .....	3. 00
For assistance to attorneys and others in the examination of records, one hour or less .....	.50
Each additional hour or fraction thereof .....	.50
For single printed copy of statement, declaration, and facsimile.....	.05
If certified, for the certificate, additional .....	.25

SEC. 17. Sections forty-nine hundred and thirty-five and forty-nine hundred and thirty-six, relating to the payment of patent fees and to the repayment of fees paid by mistake, are hereby made applicable to trademark fees.

The sections referred to are as follows:

"SEC. 4935. Patent fees may be paid to the Commissioner of Patents, or to the Treasurer, or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by

the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever.

"SEC. 4936. The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents."

This section is merely declaratory of what is understood to be the present law. See rules 49 and 51 of the Rules Governing the Registration of Trade-marks, which are as follows:

"49. Money required for office fees may be paid to the Commissioner or to the Treasurer, or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this can not be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders should be made payable to the 'Commissioner of Patents.'

"51. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trade-mark, will not entitle a party to demand such a return."

SEC. 18. That the Commissioner of Patents may from time to time establish regulations not inconsistent with law for the conduct of proceedings in reference to the registration of trademarks provided for by this act.

Authority for the rules governing the registration of trademarks which are issued by the Commissioner of Patents is contained in the third paragraph of section 1 of the act of March 3, 1881, which states as a requirement for registration the following:

"Second. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents."

The above section is drawn to correspond in terms with section 483 of the Revised Statutes giving the Commissioner authority to prescribe regulations for proceedings in the Patent Office. This is as follows:

"SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

SEC. 19. That registration of a trademark shall be legal notice of claim of ownership therein by the registrant. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trademark registered under this act, and affix the same to merchandise of substantially the same descriptive properties as those described in the registration, or shall sell or expose for sale or have in possession for purposes of sale merchandise of substantially the same descriptive properties as those described in the registration bearing, without authority from the owner thereof, a reproduction, counterfeit, copy, or colorable imitation of any such trademark, shall be liable to an action on the case for damages for the wrongful use of said trademark at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

Section 7 of the present trademark law is as follows:

"SEC. 7. That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any



trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor, in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy."

The section is modified to make registration legal notice of the claim of ownership therein instead of *prima facie* evidence of ownership as provided by the present law. As it is believed that the law should be declaratory of rights acquired under the common law and should not make registration the basis of the right of ownership in the mark, it seems clear that registration granted on a merely *ex parte* showing can not properly be even *prima facie* evidence of the fact of ownership. The owner of a trademark who gives legal notice to all the world that he claims such trademark as his own may properly be entitled to advantages by reason of such notice which the trademark owner who does not register his mark should not have.

The section is modified to prove specifically that the owner of a registered trademark may enforce his right to its exclusive use against any person who without right makes use of that mark, whether such person be the manufacturer who affixes the mark to the goods or the trader who subsequently distributes the goods bearing the false mark to the consumers. The one is as much an infringer as the other and there should be no doubt as to the right of the owner of the mark to proceed against either the infringing manufacturer or the infringing trader or both, as he may choose.

The provisions respecting the power of the court to increase damages is drawn in accordance with section 4919 of the Revised Statutes, relating to patents, which is as follows:

"SEC. 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs."

These provisions are made applicable only to *registered* trademarks for the purpose and with the intent of inducing the general registration of trademarks now in use or which may hereafter be used by affording to owners of trademarks, who by complying with the conditions of this act give notice to others of their claim of right in their trademarks, a protection not given to unregistered marks. Compare the copyright law under which an author is so far required to give notice of his claim of right that without such notice in strict conformity with the law he is without the right to bring suit in the courts. Compare also the patent law under which the right of an inventor to make, use, and vend his invention can not be enforced in the courts unless he has, by the filing of an application on which a patent has been granted, given notice to others of his claim of right in his invention.

The clause of section 7 of the present trademark law by which the party aggrieved is given his remedy in equity is embodied in section 21 of this act and the clause by which jurisdiction is conferred on the United States courts is embodied in section 20 of this act.

The other changes in the section are made in the interest of clearness.

SEC. 20. That the circuit courts of the United States shall have original jurisdiction, and the circuit courts of appeal of the United States, the court of appeals of the District of Columbia, and the Supreme Court shall have appellate jurisdiction of all suits at law or in equity respecting trademarks registered in accordance with the provisions of this act, arising under the present act or under any laws of the United States in reference to trademarks, without regard to the amount in controversy, except that such courts shall not have jurisdiction of such suits between citizens of the same State, unless it appears that the defendant uses the registered trademark involved in the suit on merchandise intended to be transported to another State or beyond the boundaries of the State of which the parties are citizens.

Section 7 of the trademark law of March 3, 1881, provides that "courts of the United States shall have original and appellate jurisdiction without regard to the



amount in controversy," in cases in which trademarks registered under the act of March 3, 1881, are involved.

The proposed section is intended to more clearly define the jurisdiction conferred upon the United States courts by the present law, and particularly to avoid any question of constitutionality. It will be understood that so far as concerns controversies arising between citizens of different States, or between aliens and citizens, the section confers no jurisdiction that is not conferred in express terms by the Constitution (Art. III, sec. 2), but provides that the amount in controversy shall not affect jurisdiction. With respect to controversies arising between citizens of the same State, jurisdiction is conferred by this section upon the United States only in cases in which the right to a registered trademark is involved between parties who are engaged in interstate or foreign commerce in the goods to which the trademark in controversy is applied. As to what constitutes interstate or foreign commerce, see the decision of the Supreme Court in *Addyston Pipe & Steel Co. v. U. S.* (175 U. S., 211).

SEC. 21. That the several courts vested with jurisdiction of cases arising under the present act or under any laws of the United States in reference to trademarks shall have power to grant injunctions according to the course and principles of equity to prevent the violation of any right of the owner of a trademark registered under this act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a registered trademark, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

This action corresponds in terms with section 4921 of the Revised Statutes relating to patent cases, which is as follows:

"Sec. 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case."

SEC. 22. That in any case involving the right to a trademark registered in accordance with the provisions of this act, in which a verdict has been found for the plaintiff, or an injunction issued, the court may order that all labels, prints, packages, wrappers, or receptacles in the possession of the defendant bearing the trademark of the plaintiff or complainant, or any reproduction, counterfeit, or colorable imitation thereof, shall be delivered up and destroyed. Any injunction that may be granted, upon hearing after notice to the defendant, to prevent the violation of any right of the owner of a trademark registered in accordance with the provisions of this act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States, and shall be operative and may be enforced by proceedings to punish for contempt or otherwise by the circuit court by which such injunction was granted, or by any other circuit court or judge thereof in the United States. The circuit courts or judges thereof shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted in the circuit in which it is sought to be enforced.

The clerk of the court or judge granting the injunction shall, when required to so do by the court before which application to enforce said injunction is made, transmit without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

The provisions of this section under which an injunction granted in any circuit court may be enforced wherever the defendant may be found is taken from the present law relating to copyrights, which provides as follows in section 4966, as amended by the act approved January 6, 1897:

"Any injunction that may be granted upon hearing after notice to the defendant by any circuit court of the United States, or by a judge thereof, restraining and enjoining the performance or representation of any such dramatic or musical composition may be served on the parties against whom such injunction may be granted anywhere in the United States, and shall be operative and may be enforced by proceedings to punish for contempt or otherwise by any other circuit court or judge in the United States; but the defendants in said action, or any or either of them, may make a motion in any other circuit in which he or they may be engaged in performing or representing said dramatic or musical composition to dissolve or set aside the said injunction upon such reasonable notice to the plaintiff as the circuit court or the judge before whom said motion shall be made shall deem proper; service of said motion to be made on the plaintiff in person or on his attorneys in the action. The circuit courts or judges thereof shall have jurisdiction to enforce said injunction and to hear and determine a motion to dissolve the same, as herein provided, as fully as if the action were pending or brought in the circuit in which said motion is made.

"The clerk of the court, or judge granting the injunction, shall, when required to do by the court hearing the application to dissolve or enforce said injunction, transmit without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office."

SEC. 23. That no action or suit shall be maintained under the provision of this act in any case when the trademark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registration fraudulently obtained.

This is section 8 of the present trademark law without change:

"SEC. 8. That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained."

SEC. 24. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade or other mark, commercial name, or indication of locality of origin, might have had if the provisions of this act had not been passed.

Section 10 of the act of March 3, 1881, is as follows:

"SEC. 10. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed."

The purpose of this section, as above drawn, is to provide that the user of a designating mark, whether such mark is a trademark in the technical sense registrable under the provisions of this act or is a personal commercial name or a geographical name, may continue to have such remedy against those who make use of such mark with fraudulent intent as is given by the courts under the common law under the doctrine of unfair competition, whether such mark has been registered or not, and to provide that the courts of the United States shall continue to have such jurisdiction as they now have to afford under the so-called common law of trademarks such remedy at law or in equity for the wrongful use of any trademark irrespective of its registration as they now give.

SEC. 25. That nothing contained in this act shall prevent the registration as a trademark of any word or words, letter, figure, or com-



bination of letters or figures used as a trademark in commerce among the several States or in commerce with foreign nations, or with the Indian tribes before the third day of March, eighteen hundred and eighty-one, and which has distinguished the goods of the applicant or his predecessor in business.

The above section is intended to cover substantially the same ground that is covered by the act of August 5, 1882, which is as follows:

"That nothing contained in the law entitled 'An act to authorize the registration of trade-marks and protect the same,' approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act."

This act is similar to, and no doubt was suggested by, the provisions of the British trade-mark law in reference to what are known as "old marks;" that is, marks in use prior to the date of the passage of the first law which provided for registration of trade-marks and defined what should be registrable as trademarks. This provision is found in section 64 of the Patents, etc., Acts, 1883-1888, and is as follows:

"(3) *Provided as follows:*

\* \* \* \* \*

"(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures, used as a trade-mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this act."

This is in recognition of the fact that by long-continued use in public a mark which at the date of its adoption might be open to objection as being descriptive or geographical or otherwise not so far arbitrary or fanciful as to be capable at once of exclusive appropriation, may become known to the public as the distinctive mark of its user, and has therefore come to be of value to him, and of the necessity in the interests of fair competition in trade of giving to such "old marks" the protection given to marks which are technically trademarks. Without such a provision, such marks not being registrable in this country would not be registrable in the foreign countries which require registration here as a condition precedent to protection there, and such requirement is made by the laws of most foreign countries.

SEC. 26. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture or manufacturer or trader, or of any manufacturer or trader located in any foreign country, which by treaty, convention, or law, affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States. And in order to aid the officers of the customs in enforcing this prohibition any domestic manufacturer or trader, and any foreign manufacturer or trader who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country, to the advantages accorded by law to citizens of the United States, in respect to trade or commercial marks, and commercial names, may require his name and residence, and name or mark of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark issued in accordance with the provisions of this act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name or mark of the locality in which his goods are manufactured, or of his registered trademark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs.



Section 11 of the act of July 24, 1897, is as follows:

"SEC. 11. That no article of imported merchandise which shall copy or simulate the name or trade-mark of any domestic manufacture or manufacturer, or which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom-house of the United States. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trade-marks may require his name and residence and a description of his trade-marks to be recorded in books which shall be kept for that purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of such trade-marks; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs."

This is section 11 of the act of Congress approved July 24, 1897, entitled "An act to provide revenue for the Government and to encourage the industries of the United States;" so amended as to extend the advantages therein given to domestic manufacturers to manufacturers located in foreign countries who are by treaty stipulations entitled to these advantages.

SEC. 27. That for the purposes of this act the United States shall be held to include and embrace all territory which is under the jurisdiction and control of the United States; and the word "States," as used in this act, shall be held and construed to include and embrace the District of Columbia, the Territories of the United States, and such other territory as shall be under the jurisdiction and control of the United States.

The purpose of this section is to enable persons located in Cuba, Porto Rico, the Philippines, and any other territory which is, for the time being, under the jurisdiction and control of the United States, to secure the advantages of this act for the protection of their trade-marks; and to make it clear that "commerce among the several States" is not to be limited to commerce among the States in a technical sense, but is to be construed to include commerce between the District of Columbia and a State, between a State and a Territory, between a State and Cuba, Porto Rico, or the Philippines, between a Territory and another Territory, between a Territory and Cuba, Porto Rico, or the Philippines, and between Cuba and Porto Rico, Cuba and the Philippines, or Porto Rico and the Philippines; in other words, between any portion of the territory of the United States having its distinctive government, whether State, Territorial, or other form of government, and any other portion.

SEC. 28. This act shall take effect upon its passage. All acts and parts of acts inconsistent with this act are hereby repealed except so far as the same may apply to certificates of registration issued or applied for under the act of Congress approved March 3, 1881, entitled "An act to authorize the registration of trade-marks and protect the same," or under the act approved August 5, 1882, entitled "An act relating to the registration of trade-marks."

As this proposed act makes comparatively little change in the procedure with respect to registration of trade-marks, and does not deprive owners of trade-marks of any substantial right which is given them by the present law, but on the other hand adds materially to such rights, there seems to be no substantial reason why it should not take effect at the earliest possible moment after its passage.



## APPENDIX TO REPORT.

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### CHAPTER I.

#### ACT PROVIDING FOR THE APPOINTMENT AND DUTIES OF THE COMMISSIONERS.

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AN ACT Appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the President, with the advice and consent of the Senate, shall appoint three commissioners, to serve without compensation, whose duty it shall be to revise and amend the laws of the United States concerning patents, trade and other marks, and trade or commercial names, which shall be in force at the time such commission shall make its final report, so far as the same relates to matters contained in or affected by the Convention for the Protection of Industrial Property concluded at Paris March twentieth, eighteen hundred and eighty-three, the agreements under said Convention concluded at Madrid April fourteenth, eighteen hundred and ninety-one, and the protocols adopted by the conference held under such Convention at Brussels, eighteen hundred and ninety-seven, and the treaties of the United States, and the laws of other nations relating to patents, trade and other marks, and trade or commercial names.

That they shall report to Congress as soon as possible.

That the report shall be so made as to indicate any proposed change in the substance of existing law, and shall be accompanied by notes which shall briefly and clearly state the reasons for any proposed change. It shall also be accompanied by references to such treaties and foreign laws relating to patents, trade and other marks, and trade or commercial names, as, in the opinion of the commissioners, may affect citizens of the United States.

That the sum of two hundred and fifty dollars, or so much thereof as may be necessary, be appropriated to pay the necessary expenses of the commissioners in making their report, which sum shall be immediately available.

Approved, June 4, 1898.



## CHAPTER II.

### CONVENTION AND AGREEMENTS ESPECIALLY MENTIONED IN THE ACT PROVIDING FOR THE APPOINTMENT OF COMMISSIONERS.

#### SECTION 1.

CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, CONCLUDED AT PARIS, MARCH 20, 1883. FINAL PROTOCOL. PROCLAMATION BY PRESIDENT JUNE 11, 1887.

CONVENTION AND FINAL PROTOCOL BETWEEN THE UNITED STATES, BELGIUM, BRAZIL, THE DOMINICAN REPUBLIC, FRANCE, GREAT BRITAIN, GUAITEMALA, ITALY, THE NETHERLANDS, NORWAY, PORTUGAL, SALVADOR, SERBIA, SPAIN, SWEDEN, THE SWISS CONFEDERATION, AND TUNIS,<sup>1</sup> FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

[Concluded at Paris, March 20, 1883. Exchange of ratifications by Signatory Powers, June 6, 1884. Adhesion to the Convention advised by the Senate, March 2, 1887. Ratified by the President, March 29, 1887. Accession of the United States to the Union announced by the Minister Resident and Consul-General of the United States at Berne to the Federal Council of Switzerland, May 30, 1887. Proclaimed, June 11, 1887.]

BY THE PRESIDENT OF THE UNITED STATES OF AMERICA.

#### A PROCLAMATION.

Whereas a Convention and Final Protocol, in the French language, for the Protection of Industrial Property were concluded on the 20th day of March 1883 at Paris, France, between the Kingdom of Belgium and the Empire of Brazil, the French Republic, the Republic of Guatemala, the Kingdom of Italy, the Kingdom of the Netherlands, the Kingdom of Portugal, the Republic of Salvador, the Kingdom of Serbia, the Kingdom of Spain, and the Swiss Confederation, the tenor of which Convention and Final Protocol is as follows:

*Convention for the Protection of Industrial Property.*

*Convention pour la Protection de la Propriété Industrielle.*

His Majesty the King of the Belgians; His Majesty the Emperor of Brazil; His Majesty the King of Spain; The President of the French Republic; The President of the Republic of Guatemala; His Majesty the King of Italy; His Majesty the King of the Netherlands; His Majesty the King of Portugal and the Algarves; the President of the Republic of Salvador; His Majesty the King of Serbia; the Federal Council of the Swiss Confederation;

Sa Majesté le Roi des Belges, Sa Majesté l'Empereur du Brésil, Sa Majesté le Roi d'Espagne, le Président de la République Française, le Président de la République de Guatemala, Sa Majesté le Roi d'Italie, Sa Majesté le Roi des Pays-Bas, Sa Majesté le Roi de Portugal et des Algarves, le Président de la République de Salvador, Sa Majesté le Roi de Serbie et le Conseil fédéral de la Confédération Suisse;

Equally animated by the desire to assure, by common accord, a complete

Également animés du désir d'assurer, d'un common accord, une complète et

<sup>1</sup> The following countries are now members of the Union: Belgium, Brazil, Denmark with the Farøe Islands, Dominican Republic, France with Algeria and the French colonies, Great Britain with New Zealand and Queensland, Italy, Japan; Netherlands with the Dutch East Indies, Surinam, and Curaçao; Norway, Portugal, Serbia, Spain, Sweden, Switzerland, Tunis, and the United States.

The following countries not now members of the Union may be said to be at the present time seriously considering the question of becoming members, from the fact that they each sent one or more delegates to the conference of the Union held at Brussels in 1897, some of these delegates taking an active part in the deliberations of the conference: Austria-Hungary, Chile, Ecuador, Germany, Mexico, and Turkey.

and efficacious protection to the industry and commerce of the subjects of their respective States, and to contribute to the safeguard of the rights of inventors, and to the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries the following:

*His Majesty the King of the Belgians:* Baron Beyens, Grand Officer of His Royal Order of Léopold, Grand Officer of the Legion of Honor, etc., His Envoy Extraordinary and Minister Plenipotentiary at Paris;

*His Majesty the Emperor of Brazil:* M. Jules Constant, Count de Villeneuve, member of the Council of His Majesty, His Envoy Extraordinary and Minister Plenipotentiary near His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Order of the Rose, Knight of the Legion of Honor, etc.

*His Majesty the King of Spain:* His Excellency the Duke de Fernan-Núñez, de Montellano, and Del Arco, Count de Cervellon, Marquis of Almonacir, Grandee of Spain of the 1st Class, Knight of the distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Knight of Calatrava, Grand Cross of the Legion of Honor, etc., Senator of the Kingdom, His Ambassador Extraordinary and Plenipotentiary at Paris;

*The President of the French Republic:* Mr. Paul Challemeil-Lacour, Senator, Minister of Foreign Affairs; Mr. Hérisson, Deputy, Minister of Commerce; Mr. Charles Jagerschmidt, Minister Plenipotentiary of 1st Class, Officer of the National Order of the Legion of Honor;

*The President of the Republic of Guatemala:* Mr. Crisanto Medina, Officer of the Legion of Honor, etc., His Envoy Extraordinary and Minister Plenipotentiary at Paris;

*His Majesty the King of Italy:* Mr. Constantin Ressiman, Commander of His Orders of St. Maurice and St. Lazarus, and of the Crown of Italy, Commander of the Legion of Honor, etc., Counsellor of the Embassy of Italy at Paris;

*His Majesty the King of the Netherlands:* Baron de Zuylen de Nyevelt, Commander of His Order of the Lion of the Netherlands, Grand Cross of His Grand Ducal Order of the Oaken Crown and of the Golden Lion of Nassau, Grand Officer of the Legion of Honor, etc., His Envoy Extraordinary and Minister Plenipotentiary at Paris;

*His Majesty the King of Portugal and the Algarves:* Mr. José da Silva Mendes Leal, Counsellor of State, Peer of the Kingdom, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Knight of the Order of the Tower and of the Sword of Portugal, Grand Officer of

efficace protection à l'industrie et au commerce des nationaux de leurs États respectifs et de contribuer à la garantie des droits des inventeurs et de la loyauté des transactions commerciales, ont résolu de conclure une Convention à cet effet et ont nommé pour leurs Plénipotentiaires, savoir:

*Sa Majesté le Roi des Belges,* M. le Baron Beyens, Grand Officier de Son Ordre Royal de Léopold, Grand-Officier de la Légion d'honneur, etc., son Envoyé extraordinaire et Ministre plénipotentiaire à Paris;

*Sa Majesté L'Empereur du Brésil,* M. Jules Constant, Comte de Villeneuve, Membre du Conseil de Sa Majesté, son Envoyé extraordinaire et Ministre plénipotentiaire près Sa Majesté le Roi des Belges, Commandeur de l'Ordre du Christ, Officier de son Ordre de la Rose, Chevalier de la Légion d'honneur, etc.;

*Sa Majesté le Roi d'Espagne,* S. Exc. M. le Duc de Fernan-Núñez, de Montellano et Del Arco, Comte de Cervellon, Marquis de Almonacir, Grand d'Espagne de 1<sup>re</sup> classe, Chevalier de l'Ordre Insigne de la Toison-d'Or, Grand-Croix de l'Ordre de Charles III., Chevalier de Calatrava Grand-Croix de la Légion d'honneur, etc., Sénateur du Royaume, son Ambassadeur extraordinaire et plénipotentiaire à Paris;

*Le Président de la République Française,* M. Paul Challemeil-Lacour, Sénateur, Ministre des Affaires étrangères; M. Hérisson, Député, Ministre du Commerce; M. Charles Jagerschmidt, Ministre plénipotentiaire de 1<sup>re</sup> classe, Officier de l'Ordre National de la Légion d'honneur, etc.;

*Le Président de la République de Guatemala,* M. Crisanto Medina, Officier de la Légion d'honneur, etc., son Envoyé extraordinaire et Ministre plénipotentiaire à Paris;

*Sa Majesté le Roi d'Italie,* M. Constantin Ressiman, Commandeur de ses Ordres des Saints Maurice et Lazare et de la Couronne d'Italie, Commandeur de la Légion d'honneur, etc., Conseiller de l'Ambassade d'Italie à Paris;

*Sa Majesté le Roi des Pays-Bas,* M. le Baron de Zuylen de Nyevelt, Commandeur de son Ordre du Lion Néerlandais, Grand-Croix de son Ordre Grand-Ducal de la Couronne du Chêne et du Lion-d'Or de Nassau, Grand Officier de la Légion d'honneur, etc., son Envoyé extraordinaire et Ministre plénipotentiaire à Paris;

*Sa Majesté le Roi de Portugal et des Algarves,* M. José da Silva Mendes Leal, Conseiller d'État, Pair du Royaume, Ministre et Secrétaire d'État honoraire, Grand-Croix de l'Ordre de Saint-Jacques, Chevalier de l'Ordre de la Tour et de l'Épée de Portugal, Grand Officier de la Légion



the Legion of Honor, etc., His Envoy Extraordinary and Minister Plenipotentiary at Paris; Mr. Fernand de Azevedo, Officer of the Legion of Honor, etc., First Secretary of the Legation of Portugal at Paris;

*The President of the Republic of Salvador:* Mr. Torres Caicedo, Corresponding Member of the Institute of France, Grand Officer of the Legion of Honor, etc., His Envoy Extraordinary and Minister Plenipotentiary at Paris;

*His Majesty the King of Servia:* Mr. Sima M. Marinovitch, Chargé d'Affaires ad interim of Servia, Knight of the Royal Order of Takovo, etc.;

And the *Federal Council of the Swiss Confederation:* Mr. Charles Edward Lardy, its Envoy Extraordinary and Minister Plenipotentiary at Paris; Mr. J. Weibel, Engineer at Geneva, President of the Swiss Section of the permanent Commission for the protection of Industrial Property.

Who, after having communicated to each other their respective full powers, found to be in good and due form, have agreed upon the following Articles:

#### ARTICLE I.

The Governments of Belgium, of Brazil, of Spain, of France, of Guatemala, of Italy, of the Netherlands, of Portugal, of Salvador, of Servia and of Switzerland, have constituted themselves into a state of Union for the protection of Industrial Property.<sup>1</sup>

#### ARTICLE II.

The subjects or citizens of each of the contracting States shall enjoy, in all the other States of the Union, so far as concerns patents for inventions,<sup>2</sup> trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterwards accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.<sup>3</sup>

#### ARTICLE III.

Are assimilated to the subjects or citizens of the contracting States, the subjects or citizens of States, not forming part of the Union, who are domiciled or

d'honneur, etc., son Envoyé extraordinaire et Ministre plénipotentiaire à Paris; M. Fernand de Azevedo, Officier de la Légion d'honneur, etc., Premier Secrétaire de la Légation de Portugal à Paris;

*Le Président de la République de Salvador,* M. Torres Caicedo, Membre correspondant de l'Institut de France, Grand Officier de la Légion d'honneur, etc., son Envoyé extraordinaire et Ministre plénipotentiaire à Paris;

*Sa Majesté le Roi de Serbie,* M. Sima S. Marinovitch, Chargé d'Affaires par intérim de Serbie, Chevalier de l'Ordre Royal de Takovo, etc., etc.;

Et le *Conseil Fédéral de la Confédération Suisse,* M. Charles-Edouard Lardy, son Envoyé extraordinaire et Ministre plénipotentiaire à Paris; M. J. Weibel, Ingénieur à Genève, Président de la Section Suisse de la Commission permanente pour la protection de la propriété industrielle.

Lesquels, après s'être communiqué leurs pleins pouvoirs respectifs, trouvés en bonne et due forme, sont convenus des Articles suivants:

#### ARTICLE I.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse sont constitués à l'état d'Union pour la protection de la Propriété industrielle.

#### ARTICLE II.

Les sujets ou citoyens de chacun des États contractants jouiront, dans tous les autres États de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux. En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque État.

#### ARTICLE III.

Sont assimilés aux sujets ou citoyens des États contractants les sujets ou citoyens des États ne faisant pas partie de l'Union, qui sont domiciliés ou ont des

<sup>1</sup> See paragraph 1 of Final Protocol, p. 152.

<sup>2</sup> See paragraph 2 of Final Protocol, p. 152.

<sup>3</sup> See paragraph 3 of Final Protocol, p. 153.



have industrial or commercial establishments upon the territory of one of the States of the Union.<sup>1</sup>

#### ARTICLE IV.

Any one who shall have regularly deposited an application for a patent of invention, of an industrial model, or design, of a trade or commercial mark, in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

In consequence, the deposit subsequently made in one of the other States of the Union, before the expiration of these periods cannot be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working by a third party, by the sale of copies of the design, or model, by the employment of the mark.

The periods of priority above-mentioned shall be six months for patents of invention and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the seas.<sup>1</sup>

#### ARTICLE V.

The introduction by the patentee into countries where the patent has been granted, of articles manufactured in any other of the States of the Union, shall not entail forfeiture.

The patentee, however, shall be subject to the obligation of working his patent conformably to the laws of the country into which he has introduced the patented articles.

#### ARTICLE VI.

Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the Union.<sup>2</sup>

Shall be considered as country of origin, the country where the depositor has his principal establishment.

If this principal establishment is not situated in one of the countries of the Union, shall be considered as country of origin that to which the depositor belongs.

The deposit may be refused, if the object, for which it is asked, is considered contrary to morals and to public order.

établissements industriels ou commerciaux sur le territoire de l'un des États de l'Union.

#### ARTICLE IV.

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des États contractants, jouira, pour effectuer le dépôt dans les autres États, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres États de l'Union, avant l'expiration de ces délais, ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre mer.

#### ARTICLE V.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des États de de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

#### ARTICLE VI.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant a son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré contraire à la morale ou à l'ordre public.

<sup>1</sup> See amendment First Protocol signed at Brussels December 14, 1897, p. 182.

<sup>2</sup> See paragraph 4 of Final Protocol, p. 153.

## ARTICLE VII.

The nature of the production upon which the trade or commercial mark is to be affixed can not in any case be an obstacle to the deposit of the mark.

## ARTICLE VIII.

The commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not, of a trade or commercial mark.

## ARTICLE IX.

Every production bearing, unlawfully, a trade or commercial mark, or a commercial name, may be seized upon importation into those of the States of the Union in which such mark or such commercial name has a right to legal protection.

The seizure shall take place either at the instance of the public prosecutor or of the interested party, conformably to the domestic legislation of each State.<sup>1</sup>

## ARTICLE X.

The provisions of the preceding article shall be applicable to every production bearing falsely as indication of origin, the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention.

Is reputed interested party every manufacturer or trader engaged in the manufacture or sale of this production, when established in the locality falsely indicated as the place of export.<sup>1</sup>

## ARTICLE XI.

The High Contracting parties engage between themselves to accord a temporary protection to patentable inventions, to industrial designs or models as well as to trade or commercial marks for the productions, which may figure at official or officially recognized International Exhibitions.<sup>1</sup>

## ARTICLE XII.

Each one of the High Contracting parties engages to establish a special service of Industrial Property and a Central Depot, for giving information to the public, concerning patents of invention, industrial designs or models and trade or commercial marks.<sup>2</sup>

## ARTICLE VII.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

## ARTICLE VIII.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce.

## ARTICLE IX.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des États de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

La saisie aura lieu à la requête soit du Ministère public, soit de la partie intéressée, conformément à la législation intérieure de chaque État.

## ARTICLE X.

Les dispositions de l'article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

## ARTICLE XI.

Les Hautes Parties contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce pour les produits qui figureront aux Expositions internationales officielles ou officiellement reconnues.

## ARTICLE XII.

Chacune des Hautes Parties contractantes s'engage à établir un service spécial de la Propriété industrielle et un dépôt central pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

<sup>1</sup> See amendment First Protocol, signed at Brussels December 14, 1897, p. 182.

<sup>2</sup> See paragraph 5 of Final Protocol, p. 153.



## ARTICLE XIII.

An International Office shall be organized under the title of "International Bureau of the Union for the Protection of Industrial Property."

This Bureau, the cost of which shall be supported by the Governments of all the contracting States, shall be placed under the high authority of the Superior Administration of the Swiss Confederation, and shall work under its supervision. Its powers shall be determined by common accord between the States of the Union.

## ARTICLE XIV.

The present convention shall be submitted to periodical revisions for the purpose of introducing improvements calculated to perfect the system of the Union.

With this object, Conferences shall take place successively in one of the contracting States between the delegates of said States.

The next meeting shall take place in 1885 at Rome.<sup>1</sup>

## ARTICLE XV.

It is understood that the High Contracting parties respectively reserve the right to make, separately, between themselves, special arrangements for the protection of industrial property so far as these arrangements shall not interfere with the provisions of the present convention.<sup>2</sup>

## ARTICLE XVI.

The States that have not taken part in the present convention shall be admitted to adhere to the same upon their application.

This adhesion shall be notified through the diplomatic channel to the Government of the Swiss Confederation and by the latter to all the others.

It shall convey, of full right, accession to all the clauses and admission to all the advantages stipulated by the present convention.<sup>1</sup>

## ARTICLE XVII.

The execution of the reciprocal engagements contained in the present convention is subordinated so far as needful, to the accomplishment of the formalities and rules established by the Constitutional laws of such of the High Contracting parties as are bound to ask the application thereof, which they agree to do within the shortest delay possible.

## ARTICLE XIII.

Un office international sera organisé sous le titre de *Bureau International de l'Union pour la protection de la Propriété industrielle*.

Ce Bureau, dont les frais seront supportés par les administrations de tous les États contractants, sera placé sous la haute autorité de l'Administration supérieure de la Confédération suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les États de l'Union.

## ARTICLE XIV.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des États contractants, entre les délégués desdits États.

La prochaine réunion aura lieu en 1885, à Rome.

## ARTICLE XV.

Il est entendu que les Hautes Parties contractantes se réservent respectivement le droit de prendre séparément, entre elles, des arrangements particuliers pour la protection de la Propriété industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

## ARTICLE XVI.

Les États qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, et par celui-ci à tous les autres.

Elle emportera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention.

## ARTICLE XVII.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

<sup>1</sup>See amendment First Protocol signed at Brussels December 14, 1897, p. 182.

<sup>2</sup>See agreement concerning the suppression of false indications of origin and agreement concerning the international registration of trademarks concluded at Madrid, April 15, 1891, p. 158.



## ARTICLE XVIII.

The present Convention shall be put into execution within a month after exchange of ratifications, and shall remain in force during a period of time not determined, until the expiration of one year from the day upon which the denunciation shall be made.

This denunciation shall be addressed to the Government empowered to receive adhesions. It shall only produce its effect as regards the State making it, the convention remaining executory for the other contracting parties.

## ARTICLE XIX.

The present Convention shall be ratified and the ratifications shall be exchanged at Paris, within the period of one year at the latest.

In witness whereof the respective Plenipotentiaries have signed it and affixed to it their seals.

Done at Paris the 20th of March, 1883.

[SEAL.] BEYENS.

" VILLENEUVE.  
 " DUC DE FERNAN-NUÑEZ.  
 " P. CHALLEMEL-LACOUR.  
 " CH. HÉRISSON.  
 " CH. JAGERSCHMIDT.  
 " CRISANTO MEDINA.  
 " RESSMAN.  
 " BARON DE ZUYLEN DE NYEVELT.  
 " JOSÉ DA SILVA MENDES LEAL.  
 " F. D'AZEVEDO.  
 " J. M. TORRES-CAÍCEDO.  
 " SIMA M. MARINOVITCH.  
 " LARDY.  
 " J. WEIBEL.

## FINAL PROTOCOL.

On proceeding to the signature of the convention, concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed on the following:

1. The words *Industrial Property* are to be understood in their widest acceptation, in the sense that they apply not only to the productions of industry properly so called, but equally to the productions of agriculture (wines, grains, fruits, cattle, &c.) and to mineral productions used in commerce (mineral waters, &c.).

2. Under the name *Patents of Invention* are included the various classes of industrial patents granted by the laws of the contracting states, such as patents of importation, patents of improvement, &c.

## ARTICLE XVIII.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'Etat qui l'aura faite, la Convention restant exécutoire pour les autres Parties contractantes.

## ARTICLE XIX.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris, dans le délai d'un an au plus tard.

En foi de quoi, les Plénipotentiaires respectifs l'ont signée et y ont apposé leurs cachets.

Fait à Paris, le 20 Mars 1883.

[L. s.] BEYENS.

" VILLENEUVE.  
 " DUC DE FERNAN-NUÑEZ.  
 " P. CHALLEMEL-LACOUR.  
 " CH. HÉRISSON.  
 " CH. JAGERSCHMIDT.  
 " CRISANTO MEDINA.  
 " RESSMAN.  
 " BARON DE ZUYLEN DE NYEVELT.  
 " JOSÉ DA SILVA MENDES LEAL.  
 " F. D'AZEVEDO.  
 " J. M. TORRES-CAÍCEDO.  
 " SIMA M. MARINOVITCH.  
 " LARDY.  
 " J. WEIBEL.

## PROTOCOLE DE CLÔTURE.

Au moment de procéder à la signature de la Convention conclue, à la date de ce jour, entre les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse, pour la protection de la Propriété industrielle, les Plénipotentiaires soussignés sont convenus de ce qui suit:

1. Les mots *Propriété Industrielle* doivent être entendus dans leur acceptation la plus large, en ce sens qu'ils s'appliquent non seulement aux produits de l'industrie proprement dite, mais également aux produits de l'agriculture (vins, grains, fruits, bestiaux, etc.) et aux produits minéraux livrés au commerce (eaux minérales, etc.).

2. Sous le nom de *Brevets d'invention* sont comprises les diverses espèces de brevets industriels admises par les législations des États contractants, telles que brevets d'importation, brevets de perfectionnement, etc.

3. It is understood that the final provision of Article 2 of the convention shall in no respect infringe upon the laws of each of the contracting states, so far as concerns the procedure before the courts and the competence of the said courts.

4. Paragraph 1 of Article 6 is to be understood in the sense that no trade or commercial mark shall be excluded from protection, in one of the states of the Union, by the mere fact that it may not satisfy, in respect to the signs composing it, the conditions of the laws of this state, provided that it does satisfy, in this regard, the laws of the country of origin, and that it has been in this latter country, duly deposited. Saving this exception which concerns only the form of the mark, and under reservation of the provisions of the other articles of the convention, the domestic legislation of each of the states shall receive its due application.

In order to avoid all misinterpretation, it is understood that the use of public armorial bearings and decorations may be considered contrary to public order in the sense of the final paragraph of Article 6.

5. The organization of a special service of Industrial Property mentioned in Article 12 shall include, as far as is possible, the publication in each state of an official periodical.

6. The common expenses of the International Bureau, created by Article 13, shall in no case exceed yearly a sum-total representing a mean of 2,000 francs for each contracting state.<sup>1</sup>

In order to determine the contributory share of each of the states in this sum-total of expenses, the contracting states, and those who may hereafter adhere to the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely:

1st class .....	25 units
2d " .....	20 "
3d " .....	15 "
4th " .....	10 "
5th " .....	5 "
6th " .....	3 "

These coefficients shall be multiplied by the number of the states of each class, and the sum of the products thus obtained shall furnish the number of units by which the total expense is to be divided. The quotient will give the amount of the unit of expense.

3. Il est entendu que la disposition finale de l'article 2 de la Convention ne porte aucune atteinte à la législation de chacun des États contractants, en ce qui concerne la procédure suivie devant les tribunaux et la compétence de ces tribunaux.

4. Le paragraphe 1<sup>er</sup> de l'article 6 doit être entendu en ce sens qu' aucune marque de fabrique ou de commerce ne pourra être exclue de la protection dans l'un des États de l'Union par le fait seul qu'elle ne satisferait pas, au point de vue des signes qui la composent, aux conditions de la législation de cet État, pourvu qu'elle satisfasse, sur ce point, à la législation du pays d'origine et qu'elle ait été, dans ce dernier pays, l'objet d'un dépôt régulier. Sauf cette exception, qui ne concerne que la forme de la marque, et sous réserve des dispositions des autres articles de la Convention, la législation intérieure de chacun des États recevra son application.

Pour éviter toute fausse interprétation, il est entendu que l'usage des armoiries publiques et des décorations peut être considéré comme contraire à l'ordre public, dans le sens du paragraphe final de l'article 6.

5. L'organisation du service spécial de la Propriété industrielle mentionné à l'article 12 comprendra, autant que possible, la publication, dans chaque État, d'une feuille officielle périodique.

6. Les frais communs du Bureau international institué par l'article 13 ne pourront, en aucun cas, dépasser, par année, une somme totale représentant une moyenne de 2,000 francs par chaque État contractant.

Pour déterminer la part contributive de chacun des États dans cette somme totale des frais, les États contractants et ceux qui adhèreraient ultérieurement à l'Union seront divisés en six classes, contribuant chacune dans la proportion d'un certain nombre d'unités, savoir:

1 <sup>re</sup> classe .....	25 unités.
2 <sup>e</sup> " .....	20 "
3 <sup>e</sup> " .....	15 "
4 <sup>e</sup> " .....	10 "
5 <sup>e</sup> " .....	5 "
6 <sup>e</sup> " .....	3 "

Ces coefficients seront multipliés par le nombre des États de chaque classe, et la somme des produits ainsi obtenus fournira le nombre d'unités par lequel la dépense totale doit être divisée. Le quotient donnera le montant de l'unité de dépense.

<sup>1</sup>Amended. See Article 1 of Third Protocol, signed at Madrid, April 15, 1891, p. 156.



The contracting states are classified as follows in respect to the division of the expenses:

- 1st class.—France, Italy.
- 2d “ —Spain.
- 3d “ —Belgium, Brazil, Portugal, Switzerland.
- 4th “ —Netherlands.
- 5th “ —Servia.
- 6th “ —Guatemala, Salvador.

The Swiss Government shall supervise the expenditure of the International Bureau, make the necessary advances, and state the annual account, which shall be communicated to all the other Governments.

The International Bureau shall collect information of every kind relating to the protection of Industrial Property, and shall compile from it general statistics, which shall be transmitted to all the Governments. It shall occupy itself with examinations of general utility which may be of interest to the Union, and shall publish, with the assistance of the documents put at its disposal by the various Governments, a periodical in the French language on questions which concern the object of the Union.

The numbers of this periodical and all the documents published by the International Bureau shall be partitioned among the Governments of the states of the Union in the proportion of the number of contributory units above mentioned.

The copies and supplementary documents which may be requested either by the said Governments, or by corporations or private persons, shall be paid for separately.

The International Bureau must always hold itself at the disposal of the members of the Union, in order to furnish them, on questions relating to the international service of Industrial Property, with such special information as they may need.

The Government of the country where the next Conference is to be held shall prepare, with the assistance of the International Bureau, the work of the said Conference.

The director of the International Bureau shall be present at the sessions of the Conferences, and shall take part in the discussions without voting.

He shall make an annual report on its management, which shall be communicated to all the members of the Union.

The official language of the International Bureau shall be the French language.

7. The present final protocol, which shall be ratified at the same time as the Convention concluded this day, shall be considered as forming an integral part of that Convention, and shall have the same force, value, and duration.

Les États contractants sont classés ainsi qu'il suit, en vue de la répartition des frais:

- 1<sup>re</sup> classe—France, Italie.
- 2<sup>e</sup> “ —Espagne.
- 3<sup>e</sup> “ —Belgique, Brésil, Portugal, Suisse.
- 4<sup>e</sup> “ —Pays-Bas.
- 5<sup>e</sup> “ —Serbie.
- 6<sup>e</sup> “ —Guatemala, Salvador.

L'Administration suisse surveillera les dépenses du Bureau international, fera les avances nécessaires et établira le compte annuel, qui sera communiqué à toutes les autres Administrations.

Le Bureau international centralisera les renseignements de toute nature relatifs à la protection de la Propriété industrielle et les réunira en une statistique générale qui sera distribuée à toutes les Administrations. Il procédera aux études d'utilité commune intéressant l'Union et rédigera, à l'aide des documents qui seront mis à sa disposition par les diverses Administrations, une feuille périodique, en langue française, sur les questions concernant l'objet de l'Union.

Les numéros de cette feuille, de même que tous les documents publiés par le Bureau International, seront répartis entre les Administrations des États de l'Union, dans la proportion du nombre des unités contributives ci-dessus mentionnées.

Les exemplaires et documents supplémentaires qui seraient réclamés, soit par lesdites Administrations, soit par des sociétés ou des particuliers, seront payés à part.

Le Bureau international devra se tenir en tout temps à la disposition des Membres de l'Union, pour leur fournir, sur les questions relatives au service international de la Propriété industrielle, les renseignements spéciaux dont ils pourraient avoir besoin.

L'Administration du pays où doit siéger la prochaine Conférence préparera, avec le concours du Bureau international, les travaux de cette Conférence.

Le directeur du Bureau international assistera aux séances des Conférences et prendra part aux discussions sans voix délibérative. Il fera, sur sa gestion, un rapport annuel qui sera communiqué à tous les membres de l'Union.

La langue officielle du Bureau international sera la langue française.

7. Le présent Protocole de Clôture, qui sera ratifié en même temps que la Convention conclue à la date de ce jour, sera considéré comme faisant partie intégrante de cette Convention, et aura mêmes force, valeur et durée.



In faith whereof the undersigned plenipotentiaries have drawn up the present protocol.

Signed: BEYENS.

" VILLENEUVE.  
 " DUC DE FERNAN-NUÑEZ.  
 " P. CHALLEMEL-LACOUR.  
 " CH. HÉRISSE.  
 " CH. JAGERSCHMIDT.  
 " CRISANTO MEDINA.  
 " RESSMAN.  
 " BARON DE ZUYLEN DE NYEVELT.  
 " JOSÉ DA SILVA MENDES LEAL.  
 " F. d'AZEVEDO.  
 " J. M. TORRES CAICEDO.  
 " SIMA M. MARINOVITCH.  
 " J. LARDY.  
 " J. WEIBEL.

En foi de quoi, les Plénipotentiaires soussignés ont dressé le présent Protocole.

Signé: BEYENS.

" VILLENEUVE.  
 " DUC DE FERNAN-NUÑEZ.  
 " P. CHALLEMEL-LACOUR.  
 " CH. HÉRISSE.  
 " CH. JAGERSCHMIDT.  
 " CRISANTO MEDINA.  
 " RESSMAN.  
 " BARON DE ZUYLEN DE NYEVELT.  
 " JOSÉ DA SILVA MENDES LEAL.  
 " F. d'AZEVEDO.  
 " J. M. TORRES CAICEDO.  
 " SIMA M. MARINOVITCH.  
 " LARDY.  
 " J. WEIBEL.

And whereas the several Contracting parties to the said Convention and Final Protocol exchanged the ratifications thereof, at the City of Paris, on the 6th day of June, 1884;

And whereas the several States hereinafter named, have adhered to the said Convention and Final Protocol in virtue of Article XVI of the said Convention :

Great Britain.....	March 17, 1884.
Tunis.....	March 20, 1884.
The Dominican Republic .....	October 20, 1884.
Norway .....	July 1st, 1885.
Sweden.....	July 3, 1885.

And whereas in virtue of Article III of the Regulation for the Execution of the said Convention, the several States hereinafter named have declared that their accession to the International Union for the protection of Industrial Property includes that of their Colonies and Possessions hereinafter enumerated, namely:

France: Martinique, Guadeloupe and dependencies, Reunion and dependency, (Saint Mary of Madagascar) Cochín-China, St. Pierre, Miquelon, Guiana, Senegal and dependencies (Rivières du Sud, Grand Bassam, Assinie, Porto Novo and Kotonou), the Congo and of the Gaboon, Mayotte, Nossi-Bé, the French Establishments in India (Pondicherry, Chandernagore, Karikal, Mahé, Yanaon), New Caledonia, the French Establishments in Oceanica (Tahiti and dependencies), Obock and Diégo-Suarez;

Portugal: The Azores and Madeira;

Spain: Cuba, Porto Rico and the Philippines.

And whereas the Republic of Salvador has in virtue of Article XVIII of the said Convention, denounced the same on the 17th day of August 1886, and will cease to be a member of the International Union for the Protection of Industrial Property on and after the 17th day of August 1887;

And whereas the Swiss Confederation in virtue of the said Article XVI of the said Convention has invited the United States of America to adhere to the said Convention and final protocol;

And whereas the President of the United States of America, by and with the advice and consent of the Senate thereof, did on the 29th day of March 1887, declare that the United States adhere to the said Convention and Final Protocol of the 20th of March, 1883;

And whereas the Minister Resident and Consul General of the United States at Berne did, in virtue of Article II of the Regulation for the

Execution of the Convention of March 20, 1883, by note of May 30, 1887, to the Swiss Federal Council, designate the said thirtieth day of May 1887, as the date of accession of the United States of America to the Union for the Protection of Industrial Property;

Now, therefore, be it known that I, Grover Cleveland, President of the United States of America, have caused the said Convention and Final Protocol of March 20, 1883, to be made public, to the end that the same and every article and clause thereof may be observed and fulfilled with good faith by the United States and the citizens thereof.

In witness whereof, I have hereunto set my hand and caused the seal of the United States to be affixed.

Done at the city of Washington, this 11th day of June in the year of our Lord one thousand eight hundred and eighty-seven,  
[SEAL.] and of the Independence of the United States of America the one hundred and eleventh.

GROVER CLEVELAND.

By the President:

T. F. BAYARD,

*Secretary of State.*

## SECTION 2.

SUPPLEMENTAL CONVENTION CONCLUDED AT MADRID APRIL 15, 1891, AMENDING CONVENTION OF PARIS, CONCLUDED MARCH 20, 1883—PROCLAMATION BY PRESIDENT JUNE 22, 1892.

SUPPLEMENTAL CONVENTION BETWEEN THE UNITED STATES, BELGIUM, BRAZIL, FRANCE, GREAT BRITAIN, GUATEMALA, ITALY, THE NETHERLANDS, NORWAY, PORTUGAL, SPAIN, SWEDEN, SWITZERLAND, AND TUNIS, AMENDATORY OF THE CONVENTION OF MARCH 20, 1883, FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

[Concluded at Madrid April 15, 1891. Ratification advised by the Senate March 2, 1892. Ratified by the President March 30, 1892. Ratifications exchanged June 15, 1892. Proclaimed June 22, 1892.]

BY THE PRESIDENT OF THE UNITED STATES OF AMERICA.

### A PROCLAMATION.

Whereas protocol 3, amendatory of the Convention of March 20, 1883, for the Protection of Industrial Property was signed at Madrid on the 15th day of April, 1891, by the plenipotentiaries of the United States and other powers, a certified copy of which protocol 3, in the French language, is word for word as follows:

#### *Third protocol.*

Protocol concerning the dotation of the International Bureau of the Union for the Protection of Industrial Property between Belgium, Brazil, Spain, the United States of America, France, Great Britain, Guatemala, Italy, Norway, the Netherlands, Portugal, Sweden, Switzerland, and Tunis.

The undersigned plenipotentiaries of the Governments above named,

In view of the declaration adopted March 12, 1883, by the International Con-

#### *Troisième protocole.*

Protocole concernant la dotation du Bureau International de l'Union pour la Protection de la Propriété Industrielle conclu entre la Belgique, le Brésil, l'Espagne, les Etats-Unis d'Amérique, la France, la Grande Bretagne, le Guatemala, l'Italie, la Norvège, les Pays-Bas, le Portugal, la Suède la Suisse, et la Tunisie.

Les soussignés Plénipotentiaries des Gouvernements ci-dessus énumérés,

Vu la Déclaration adoptée le 12 mars 1883 par la Conférence internationale

ference for the Protection of Industrial Property convened at Paris,

Have, with one accord and subject to ratification, concluded the following protocol:

#### ARTICLE 1.

The first paragraph of No. 6 of the final protocol annexed to the International Convention of March 20, 1883, for the protection of industrial property is annulled and replaced by the following provision:

"The expenses of the International Bureau instituted by Article 13 shall be supported by the contracting states in common. They can not in any event exceed the sum of sixty thousand francs per annum.

#### ARTICLE 2.

The present protocol shall be ratified, and the ratifications thereof shall be exchanged at Madrid within a period of six months at the latest.

It shall take effect one month after the exchange of ratifications, and shall have the same force and duration as the Convention of March 20, 1883, of which it shall be considered as forming an integral part.

In testimony whereof the plenipotentiaries of the states above named have signed the present protocol at Madrid, the fifteenth day of April, one thousand eight hundred and ninety-one.

For Belgium: Th. de Bounder de Melsbroeck.

For Brazil: Luis F. d'Abreu.

For Spain: S. Moret, Marquis de Aguilar, Enrique Calleja, Luis Mariano de Larra.

For the United States of America: E. Burd Grubb.

For France and Tunis: P. Cambon.

For Great Britain: Francis Clare Ford.

For Guatemala: J. Carrera.

For Italy: Maffei.

For Norway: Arild Huitfeldt.

For the Netherlands: Gericke.

For Portugal: Count de Casal Ribeiro.

For Sweden: Arild Huitfeldt.

For Switzerland: Ch. E. Lardet Morel.

pour la protection de la propriété industrielle réunie à Paris,

Ont, d'un commun accord, et sous réserve de ratification, arrêté le Protocole suivant:

#### ARTICLE PREMIER.

Le premier alinéa du chiffre 6 du Protocole de clôture annexé à la Convention internationale du 20 mars 1883, pour la protection de la propriété industrielle est abrogé et remplacé par la disposition suivante:

"Les dépenses du Bureau international institué par l'article 13 seront supportées en commun par les Etats contractants. Elles ne pourront, en aucun cas, dépasser la somme de soixante mille francs par année."

#### ARTICLE 2.

Le présent protocole sera ratifié, et les ratifications en seront échangées à Madrid dans le délai de six mois au plus tard.

Il entrera en vigueur un mois à partir de l'échange des ratifications, et aura la même force et durée que la Convention de 20 mars 1883 dont il sera considéré comme faisant partie intégrante.

En foi de quoi, les plenipotentiaires des Etats ci-dessus énumérés ont signé le présent protocole à Madrid le quinze avril mil huit cent quatre-vingt-onze.

Pour la Belgique: Th. de Bounder de Melsbroeck.

Pour le Brésil: Luis F. d'Abreu.

Pour l'Espagne: S. Moret, Marqués de Aguilar, Enrique Calleja, Luis Mariano de Larra.

Pour les Etats-Unis d'Amérique: E. Burd Grubb.

Pour la France et la Tunisie: P. Cambon.

Pour la Grande-Bretagne: Francis Clare Ford.

Pour le Guatemala: J. Carrera.

Pour l'Italie: Maffei.

Pour la Norvège: Arild Huitfeldt.

Pour les Pays-Bas: Gericke.

Pour le Portugal: Comte de Casal Ribeiro.

Pour la Suède: Arild Huitfeldt.

Pour la Suisse: Ch. E. Lardet Morel.

And whereas the said protocol 3 has been duly ratified by the signatory powers, and the ratifications thereof were exchanged at the city of Madrid, on the 15th day of June, 1892;

Now, therefore, be it known that I, Benjamin Harrison, President of the United States of America, have caused the said protocol 3 to be made public, to the end that the same and every article and clause



thereof may be observed and fulfilled with good faith by the United States and the citizens thereof.

In witness whereof I have hereunto set my hand and caused the seal of the United States to be affixed.

Done at the city of Washington this 22d day of June, in the year of our Lord 1892 and of the Independence of the United States the one hundred and sixteenth.

[SEAL.]

BENJ. HARRISON.

By the President:

WILLIAM F. WHARTON,

*Acting Secretary of State.*

[NOTE.—Ratifications of protocol 4 were not exchanged. The protocol was referred to the next conference to be held at Brussels. See telegram from United States Chargé at Madrid, June 15, 1892.]

### SECTION 3.

#### AGREEMENT CONCERNING THE SUPPRESSION OF FALSE INDICATIONS OF ORIGIN ON MERCHANDISE, CONCLUDED AT MADRID APRIL 14, 1891.

[Concluded at Madrid, April 14, 1891, between France, Great Britain, Spain, Switzerland, and Tunis.<sup>1</sup>]

*Arrangement concernant la Répression des  
Fausses Indications de Provenance sur les  
Marchandises.*

*Agreement concerning the suppression of  
false indications of origin on Merchandise.*

Les Soussignés, Plénipotentiaires des  
Gouvernements des États ci-dessus énu-  
mérés,

The undersigned Plenipotentiaries of  
the States above enumerated.

Vu l'article 15 de la Convention inter-  
nationale du 20 mars 1883 pour la protec-  
tion de la Propriété industrielle,

In view of article 15 of the Interna-  
tional Convention of March 20th, 1883,  
for the protection of industrial property.

Ont, d'un commun accord, et sous ré-  
serve de ratification, arrêté l'Arrange-  
ment suivant:

Have with one accord and subject to  
ratification, concluded the following  
agreement:

#### ARTICLE PREMIER.

#### ARTICLE 1.

Tout produit portant une fausse indica-  
tion de provenance dans laquelle un des  
États contractants, ou un lieu situé dans  
l'un d'entre eux, serait, directement ou  
indirectement, indiqué comme pays ou  
comme lieu d'origine, sera saisi à l'importa-  
tion dans chacun desdits États.

All product, bearing a false indication  
of origin, in which one of the contracting  
States, or a place situated in one of them,  
shall be directly or indirectly indicated  
as country or as place of origin, shall be  
seized on importation into any of said  
States.

La saisie pourra s'effectuer dans l'État  
où la fausse indication de provenance  
aura été apposée, ou dans celui où aura  
été introduit le produit muni de cette  
fausse indication.

The seizure may also be effected in the  
State where the false indication of origin  
shall have been affixed, or in that where  
the product bearing such false indication  
shall have been introduced.

Si la législation d'un État n'admet pas  
la saisie à l'importation, cette saisie sera  
remplacée par la prohibition d'importa-  
tion.

If the law of a State does not permit  
seizure on importation, such seizure shall  
be replaced by prohibition of importa-  
tion.

Si la législation d'un État n'admet pas  
la saisie à l'intérieur, cette saisie sera rem-  
placée par les actions et moyens que la  
loi de cet État assure en pareil cas aux  
nationaux.

If the law of a State does not permit  
seizure in the interior, such seizure shall  
be replaced by the remedies assured in  
like case to natives by the law of such  
State.

<sup>1</sup>Portugal adhered to this agreement October 31, 1893. Brazil adhered to this agreement October 3, 1896. The following countries are now parties to this agreement: Brazil, France, Great Britain, Portugal, Spain, Switzerland, and Tunis.

ARTICLE 2.

La saisie aura lieu à la requête soit du Ministère public, soit d'une partie intéressée, individu ou société, conformément à la législation intérieure de chaque Etat.

Les autorités ne seront pas tenues d'effectuer la saisie en cas de transit.

ARTICLE 3.

Les présentes dispositions ne font pas obstacle à ce que le vendeur indique son nom ou son adresse sur les produits provenant d'un pays différent de celui de la vente; mais, dans ce cas, l'adresse ou le nom doit être accompagné de l'indication précise et en caractères apparents du pays ou du lieu de fabrication ou de production.

ARTICLE 4.

Les tribunaux de chaque pays auront à décider quelles sont les appellations qui, à raison de leur caractère générique, échappent aux dispositions du présent Arrangement, les appellations régionales de provenance des produits vinicoles n'étant cependant pas comprises dans la réserve statué par cet article.

ARTICLE 5.

Les États de l'Union pour la protection de la Propriété industrielle qui n'ont pas pris part au présent Arrangement seront admis à y adhérer sur leur demande, et dans la forme prescrite par l'article 16 de la Convention du 20 mars 1883 pour la protection de la Propriété industrielle.

ARTICLE 6.

Le présent Arrangement sera ratifié, et les ratifications en seront échangées à Madrid dans le délai de six mois au plus tard.

Il entrera en vigueur un mois à partir de l'échange des ratifications, et aura la même force et durée que la Convention du 20 mars 1883.

En foi de quoi, les Plénipotentiaires des États ci-dessus énumérés ont signé le présent Arrangement à Madrid, le quatorze avril mil huit cent quatrevingt-onze.

ARTICLE 2.

The seizure shall take place at the request either of the public prosecutor or of an interested party, individual, or society, in conformity with the domestic law of each State.

The authorities shall not be bound to effect the seizure in case of transit.

ARTICLE 3.

The present provisions do not prevent the vendor from indicating his name or his address upon goods coming from a country other than that of sale; but in such case the address or the name must be accompanied by clear indication and in legible characters of the country or place of manufacture or of production.

ARTICLE 4.

The tribunals of each country shall decide what are the appellations which, by reason of their generic character, do not fall within the provisions of the present agreement, regional appellations of origin of products of the vine being, however, not comprised in the reserve provided for by this article.

ARTICLE 5.

The States of the Union for the protection of industrial property, which have not taken part in the present agreement, shall be admitted to adhere to the same on their demand, and the form prescribed by article 16 of the Convention of March 20th, 1883, for the protection of industrial property.

ARTICLE 6.

The present agreement shall be ratified, and the ratification shall be exchanged at Madrid within a period of six months at the latest.

It shall take effect one month after the exchange of ratifications, and shall have the same force and duration as the convention of March 20th, 1883.

In witness whereof the Plenipotentiaries of the States above named have signed the present agreement at Madrid April 14th, 1891.

## SECTION 4.

## AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF TRADE-MARKS, CONCLUDED AT MADRID APRIL 14, 1891.

[Concluded at Madrid April 14, 1891, between Belgium, France, Spain, Switzerland, and Tunis.]

*Arrangement concernant l'Enregistrement International des Marques de Fabrique ou de Commerce.**Agreement concerning the International Registration of Trade-Marks.*

Les Soussignés, Plénipotentiaires des Gouvernements des États ci-dessus énumérés,

The undersigned plenipotentiaries of the States above enumerated,

Vu l'article 15 de la Convention internationale du 20 mars 1883, pour la protection de la Propriété industrielle,

In view of article 15 of the international convention of March 20, 1883, for the protection of industrial property,

Ont, d'un commun accord, et sous réserve de ratification, arrêté l'Arrangement suivant:

Have, with one accord and subject to ratification, concluded the following agreement:

## ARTICLE PREMIER.

## ARTICLE 1.

Les sujets ou citoyens de chacun des États contractant pourront s'assurer, dans tous les autres États, la protection de leurs marques de fabrique ou de commerce acceptées au dépôt dans le pays d'origine, moyennant le dépôt desdites marques au Bureau international à Berne, fait par l'entremise de l'Administration dudit pays d'origine.

The subjects or citizens of each of the contracting States may secure, in all of the other States, the protection of their trade-marks accepted at the depository in the country of origin by means of the deposit of the said marks at the International Bureau at Berne, made by the intervention of the Government of the said country of origin.

## ARTICLE 2.

## ARTICLE 2.

Sont assimilés aux sujets ou citoyens des États contractants les sujets ou citoyens des États n'ayant pas adhéré au présent Arrangement qui satisfont aux conditions de l'article 3 de la Convention.

Are assimilated to the subjects or citizens of the contracting States, the subjects or citizens of States which have not adhered to the present agreement, who fulfill the conditions of article 3 of the Convention.

## ARTICLE 3.

## ARTICLE 3.

Le Bureau international enregistrera immédiatement les marques déposées conformément à l'article premier. Il notifiera cet enregistrement aux États contractants. Les marques enregistrées seront publiées dans un supplément au journal du Bureau international, au moyen soit d'un dessin, soit d'une description présentée en langue française par le déposant.

The International Bureau shall immediately register the marks deposited in accordance with article first. It shall give notice of this registration to the contracting States. The registered marks shall be published in a supplement to the journal of the International Bureau, either by means of a cut or of a description presented in the French language by the depositor.

En vue de la publicité à donner dans les divers États aux marques ainsi enregistrées, chaque Administration recevra gratuitement du Bureau international le nombre d'exemplaires de la susdite publication qu'il lui plaira de demander.

In view of the publicity to be given to the marks so registered in the different States, each Government shall receive gratuitously from the International Bureau such number of copies of said publication as it shall see fit to demand.

## ARTICLE 4.

## ARTICLE 4.

A partir de l'enregistrement ainsi fait au Bureau international, la protection dans chacun des États contractants sera la même que si la marque y avait été directement déposée.

From the time of registration so made at the International Bureau, the protection in each of the contracting States shall be the same as if the mark had been directly deposited therein.

<sup>1</sup>The following countries have since adhered to this agreement: Netherlands, March 1, 1893; Portugal, October 31, 1893; Italy, October 15, 1894; Brazil, October 30, 1896. The following countries are now parties to this agreement: Belgium, Brazil, France, Italy, Netherlands, Portugal, Spain, Switzerland, and Tunis.



ARTICLE 5.

Dans les pays où leur législation les y autorise, les Administrations auxquelles le Bureau international notifiera l'enregistrement d'une marque auront la faculté de déclarer que la protection ne peut être accordée à cette marque sur leur territoire.

Elles devront exercer cette faculté dans l'année de la notification prévue par l'article 3.

La dite déclaration ainsi notifiée au Bureau international sera par lui transmise sans délai à l'Administration du pays d'origine et au propriétaire de la marque. L'intéressé aura les mêmes moyens de recours que si la marque avait été par lui directement déposée dans le pays où la protection est refusée.

ARTICLE 6.

La protection résultant de l'enregistrement au Bureau international durera 20 ans à partir de cet enregistrement, mais ne pourra être invoquée en faveur d'une marque qui ne jouirait plus de la protection légale dans le pays d'origine.

ARTICLE 7.

L'enregistrement pourra toujours être renouvelé suivant les prescriptions des articles 1 et 3.

Six mois avant l'expiration du terme de protection, le Bureau international donnera un avis officiel à l'Administration du pays d'origine et au propriétaire de la marque.

ARTICLE 8.

L'Administration du pays d'origine fixera à son gré et percevra à son profit une taxe qu'elle réclamera du propriétaire de la marque dont l'enregistrement international est demandé.

A cette taxe s'ajoutera un émolument international de cent francs, dont le produit annuel sera réparti par parts égales entre les États contractants par les soins du Bureau international, après déduction des frais communs nécessités par l'exécution de cet Arrangement.

ARTICLE 9.

L'Administration du pays d'origine notifiera au Bureau international les annulations, radiations, renonciations, transmissions et autres changements qui se produiront dans la propriété de la marque.

ARTICLE 5.

In the countries where their laws so authorize, the Governments to which the International Bureau shall give notice of the registration of a mark shall have power to declare that protection can not be given to such mark within their territory.

They shall exercise this right within a year from the notice provided for by article 3.

The said declaration thus made known to the International Bureau shall be transmitted by it without delay to the Government of the country of origin and to the owner of the mark. The interested party shall have the same means of redress as if the mark had been deposited by him directly in the country where the protection is refused.

ARTICLE 6.

The protection resulting from the registration at the International Bureau shall continue for twenty years from the date of registration, but can not be invoked in favor of a mark which has ceased to enjoy legal protection in the country of origin.

ARTICLE 7.

The registration can always be renewed in accordance with the provisions of articles 1 and 3.

Six months prior to the expiration of the term of protection, the International Bureau shall give an official notice to the Government of the country of origin and to the owner of the mark.

ARTICLE 8.

The Government of the country of origin shall fix, in its discretion, and receive for its own profit a fee, which it shall collect from the owner of the mark for which international registration is demanded.

To such fee shall be added an international fee of 100 francs, the annual proceeds of which shall, under the supervision of the International Bureau, be distributed equally between the contracting States, after deduction of the common expenses necessary to the execution of this agreement.

ARTICLE 9.

The Government of the country of origin shall notify the International Bureau of annulments, cancellations, abandonments, transfers, and other changes which occur in the right of ownership of the mark.

Le Bureau international enregistra ces changements, les notifiera aux Administrations contractantes et les publiera aussitôt dans son journal.

## ARTICLE 10.

Les Administrations régleront d'un commun accord les détails relatifs à l'exécution du présent Arrangement.

## ARTICLE 11.

Les États de l'Union pour la protection de la Propriété industrielle qui n'ont pas pris part au présent Arrangement, seront admis à y adhérer sur leur demande, et dans la forme prescrite par l'article 16 de la Convention du 20 mars 1883 pour la protection de la Propriété industrielle.

Dès que le Bureau international sera informé qu'un État a adhéré au présent Arrangement, il adressera à l'Administration de cet État, conformément à l'article 3, une notification collective des marques qui, à ce moment, jouissent de la protection internationale.

Cette notification assurera, par elle même, auxdites marques le bénéfice des précédentes dispositions sur le territoire de l'État adhérent, et fera courir le délai d'un an pendant lequel l'Administration intéressée peut faire la déclaration prévue par l'article 5.

## ARTICLE 12.

Le présent Arrangement sera ratifié, et les ratifications en seront échangées à Madrid dans le délai de six mois au plus tard.

Il entrera en vigueur un mois à partir de l'échange des ratifications, et aura la même force et durée que la Convention du 20 mars, 1883.

En foi de quoi, les Plénipotentiaires des États ci-dessus énumérés ont signé le présent Arrangement à Madrid, le quatorze avril mil huit cent quatre-vingt-onze.

## PROTOCOLE DE CLÔTURE.

Au moment de procéder à la signature de l'Arrangement concernant l'enregistrement international des marques de fabrique ou de commerce, conclu à la date de ce jour, les Plénipotentiaires des États qui ont adhéré audit Arrangement sont convenus de ce qui suit:

Des doutes s'étant élevés au sujet de la portée de l'article 5, il est bien entendu que la faculté de refus que cet article laisse aux Administrations ne porte aucune atteinte aux dispositions de l'article 6 de la Convention du 20 mars 1883 et du paragraphe 4 du Protocole de clôture qui l'ac-

The International Bureau shall register these changes, shall notify the contracting Governments thereof, and shall immediately publish them in its journal.

## ARTICLE 10.

The Governments shall regulate by common consent the details pertaining to the execution of the present agreement.

## ARTICLE 11.

The States of the Union for the protection of industrial property which have not taken part in the present agreement shall be admitted to adhere thereto on their application and in the form prescribed by article 16 of the Convention of March 20, 1883, for the protection of the industrial property.

As soon as the International Bureau shall be informed that a State has adhered to the present agreement it shall address to the Government of the State, conformably to article 3, a collective notification of marks which at that time enjoy international protection.

This notice shall, of itself, secure to the said marks the benefit of the foregoing provisions in the territory of the adhering State, and shall cause to run the delay of a year, during which the interested Government can make the declaration provided for in article 5.

## ARTICLE 12.

The present agreement shall be ratified, and the ratifications shall be exchanged at Madrid within a period of six months at the latest.

It shall take effect one month after the exchange of ratifications, and shall have the same force and duration as the convention of March 20, 1883.

In witness whereof the Plenipotentiaries of the States above named have signed the present agreement at Madrid, April 14, 1891.

## FINAL PROTOCOL.

On proceeding to the signature of the agreement concerning the international registration of trade-marks, concluded this day, the Plenipotentiaries of the States which have adhered to said Agreement have agreed as follows:

Doubts having arisen on the subject of the meaning of Article 5, it is clearly understood that the right of refusal which that article leaves to the Governments does not affect the provisions of Article 6 of the Convention of March 20, 1883, and of paragraph 4 of the Final Protocol which

compagne, ces dispositions étant applicables aux marques déposées au Bureau international, comme elles l'ont été et le seront encore à celles déposées directement dans tous les pays contractants.

Le présent Protocole aura la même force et durée que l'Arrangement auquel il se rapporte.

En foi de quoi, les Plénipotentiaires soussignés ont signé le présent Protocole à Madrid, le quatorze avril mil huit cent quatre-vingt-onze.

accompanies it, these provisions being applicable to the marks deposited at the International Bureau as they have been and still will be to those deposited directly in all the contracting countries.

The present Protocol shall have the same force and duration as the Agreement of which it forms a part.

In witness whereof the undersigned Plenipotentiaries have signed the present Protocol at Madrid, the fourteenth of April, 1891.

## SECTION 5.

### RULES FOR CARRYING INTO EFFECT THE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF TRADEMARKS, CONCLUDED AT MADRID APRIL 14, 1891.

[Translated for this report by Mr. Greeley.]

#### ARTICLE 1.

Application for International registration of a trademark under the agreement of April 14, 1891, should be addressed by the owner of the mark to the Government of the country of origin in the form prescribed by the latter.

Each Government should collect for the international registration a fee of 100 francs plus such additional fee as it shall fix at its pleasure and which shall belong to it.

#### ARTICLE 2.

After having certified that the mark is duly registered, the Government of the country of origin shall address to the International Bureau at Berne:

A. An application for registration in duplicate bearing a printed representation of the mark, and a statement of—

First. The name of the owner of the mark.

Second. His address.

Third. The products or merchandise to which the mark is applied.

Fourth. The date of registration in the country of origin.

Fifth. The serial number of the mark in the country of origin.

The printed representation of the mark may be replaced by a description of the latter in the French language.

B. An electrotype (cliché) of the mark, for printing the latter in the publication which shall be made of it by the International Bureau. This electrotype (cliché) ought to reproduce the mark exactly in such a manner as to bring out clearly all its details. It must not be less than 15 millimeters nor more than 10 centimeters long or wide. The thickness of the electrotype must be exactly 24 millimeters, corresponding with the height of printing type. This electrotype will be retained at the bureau.

If the printed reproduction of the mark, required under A, is replaced by a simple description, the deposit of the electrotype shall not be necessary.

C. If color is one of the distinct features of the mark, 30 copies on paper of a reproduction of the mark in colors may be furnished with the application.



D. A postal money order for 100 francs, being the amount of the fee for international registration.

The application for registration shall be prepared in accordance with the form annexed to these rules, or in accordance with such other form as the Governments of the contracting States shall hereafter adopt by common consent.

The International Bureau will furnish the necessary forms gratuitously to the Governments.

### ARTICLE 3.

The International Bureau will proceed without delay to enter the mark on a register for the purpose.

The register will contain the following statements:

First. The date of registration in the International Bureau.

Second. The date of notification to the contracting States.

Third. The serial number of the mark.

Fourth. The name of the owner of the mark.

Fifth. His address.

Sixth. The products of articles to which the mark is applied.

Seventh. The country of origin of the mark.

Eighth. The date of registration in the country of origin.

Ninth. The serial number of the mark in the country of origin.

Tenth. Statements respecting the cancellation of the mark or its transfer. (Article 9 of the Agreement.)

### ARTICLE 4.

The entry having been made in the register, the International Bureau shall certify on the two copies of the application that the registration has been made, and shall place upon both its signature and stamp. One of these copies shall remain in the archives of the bureau; the other shall be returned to the Government of the country of origin.

Besides this, the International Bureau shall notify the Governments of the registration by sending to each of them a printed reproduction, or, if wanting, a description of the mark in the French language.

First. The date of the registration at the International Bureau.

Second. The serial number of the mark.

Third. The name and address of the applicant.

Fourth. The products of articles to which the mark is applied.

Fifth. The country of origin of the mark, together with its date of registration and its serial number in that country.

In the case before mentioned in article 2, letter C, notification shall also be accompanied by one of its copies of the reproduction of the mark in color.

### ARTICLE 5.

The International Bureau shall provide for the publication of the mark, which shall be made in a supplement to its journal, and shall consist in the reproduction of the mark, or of the description of it in the French language, together with the statements mentioned in article 4, paragraph 2.

At the beginning of each year, the International Bureau shall publish a table where there shall be stated in alphabetical order, and by

contracting States, the names of the owners of the marks which have been published during the preceding year.

Each Government shall receive gratuitously from the International Bureau as many copies as it shall ask for of the supplement containing the publications relative to international registration.

#### ARTICLE 6.

The statement required to be made to the International Bureau under article 5 of the agreement (refusal of protection to the mark in a country) shall be forwarded by it without delay to the Government of the country of origin and to the owner of the mark.

#### ARTICLE 7.

Subsequent changes in the ownership of a mark of which the International Bureau has been notified under article 9 of the Agreement shall be entered on the register of the International Bureau. The latter shall send notice of these to the contracting Governments and publish them in its journal.

#### ARTICLE 8.

Six months before the expiration of the twenty years' protection the International Bureau shall give official notice thereof to the Government of the country of origin and to the owner of the mark.

The formalities to be complied with for the renewal of the International registration shall be the same as in case of an original registration, except that it will not be necessary to furnish an electrotype.

#### ARTICLE 9.

At the beginning of each year the International Bureau shall prepare a statement of the expenses of all kinds which have been incurred by it during the preceding year in the international registration of marks. The amount of these expenses shall be deducted from the total sum received from the Governments as fees for the International registration, and the excess of receipts shall be divided equally between the contracting States.

#### ARTICLE 10.

The collective notification required under article 11 of the agreement shall contain the same statements as the notification provided for by article 4 of these rules.

#### ARTICLE 11.

The present rules shall go into operation from the day on which the Agreement of April 14, 1891, is put in force.

The contracting States may always adopt, by agreement, in accordance with the provisions of article 10 of the said Agreement, such modifications as may seem necessary to them.

## SECTION 6.

## REPORT OF THE INTERNATIONAL BUREAU ON THE INTERNATIONAL REGISTRATION OF TRADEMARKS, FOR THE YEARS 1893-1897, INCLUDING FORMS USED IN INTERNATIONAL REGISTRATION.

[Translated for this report by Mr. Greeley.]

## INTRODUCTORY STATEMENT.

Formerly marks of manufacture or commerce were required to be used by producers and traders as an assurance of their responsibility in case of fraud, and consequently as in effect a guaranty to the consumers against deception and adulteration. But such a system could not be carried out except through a government supervision of industries which disappeared at the close of the last century or early in the present.

In the régime of freedom which followed the previous restraint the authority which prevented the abuse of the mark by the proprietor disappeared, leaving the public to punish such abuse by simply refusing to receive inferior products. But at the same time the change left the field open to persons disposed to make use of the mark of another for purposes of unfair competition; in other words, to use it upon products generally inferior in order to dispose of them under the cover of the reputation acquired by articles of the same kind, but of good quality. This species of fraud causes material injury, especially to the producer, who is not only deprived of the opportunity to make sales, but finds the reputation of his mark disparaged and destroyed in the estimation of his customers. On the other hand the consumer is doubly deceived; first, as to the quality of that which he has bought, and secondly, as to the real value of the mark as to which he is misled. It is therefore of the greatest importance, both on moral and economic grounds, to give to producers and traders the means of preventing unlawful use of the marks which they employ to distinguish their goods. There should be no hesitation in considering and enacting laws providing for this protection which shall rest upon a principle very different from that of the old régime. The mark need no longer guarantee the public against the making of inferior goods by the manufacturer; it should become a means of protection of the latter against the unfair competition of his business rivals, and at the same time should permit the consumer to choose between products each bearing a mark of known reputation.

It is thus that the protection for marks of manufacture originated during the first half of the present century in nearly all civilized countries. But although many products are consumed in the country in which they are manufactured and are consequently within the control of one and the same law, there are others which find their market abroad and which pass under the jurisdiction of foreign laws. Though protected in the country of their origin, the marks placed on these products cease to be protected when they have passed beyond the frontier and may be imitated with impunity in the market where they are sold. Yet it is clear that each country has an interest in protecting the marks of foreigners, both because while protection may be refused in the interest of the producer who owns the mark, it is still necessary to take into account honest dealing, which recognizes no particular country and is clearly interfered with by the counterfeiting of marks, and



because it is a matter of public interest that the consumer in the country should be protected against the deceit practiced by those who counterfeit such marks. It takes some time to impress upon the public these very simple principles, but little by little we see the idea of International protection extending, both through the effect of domestic legislation which provides for the protection of foreigners, generally as a measure of reciprocity, and through the effect of treaty provisions which formally establish this reciprocity between two particular countries.

This important progress has too often been more or less neutralized by radical differences between the laws of different countries. It happens, for instance, that in certain countries all sorts of devices are considered registrable marks—signs, words, letters, numbers, representations, used alone, or even the form of the product or its wrapper. In other countries only arbitrary signs are registrable. It results that many marks protected in the former countries can not be in the latter. A means for remedying this difficulty has been found in stipulating in treaties that each of the contracting States should bind itself to accept as they are (*telle quelle*) the marks protected in the other State, except such as are clearly contrary to public order or to existing rights legitimately acquired. This system finds expression in article 6 of the International Convention of 1883, a convention which has for its purpose—

First. To constitute by a single agreement a vast territory in which the right to protection is assured for all the marks protected in any one of the contracting States.

Second. To give to these marks a status by which they are not subjected to the forfeiture which would otherwise result from the difference in the laws of the several States.

Third. To establish for the advantage of the applicant for registration a period of priority during which his successive applications for registration are considered as having been made on the date of the first application.

The progress attained in this matter between the years 1860 and 1883 has been very considerable. Yet it has been impossible to avoid certain material obstacles which place in the way of protection of marks, difficulties very often insurmountable. For instance, each of the several laws requires in the interest of the public that all marks to be protected shall be recorded on a special register after compliance with certain formalities of filing and publication and the payment of a specified fee. In order to obtain throughout the world a recognition of his right, the proprietor of a mark must register it in every country which will receive it. In order to do this it is necessary to ascertain in detail the requirements of each law, to prepare the necessary documents, such as petitions, descriptions, powers of attorney, etc., in the language of the particular country, to file the application, furnish the electrotypes blocks (*clichés*), pay the prescribed fees, etc. All this is sufficiently difficult to do in a neighboring country with which intercourse is frequent, and becomes almost impossible to do in distant countries. The applicant must in such cases have recourse to special agents, who effect the filing through their correspondents. But the employment of these intermediaries means great expense, as will be seen from the following table in which is shown, first, the official fees required in each of several countries for each

registration of a mark; and, second, the agents' fees charged by two agents—one in France and the other in England.

[In this table the value of the franc is roughly estimated at \$0.20. The correct value is \$0.193.]

Countries.	Government fee.	Agents' fees.	
		In France.	In England.
	<i>Francs.</i>	<i>Francs.</i>	<i>Francs.</i>
France <sup>1</sup> .....	9 (\$1.80)	45 (\$9.00)	120 (\$24.00)
Belgium .....	10 (2.00)	100 (20.00)	100 (20.00)
Brazil .....	17 (3.40)	225 (45.00)	200 (40.00)
Spain .....	25 (5.00)	150 (30.00)	200 (40.00)
Italy .....	50 (10.00)	150 (30.00)	150 (30.00)
Netherlands .....	20 (4.00)	200 (40.00)	150 (30.00)
Portugal .....	14 (2.80)	185 (37.00)	100 (20.00)
Switzerland .....	20 (4.00)	90 (18.00)	50 (10.00)
Total .....	165 (33.00)	1,125 (225.00)	1,070 (214.00)

<sup>1</sup> France does not require a registration fee, but it is necessary to pay for each registration the cost of recording the papers, a stamp tax, and 1 franc for drawing up the papers. These several expenses amount to about 9 francs.

In preparing this table there has been no intention to exaggerate the agents' fees. It is possible that the figures given represent, after deducting actual expenses, no more than reasonable remuneration. But it is none the less true that not a few manufacturers and traders are discouraged, perhaps by the difficulties and delays which are inevitable if agents are not employed, perhaps by the fees charged by them if they are employed. The effect will be understood by comparing the number of registrations by citizens or subjects and by foreigners in the principal importing and exporting countries. The following table shows in this matter some facts of interest:

Countries.	Year.	Marks of citizens or subjects.	Marks of foreigners.	Remarks.
Germany .....	1896	7,833	1,048	
Austria .....	1893	1,612	316	
Brazil .....	1891	111	58	
Spain .....	1891	437	77	
France .....	1895	7,415	521	Of which 132 marks were registered under the international registration.
Great Britain .....	1891	4,022	203	
Hungary .....	1895	371	2,452	Of which 2,083 were marks previously registered in Austria.
Italy .....	1891	100	111	
Norway .....	1891	33	49	
Netherlands .....	1891	185	112	
Portugal .....	1893	91	102	
Servia .....	1892	14	12	
Sweden .....	1891	113	51	
Switzerland .....	1892	447	161	

It is to be noted that the same mark registered simultaneously in a number of countries may figure more than once in this table.

Such results can not but suggest the idea of simplifying the procedure and of seeking means of facilitating and rendering less costly the international registration of marks. The congress assembled in Paris in 1878 expressed the following opinion on this subject:

It is desirable that the filing of applications for registration of marks should be effected simultaneously at the local registry office and at the consulates of the different foreign countries.

Agreeing with this opinion, the Belgian legislature the following year authorized the Government to permit, under such conditions as



might be determined, the filing of applications and the payment of fees at Belgian consulates in foreign countries. (Law of April, 1879, art. 19, par. 2.) This example afforded, as is evident, but a partial and incomplete solution of the question. It seemed, moreover, to involve so much difficulty that an eminent German jurist, Professor Kohler, expressed the view in 1884 that, while desirable, a solution of the question was far from being realized. Nevertheless, it was at that time much nearer successful solution than Professor Kohler imagined. The congress of 1878, which was animated by a remarkably progressive spirit, adopted a second expression of opinion in the following language:

The congress expresses the opinion that the formality of registration of trademarks should be placed under such international control that it shall be sufficient for the owner of a mark by registering it in a single State to secure protection therefor in all the other contracting States.

This proposition was met by administrative and judicial difficulties which were almost insurmountable. It was not then possible for marks to be admitted to registration as originally registered (*telle quelle*), but the opinion had none the less the merit of advancing a new principle of great importance.

In 1878 there was no union of States under the control of one and the same international regulation. But by the creation in 1883 of the industrial Union the situation was wholly changed and the idea expressed by the Congress of 1878 appeared at once under a new and more precise form. At the conference of the Union in Rome in 1886 the Swiss delegates presented a scheme for the international registration of marks through the central bureau of the Union at Berne, a registration which would have the effect of enlarging by a simple and inexpensive arrangement the extent of the territory within which protection would be accorded to the marks under consideration. The Italian Government, charged with preparing the conference, studied the plan very thoroughly, amended it to advantage, and supported it vigorously. The delegates of the several States understood fully the importance of the plan and realized that it was a decided step in advance and a development of benefit to the Union; but as it involved a proposition entirely new which the governments which they represented had not had time to consider, they did not discuss the matter exhaustively and contented themselves with adopting, at the session of May 8, the following resolution:

The conference considering that the arrangement prepared by Switzerland and amended by Italy merits profound study on the part of the several States of the union, refers the matter to the next conference.

The matter was thus seriously taken up and did not fail to be studied in all its details. The idea was naturally received with much favor, and the general opinion was very clearly expressed in the following resolution almost unanimously adopted by the Congress of Industrial Property, assembled in Paris in 1889:

It is desirable that an international regulation be established in respect to trademarks of such a character that a mark, registered in a country which is a party to the International Union, may be protected in all the contracting States by means of the international bureau of the union.

In the following year the second of the periodical conferences of the Union assembled at Madrid. In the interval the Swiss Govern-



ment had carefully considered and revised its proposed agreement. It was presented at the conference in a form much more complete and definite. Further than this, it had been submitted in advance to the preliminary study of the different Governments of the Union. It was at the conference discussed in its details, modified on some points, and finally adopted by nearly all of the delegations attending the conference. Submitted for acceptance to sixteen of the Governments of the Union, it was agreed to by but nine of them, who signed the agreement April 14, 1891, but of these five only finally ratified the agreement in June, 1892. These were Belgium, Spain, France, Switzerland, and Tunis. Since that date Brazil, Italy, the Netherlands, and Portugal have ratified it, so that there are now nine members of the Union for the international registration of trade-marks.

This Union includes to-day a population of 182,000,000 souls; the aggregate value of its commerce is estimated by statisticians at about 22,000,000,000 francs (about \$4,400,000,000), of which 12,000,000,000 (about \$2,400,000,000) are imports and 10,000,000,000 (about \$2,000,000,000) are exports. This represents an area of protection and a grand total of interests protected sufficiently imposing, especially as among the States which belong to this Union are some in which manufacturing is carried on very extensively.

#### INTERNATIONAL REGISTRATION ORGANIZATION.

The international registration requires a legal organization and a material installation. The first is regulated by the agreement of April 14, 1891, in the following manner:

The formality of international registration does not secure for the registrant any special or new right, but only the protection that would be given him by registration simultaneously effected in the several contracting States. But this protection is secured by the simple means of one single registration. It follows that the respective situations of different persons who are interested in the question of ownership of a particular mark so registered are not changed. They remain precisely the same as if the registration had been effected separately in the several States which are members of the union. Then results this important consequence, that proceedings necessary either to enforce the rights of the registrant or to protect the rights of others can be carried on in the same manner in each of the countries of the Union as if they concerned a mark registered only in the particular country. The rights of public authority are, so far as they are concerned, sufficiently cared for. Each country reserves an absolute right, within the limits prescribed by the international convention, to refuse protection of its laws to all marks contrary to good morals, to public order, or to prior existing rights of individuals. But such marks as are not obnoxious to any of these grounds of refusal should be protected as they are (*telle quelles*), even though they are not such as are within the requirements of the domestic law. This concession is necessary and inevitable under an international arrangement, for, without it, the difference in the legislative requirements would too often destroy the effect of whatever is done under conventional agreements.

The protection assured under the national registration combined with the international registration begins to run from the day the formal-

ties of the latter have been completed and continues during a period of twenty years; but it is understood that if the protection ceases to be in force in the country of origin it ends at the same time in all the rest of the Union. This is a natural consequence of the principle by virtue of which the registrant secures a peculiar right which, taking its origin in the country in which the mark is first registered, is extended under the convention to the entire territory of the union. All the modifications or other matters which affect the property right in the mark should have effect throughout the whole of this territory.

So far as the formalities of registration are concerned, they are under the arrangement made very simple. Whoever wishes to secure international registration for his trade-mark addresses himself to the Government of his country and only to that Government. He furnishes to his Government, together with his application, certain elementary statements (name, address, purpose of the mark); an electrotype (cliché) or a description of the mark written in French,<sup>1</sup> and pays to it two fees; one to cover the expense of home registration,<sup>2</sup> the other being an international fee. The latter has been fixed at 100 francs [about \$20.] The above-mentioned statements are written upon a special form.<sup>3</sup>

This form is sent in duplicate to the International Bureau, which enters the mark in the special register established under the regulations annexed to the Arrangement of Madrid, publishes it by means of the electrotype which it has received, and gives notice of the registration to the several Governments of the Union.<sup>4</sup> It also notifies them of the cancellations and changes of which it is officially informed. The registrants receive as a certificate proving the fact of registration one of the above-mentioned forms properly filled out and countersigned by the international bureau. Besides this, in the six months preceding the expiration of the period of protection of twenty years the International Bureau will notify the Government of the country of origin and the owner of the mark of the approaching termination of his protection, in order to facilitate renewal, which may be effected in the same way as the original registration. As the Bureau preserves the electrotypes of the registered marks it is not necessary to send a new one in case of renewal.

All these formalities were so carefully worked out in the preparation of the arrangement of 1891 that the service has proceeded with perfect regularity. No material modification has been suggested by the practical experience of more than four years and no complaint has been made concerning the practical operation of the service. This gives good reason to believe that the combination established in 1891 is satisfactory, not only in principle, but also in its practical operation.

#### RESULTS OF THE INTERNATIONAL REGISTRATION.

The operation of the international registration began January 1, 1893. Hardly completely understood at its beginning, the service

<sup>1</sup> It is proposed to do away with the permission to substitute a description for the electrotype.

<sup>2</sup> Each Government is free to fix the amount of this fee. It is, in Spain, 25 pesetas; in France, 25 francs (\$5); in Italy, 60 lire (\$20); in the Netherlands, 5 florins; in Switzerland, 5 francs (\$1), and in Tunis, 1 franc (\$0.20). In Belgium, there is no fee.

<sup>3</sup> This is furnished to the several Governments by the International Bureau.

<sup>4</sup> Specimens of these forms used by the International Bureau are given herewith. See page 40.



could naturally show but small results for the first few months. Besides, many of the countries which are now members of the Union had not then ratified the arrangement, and others had not at first arranged the details of the procedure necessary for receiving applications for international registration. The number of registrations effected during the year 1893 was for these several reasons only 76. But during that year a full publication of the matter was arranged for by the International Bureau, with the assistance of many of the Governments of the Union, for the purpose of informing the public of this new means of protection. The result was that in 1894 the number of marks registered was increased to 231. The year 1895 brought about the same number (229), but in 1896 the number of registrations reached 304. The following table shows, by countries and by years, the number of registrations effected during the first four years:

Country of origin.	Marks registered.					1897 (to Sept. 15).	Registration reported up to 1897.	Transfers.
	1893.	1894.	1895.	1896.	Total.			
Belgium .....	8	6	16	16	46	14	.....	.....
Brazil .....	.....	.....	.....	.....	.....	.....	.....	.....
Spain .....	.....	7	2	.....	9	.....	42	.....
France .....	26	96	99	145	366	194	.....	.....
Italy .....	.....	.....	6	4	10	2	.....	.....
Netherlands .....	10	77	60	69	216	40	13	4
Dutch Indies .....	.....	.....	.....	.....	.....	.....	4	.....
Portugal .....	.....	.....	.....	.....	.....	.....	.....	.....
Switzerland .....	31	45	46	70	192	54	8	15
Tunis .....	1	.....	.....	.....	.....	1	.....	.....
Total .....	76	231	229	304	1 840	304	67	19

<sup>1</sup> The total number of registrations up to October 31, 1898, is 1,645.

These figures are not large, but they are not unsatisfactory, if it is considered that international registration is of recent creation, that it applies as yet to but a small number of countries, of which but few have a very active export trade, and that it is not yet as well known to the public as it will be in the future.

In this connection it should be said that a number of Governments have taken steps to extend among manufacturers and traders a knowledge of the international registration. They have sent circular letters to chambers of commerce, inserted notices in official journals, circulated the publication of the International Bureau—the *Marques Internationales*—and distributed the notices prepared for general circulation by the bureau in the different languages of the States of the Union. All this has produced good results; but it takes a long time for an institution so new and unusual to become thoroughly known and be made of use generally. It is necessary also to remember that, intended to meet special requirements, the realization of its importance will always be limited by these requirements.

#### RECEIPTS AND EXPENDITURES OF THE REGISTRATION OFFICE.

The statement of receipts of the international registration shows two items of importance which differ widely in amount. The first is made up of the fees prescribed by the Arrangement, which amounts to 100 francs (\$20) for each mark registered. The second item comprises certain small amounts received from the sale of a certain number of copies of the publication *Les Marques Internationales*, in which are



printed all the marks registered by the bureau. The expenses include in the first place the special items of expense directly incurred for the registration service. Besides this, the International Bureau, intrusted with this service, charges against it a certain proportion of the general expenses, as is reasonable, since it is necessarily the most important of its general expenses. By reason of this combination the international registration costs relatively little and shows an excess of receipts, which, divided among the contracting States, compensates them to a considerable extent for the loss which results from the substitution of the single registration for the separate registration in each country. The following table shows the receipts and expenses for the years 1893-1896:

## EXPENDITURES.

[In francs. Franc = \$0.193.]

Year.	Marks registered.	Salaries.	Rent and supplies.	Printing.	Miscellaneous.	Total.	Average per mark.
1893.....	76	3,450	1,726.90	2,155.75	203.45	7,536.10	99.16
1894.....	231	4,880	852.10	3,563.85	401.40	9,697.35	41.98
1895.....	229	4,600	971.80	3,324.55	424.12	9,320.47	40.70
1896.....	304	5,110	930.00	4,156.80	394.95	10,591.75	34.84

## RECEIPTS.

Year.	Marks registered.	International fees.	Journal.	Miscellaneous.	Total.	Per mark.	Returned to each Government.
1893.....	76	7,600	200.00	-----	7,800.00	102.63	-----
1894.....	231	23,100	177.00	0.40	23,277.40	100.77	1,900
1895.....	229	22,900	204.90	4.00	23,108.90	100.91	1,700
1896.....	304	30,400	114.55	5.00	30,519.55	100.39	2,400

The inquiry has been frequently made of the International Bureau whether in case of the simultaneous application for registration of a number of marks there could not be some reduction of the fee. As the arrangement expressly prescribes the fee of 100 francs (\$20) for each mark registered, the response has been in the negative. It may be well to consider whether, in the interest of commerce and in accordance with the spirit of the Arrangement, it is not expedient to permit a reduction of the fees when a number of marks are presented for registry by the same owner. This would perhaps have the effect of causing those who use a number of marks to decide to register all of them, instead of making a selection which might subsequently prove to have been unwise. There is no way of determining what other effect would result from this change. If such a plan had been in force during the year 1896, it would have been to the advantage of 42 registrants and affected 105 marks, about 35 per cent of all the marks registered that year. And if, for example, the reduction had been 50 per cent upon all marks except the first one presented, the receipts for the year would have been reduced for the year 1896 by 5,250 francs. These are the only facts that can be presented on this point. It is in other respects to be considered with reference to the actual condition of affairs. It can not be stated certainly what effect this would have upon the different financial arrangements. It is generally true that when in an arrangement of this kind there is a reduction of fees, it results in a corresponding increase in the use made of it by the public.

It is quite possible that the sacrifice of the fees in case of a number of registrations would be balanced by increase in the number of registrations. From another point of view, there can be no question that a change of this kind is fully in accord with the spirit of the Arrangement, the main purpose of which is to facilitate international protection of marks against unlawful use. And as an increase in the number of marks registered tends toward this result, it seems that then there is every reason for securing this increase, even though it is secured by a diminution of receipts.

#### CLASSIFICATION OF INTERNATIONAL MARKS.

The number of marks already registered is so large as to render necessary, in order to facilitate searches, a systematic classification. All the important Governments have arranged the classification of marks registered by them with this purpose in view. The generally accepted basis of the classification is the nature of the article of merchandise on which the mark is placed. But the subdivision of products under the different classes is not everywhere the same. There are in practical use three distinct plans. Under the first, products are arranged in a systematic order—that is, by principal classes according to their character or their purpose; under the second, the alphabetical arrangement is followed; under the third, a practical order is followed—that is, all those which are manufactured or sold in the same line of business are grouped in the same class.<sup>1</sup>

In establishing the classification of international marks, a careful preliminary study has been made of the classification followed in practice by the Governments of the principal countries. It has been decided to adopt an arrangement of main classes which rests on this broad plan—to arrange in a progressive order: (1) Raw materials or those only partly manufactured; (2) machines and instruments which are used to work such materials or to transport them; (3) materials used for building purposes; (4) furniture; (5) fabrics and clothing and accessories; (6) fancy goods; (7) articles of food; (8) articles pertaining to education and the liberal arts. The field of human activity being thus covered, it remains to place in each category the articles of manufacture or use which belong under it, by making the necessary number of classes to facilitate the classification of marks and the search, without unnecessary classes. There have been established thus nine main subclasses, as follows:

- I. Raw materials, agricultural products, 7 classes.
- II. Partly manufactured materials, 8 classes.
- III. Tools, machinery, carriages, 13 classes.
- IV. Construction, 7 classes.
- V. Furniture and household articles, 8 classes.
- VI. Thread, fabrics, carpets, hangings, clothing, and accessories, 12 classes.
- VII. Fancy goods, 5 classes.
- VIII. Foods, 11 classes.
- IX. Education, sciences, fine arts, and miscellaneous, 9 classes.

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<sup>1</sup> It is to be noted that in some countries the registration determines the class—that is, the amount of fee paid is the basis of classification. So far as international registration is concerned, there is no idea of introducing such a restriction. On the contrary, the owners of marks ought to be free to cover all of the field that they find it necessary. The international classification has only this purpose, and this must be clearly understood, to offer to those interested a simple and prompt means of knowing where they stand among the constantly increasing number of marks.

In all, 80 classes, which should cover all known products, the eightieth (miscellaneous) being reserved for any unusual articles which can not be otherwise classified. They include in condensed form all the subjects grouped in the classification adopted in the principal industrial countries.

By means of this classification we have endeavored to secure these two essential purposes—first, to facilitate searches in the collection of registered marks; second, to render it possible, so far as may be, for each applicant for registration to choose the class which corresponds best with the requirements of his manufacture or trade. In the great majority of cases the statements furnished by the applicants in filing their marks are within the limits of a single class and in general are even more restricted. We have completed the classification by means of an alphabetical list of products, with reference to the class to which each belongs, so that searches are made easy.

MOREL, *Director.*

BERNE, *September, 1897.*

NOTE.—We reproduce hereafter the forms used in international registration. All these forms are furnished by the national Governments or by the Bureau itself, according to the case, and not by the applicant.



*Forms used in the international registration of trademarks.*

[Translated for this report by Mr. Greeley.]

I.

INTERNATIONAL REGISTRATION OF TRADEMARKS.

APPLICATION FOR REGISTRATION.

1ST. COUNTRY OF ORIGIN OF THE MARK.

Switzerland.

(Place where the mark  
should be pasted or af-  
fixed.)



2ND. OWNER OF THE MARK.

Name: **Mermod Brothers.**

Business: **Manufacturers.**

Address: **St. Croix.**

3RD. USE OF THE MARK.

Statement of products: **Music Boxes and Parts of Music Boxes.**

4TH. REGISTRATION IN THE COUNTRY OF ORIGIN.

Serial number: **8260.** Date: **April 9, 1896.**

The undersigned Government certifies that the above mark has been duly registered in **Switzerland**, and that the statements relative thereto under numbers 2 to 4 agree with those of the national register of marks.

It requests the entry of this mark in the International register.

**Berne, January 5, 1897.**

Stamp of  
the Swiss  
Government.

*Federal Bureau of Industrial Property.*

(Signed) **Haller,**

*Director.*

The several conditions on the back of this form having been complied with on this date, the mark has been entered in the International Register as No. 842.

**BERNE, January 6, 1897.**

Stamp of the  
International  
Bureau.

*International Bureau of Industrial Property.*

(Signed) **MOREL,**

*Director.*

[REVERSE OF PRECEDING FORM.]

**CONDITIONS OF REGISTRATION IN THE INTERNATIONAL BUREAU.**

Applications for registration filed by the Governments of the contracting States must, in order to be regular, be filed in duplicate and be accompanied by—

1. An electrotype of the mark (dimensions: Minimum, 15 mm.; maximum, 10 cm., in length and width; height, 24 mm.).
2. An order for 100 francs, the international fee.

*Information respecting the international registration of trademarks.*

(International agreement of April 14, 1891.)

International registration is effected through the Government of the country of origin. (Art. 1 of the arrangement.)

It assures legal protection to marks in the countries which have adhered to the international arrangement of April 14, 1891, as well as in those which adhere hereafter. (Arts. 1 to 11.)

Within a year from the notice by which the international bureau announces the registration of a mark, the Governments which are authorized by their laws to do so may declare that protection can not be accorded to the mark in with their territory. This declaration is transmitted by the international bureau to the Government of the country of origin and to the owner of the mark, who has the same recourse as if the mark had been filed directly in the country in which protection is refused. (Art. 5.)

The protection under international registration is for 20 years and may be renewed indefinitely by complying with the requirements prescribed for the original application. At the same time, the international protection depends upon the continued existence of the right to protection in the country of origin of the mark, and suspension of this right carries with it, *ipso facto*, suspension of international protection. (Art. 6.)

**TERRITORIAL EXTENT OF THE PROTECTION AT THE DATE OF THE REGISTRATION OF THE MARK WHICH IS THE SUBJECT OF THE PRESENT CERTIFICATE.**

At this date the arrangement of April 14, 1891, concerning the international registration of trade-marks is effective in the following countries, viz: Belgium, Brazil, Spain (together with Cuba, Porto Rico, and the Philippines), France, with Algeria and colonies; Martinique, Guadeloupe and dependencies, Réunion and dependency (St. Marie, of Madagascar), Cochin China, St. Pierre and Miquelon, Guiana, Senegal and dependencies, The Ivory Coast, Dahomey and dependencies, French Guinea, French Congo, Mayotte, Nossi-Bé, French establishments in India (Pondichery, Chandernagor, Karikal, Mahé, Yanaon, etc.), New Caledonia and dependencies, French establishments in Oceanica (Tahiti and dependencies), Obock and Madagascar, Italy, Netherlands (with the Dutch Indies, Surinam and Curaçao), Portugal (with the Azores and Madeira), Switzerland, and Tunis.

## II.

## INTERNATIONAL BUREAU OF INDUSTRIAL PROPERTY.

## INTERNATIONAL REGISTRATION OF TRADEMARKS.

No. 312.

3 enclosures.

## ACKNOWLEDGMENT OF THE RECEIPT OF APPLICATIONS FOR REGISTRATION.

Received of the special office for Industrial Property of Switzerland three applications for registration (in duplicate) with electrotypes (clichés) and the sum of 300 francs, the amount of the international fees at the rate of 100 francs for each mark.

National registration Nos. 8260 8416/17.

International registration No. 842 to 844.

A specimen of each of the applications for registration bearing the stamp and signatures of the undersigned bureau, accompanies the present acknowledgment.

*International Bureau of Industrial Property.*

(Signed) MOREL,

*Director.*

BERNE, January 6, 1897.

INTERNATIONAL BUREAU OF  
INDUSTRIAL PROPERTY.INTERNATIONAL REGISTRATION  
OF TRADE-MARKS.

Notification:

No. 178.

Enclosures:

8 copies of marks.

1 notice of transfer.

1 notice of cancellation.

## III.

## NOTIFICATION

ADDRESSED TO THE

SPECIAL OFFICE FOR INDUSTRIAL PROPERTY OF  
THE STATES ADHERING TO THE INTERNA-  
TIONAL ARRANGEMENT OF APRIL 14, 1891.

The Bureau has registered since the last notification, sent on January 5:

8 marks, No. 842 to 849.

1 transfer, No. 19.

1 cancellation, No. 2.

It notifies the Governments of the contracting States of the above, sending them, in accordance with the custom, the documents relating thereto.

BERNE, January 12, 1897.

*International Bureau of Industrial Property.*

(Signed) MOREL,

*Director.*



## IV.

## INTERNATIONAL BUREAU OF INDUSTRIAL PROPERTY.

## INTERNATIONAL REGISTRATION OF TRADEMARKS.

No. 842.

Jan. 6, 1897.

*MERMOD BROTHERS, MANUFACTURERS, ST. CROIX, SWITZERLAND.*

(The print reproduced in Form No. 1 is also placed here.)

**MUSIC BOXES AND PARTS OF MUSIC BOXES.**

The above mark has been registered in **Switzerland, April 9, 1896**, as No. **8260**.

*Changes since registration.*

Dates—						Nature of the change.
Of the notice from the International Bureau.			Of the publication by the International Bureau.			

## V.

## INTERNATIONAL BUREAU OF INDUSTRIAL PROPERTY.

## INTERNATIONAL REGISTRATION OF TRADE-MARKS.

Mark No. 293.

Notification No. 19.

**TRANSFER OF MARK.**

It appears from a communication from the Netherlands Government, under date of January 4, 1897, that the international mark No. **293**, registered in the name of **W. H. van Hasselt**, at **Rotterdam**, has been transferred to the **Vereenigde Zeep-fabrieken (Société Anonyme)** at **Rotterdam**, according to the entry in the register of the Netherlands Government on **January 12, 1897**.

## VI.

## INTERNATIONAL BUREAU OF INDUSTRIAL PROPERTY.

## INTERNATIONAL REGISTRATION OF TRADE-MARKS.

Mark No. 532.

Notification No. 2.

**CANCELLATION OF MARK.**

It appears from a communication from the French Government under date of January 8, 1897, that the international mark No. **532** registered in the International Bureau **September 15, 1895**, in the name of **Ed. Vernet of Rouen**, was canceled under date of **January 3, 1897**.

(Communicated to the Governments January 12, 1897.)

INTERNATIONAL BUREAU OF  
INDUSTRIAL PROPERTY.

## VII.

INTERNATIONAL REGISTRATION  
OF TRADE-MARKS.

## NOTICE OF REFUSAL OF PROTECTION.

BERNE, January 25, 1897.

No. 34.

To the Bureau of Industrial Property, Brussels, and  
to Messrs. X. & Co., at V.:

Enclosure.

Copy of mark.

*Article 5 of the arrangement of  
April 14, 1891:*

In the countries in which such action is authorized by law the Governments to which the International Bureau has given notice of the registration of the mark shall have the right to declare that protection can not be accorded to that mark in that country. They must exercise this right within a year from the receipt of notice under article 3.

Such declaration transmitted to the International Bureau will be sent by them without delay to the Government of the country of origin, and to the owner of the mark. The persons interested shall have the same opportunity for recourse that they would have if the mark had been filed directly in the country where protection is refused.

TAKE NOTICE.

It appears from a communication received from the special service of industrial property of Spain that, in that country, legal protection can not be accorded to the following mark, registered :

In Belgium :	In the bureau international :
May 1, 1896, No. 000	Sept. 1, 1896, No. 000
----- " -----	----- " -----
----- " -----	----- " -----
----- " -----	----- " -----

Herewith is a copy of this mark.

The reasons for refusal are given below.

In sending this communication to the Government of the country of origin and to the owner of the mark, the undersigned bureau calls attention to article 5 of the arrangement of April 14, 1891, the substance of which is found in the margin.

The refusal will be considered final by the international bureau until it has been notified that appeal has been granted.

*International Bureau of Industrial Property,*

(Signed) MOREL,

*Director.*

## THE REASONS FOR REFUSAL OF PROTECTION:

[Extract from the letter from the Government of Spain.]

Mark refused because of the registration of an identical mark for the same purpose under date of June 4, 1875, No. ...., in favor of B. and Co., at Z.....

## VIII.

## INTERNATIONAL BUREAU OF INDUSTRIAL PROPERTY.

## INTERNATIONAL REGISTRATION OF TRADE-MARKS.

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MONTHLY REPORT No. 49.

The international bureau addressed to the Government of Belgium, January, 1897:

3 certificates of registration      No. 846 and 856/7.

4 notices of registration      No. 177 to 180.

1    "      of refusal of protection No. 34.

2    "      of assignment of mark No. 19.

1    "      of cancellation of mark No. 2.

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The undersigned Government acknowledges the receipt of the documents.

BRUSSELS, .....

(Signed) A. AMELIN,  
*Director.*

Stamp of the  
Belgian  
Administration.



## CHAPTER III.

### PROTOCOLS ADOPTED AT THE BRUSSELS CONFERENCE OF 1897.

#### SECTION 1.

##### FIRST FINAL PROTOCOL TO CONVENTION OF PARIS, MARCH 20, 1883.

*International Union for the Protection of Industrial Property.*

*Union Internationale pour la Protection de la Propriété Industrielle.*

##### FIRST FINAL PROTOCOL.

##### PREMIER PROTOCOL FINAL.

The International Conference of the Union for the Protection of Industrial Property convened at Brussels, December 1, 1897, submits to the Governments of the States of the union the following project:

La Conférence Intertionale de l'Union pour la protection de la propriété industrielle, convoquée à Bruxelles le 1<sup>er</sup> décembre, 1897, soumet aux Gouvernements des Etats de l'Union le projet dont la teneur suit:

*Additional act to the convention of March 20, 1883, concluded between (enumeration of the contracting States).*

*Acte additionnel à la convention du 20 mars, 1883, conclu entre (énumération des Etats contractants).*

The undersigned, duly authorized by their respective Governments, have by common consent and under reserve of ratification agreed as follows:

Les soussignés, dûment autorisés par leurs Gouvernements respectifs, ont, d'un commun accord, et sous réserve de ratification, arrêté ce qui suit:

Article 3 of the convention shall be as follows:

L'article 3 de la convention aura la teneur suivante:

"ART. 3. Are assimilated to the subjects or citizens of the contracting States, the subjects or citizens of States not forming part of the union, who are domiciled or have bona fide<sup>1</sup> industrial or commercial establishments upon the territory of one of the States of the union."

"ART. 3. Sont assimilés aux sujets ou citoyens des Etats contractants les sujets ou citoyens des Etats ne faisant pas partie de l'union, qui sont domiciliés ou ont des établissements industriels ou commerciaux effectifs et sérieux sur le territoire de l'un des Etats de l'union."

Article 4 shall be as follows:

L'article 4 aura la teneur suivante:

"ART. 4. Anyone who shall have regularly deposited an application for a patent of invention of an industrial model or design of a trade or commercial mark in one of the contracting States shall enjoy for the purpose of making the deposit in the other States, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

"ART. 4. Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des Etats contractants, jouira, pour effectuer le dépôt dans les autres Etats, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

"In consequence, the deposit subsequently made in one of the other States of the Union before the expiration of these periods can not be invalidated by acts performed in the interval, especially by another deposit, by the publication of the invention or its working,<sup>2</sup> by the sale of copies of the design or model, by the employment of the mark.

"En conséquence, le dépôt ultérieurement opéré dans l'un des autres Etats de l'Union, avant l'expiration de ces délais, ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

<sup>1</sup> "Bona fide" inserted by amendment. <sup>2</sup> By a third party (par un tiers) omitted.

"The periods of priority above mentioned shall be six months for patents of invention and three months for designs or industrial models, as well as for trade or commercial marks. They shall be augmented by one month for countries beyond the seas."

There is inserted in the convention an article 4 bis, as follows:

"ART. 4 bis. Patents applied for in the different contracting States by persons admitted to the benefit of the convention under the terms of articles 2 and 3 shall be independent of the patents obtained for the same invention in the other States adhering or not to the Union.

"This provision shall apply to patents existing at the time of its going into effect.

"The same rule applies in the case of adhesion of new States as to patents already existing either in the Union or in the new adhering State at the time of the adhesion."

There is added to article 9 two paragraphs, as follows:

"In the States whose legislation does not admit of seizure on importation, such seizure may be replaced by the prohibition of importation.

"The authorities shall not be required to effect seizure in case of goods in transit."

Article 10 shall be as follows:

"ART. 10. The provisions of the preceding article shall be applicable to every product bearing falsely as indication of origin the name of a stated locality when this indication shall be joined to a fictitious commercial name or a name borrowed with fraudulent intention.

"Is reputed interested party every producer,<sup>1</sup> manufacturer, or trader engaged in the production, the manufacture, or the sale of this product when established either in the locality falsely indicated as place of export, or in the region where said locality is situated."

Article 11 shall be as follows:

"ART. 11. The high contracting parties shall accord conformably to the legislation of each country<sup>2</sup> a temporary protection to patentable inventions, to industrial designs or models, as well as to trade-marks, for the productions which may figure at official or officially recognized international expositions organized upon the territory of one of them."

"Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer."

Il est inséré dans la convention un article 4 bis ainsi conçu:

"ART. 4 bis. Les brevets demandés dans les différents États contractants par des personnes admises au bénéfice de la Convention aux termes des articles 2 et 3, seront indépendants des brevets obtenus pour la même invention dans les autres États adhérents ou non à l'Union.

"Cette disposition s'appliquera aux brevets existants au moment de sa mise en vigueur.

"Il en sera de même, en cas d'accession de nouveaux États, pour les brevets existant de part et d'autre au moment de l'accession."

Il est ajouté à l'article 9 deux alinéas ainsi conçus:

"Dans les États dont la législation n'admet pas la saisie à l'importation, cette saisie pourra être remplacée par la prohibition d'importation.

"Les autorités ne seront pas tenues d'effectuer la saisie en cas de transit."

L'article 10 aura la teneur suivante:

"ART. 10. Les dispositions de l'article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

"Est réputé partie intéressée tout producteur, fabricant ou commerçant, engagé dans la production, la fabrication ou le commerce de ce produit, et établi soit dans la localité faussement indiquée comme lieu de provenance, soit dans la région où cette localité est située."

L'article 11 aura la teneur suivante:

ART. 11. Les hautes parties contractantes accorderont, conformément à la législation de chaque pays, une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux expositions internationales officielles ou officiellement reconnues, organisées sur le territoire de l'une d'elles."

<sup>1</sup> "Producer" (producteur) "*the production*" (*la production*); "*either \* \* \* or in a region where said locality is situated,*" Soit . . . soit dans la région où cette localité est située inserted by amendment.

<sup>2</sup> "*Shall grant conformably to the legislation of each country*" (accorderont conformément à la législation de chaque pays), substituted in place of "*Agree to grant*" (s'engage à accorder), and "*organized upon the territory of one of them*" (organisées sur le territoire de l'une d'elles) is added.



Article 14 shall be as follows:

"ART. 14. The present convention shall be submitted to periodical revision for the purpose of introducing improvements calculated to perfect the system of the union.

"With this object conferences shall take place successively in one of the contracting States between the delegates of said States."

Article 16 shall be as follows:

"ART. 16. The States that have not taken part in the present convention shall be admitted to adhere to the same upon their application.

"This adhesion shall be notified through the diplomatic channel to the Government of the Swiss Confederation and by the latter to all the others.

"It shall convey of full right, accession to all the clauses, and admission to all the advantages stipulated by the present convention, and shall go into force a month after the sending of the notification given by the Swiss Government to the other Unionist States, unless a later date shall have been indicated by the adhering State."<sup>1</sup>

The present additional act shall have the same force and duration as the convention of March 20, 1883.

It shall be ratified and the ratifications thereof shall be exchanged at Brussels in the form adopted for this convention as soon as may be, and, at the latest, within a period of one year.

It shall go into effect three months after such exchange.

In witness whereof the undersigned have signed the present additional act.

Done at Brussels, the — of —, —.

The respective Governments are invited to sign the above project within six months; the signature and the exchange of ratifications shall take place in the manner designated in said additional act.

Done in one single copy at Brussels, December 14, 1897.

For Belgium: A. Nyssens, L. Capelle, Georges De Ro, J. Dubois.

For Brazil: F. Vieira Monteiro.

For Denmark: H. Holten Nielsen.

For Spain: El Marqs. De Bertemati, Eduardo Toda.

For the United States of America: Belamy Storer, Francis Forbes.

For France: Montholon, C. Nicolas, Michel Pelletier.

For Great Britain: Charles B. Stuart Wortley, H. G. Bergne, C. N. Dalton.

For Italy: R. Cantagalli, C. F. Gabba, S. Ottolenghi.

L'article 14 aura la teneur suivante:

"ART. 14. La présente convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'union.

"A cet effet, des conférences auront lieu successivement, dans l'un des États contractants, entre les délégués desdits États."

L'article 16 aura la teneur suivante:

"ART. 16. Les États qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

"Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération suisse, et par celui-ci à tous les autres.

"Elle emportera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention, et produira ses effets un mois après l'envoi de la notification faite par le Gouvernement suisse aux autres États unionistes, à moins qu'une date postérieure n'ait été indiquée par l'État adhérent."

Le présent Acte additionnel aura même valeur et durée que la Convention du 20 mars 1883.

Il sera ratifié, et les ratifications en seront échangées à Bruxelles, dans la forme adoptée pour cette Convention, aussitôt que faire se pourra, et au plus tard dans le délai d'une année.

Il entrera en vigueur trois mois après cet échange.

En foi de quoi les soussignés ont signé le présent Acte additionnel.

Fait à Bruxelles, le —, —, —.

Les Gouvernements respectifs sont invités à signer le projet ci-dessus dans un délai de six mois; la signature et l'échange des ratifications auront lieu de la manière consignée dans ledit Acte additionnel.

Fait en un seul exemplaire, à Bruxelles, le quatorze décembre 1897.

Pour la Belgique: A. Nyssens, L. Capelle, Georges De Ro, J. Dubois.

Pour le Brésil: F. Vieira Monteiro.

Pour le Danemark: H. Holten Nielsen.

Pour l'Espagne: El Marq<sup>e</sup> De Bertemati, Eduardo Toda.

Pour les États-Unis d'Amérique: Belamy Storer, Francis Forbes.

Pour la France: Montholon, C. Nicolas, Michel Pelletier.

Pour la Grande-Bretagne: Charles B. Stuart Wortley, H. G. Bergne, C. N. Dalton.

Pour l'Italie: R. Cantagalli, C. F. Gabba, S. Ottolenghi.

<sup>1</sup> And go into force, etc. (et produira ses effets, &c.).



For Norway: Chr. Hansson.  
 For The Netherlands: Snyder Van Wyssenkerke.  
 For Portugal: F. Quintella De Sampayo, Jayme De Sequier.  
 For Servia: Spassoye Radoitchitch.  
 For Sweden: Hugo E.-G. Hamilton.  
 For Switzerland: Alphonse Rivier, L. R. De Salis.  
 For Tunis: Montholon, Etienne Blade.

Pour la Norvège: Chr. Hansson.  
 Pour les Pays-Bas: Snyder Van Wyssenkerke.  
 Pour le Portugal: F. Quintella de Sampayo, Jayme de Séguier.  
 Pour la Serbie: Spassoyé Radoitchitch.  
 Pour la Suède: Hugo E.-G. Hamilton.  
 Pour la Suisse: Alphonse Rivier, L. R. de Salis.  
 Pour la Tunisie: Montholon, Étienne Bladé.

## SECTION 2.

### SECOND FINAL PROTOCOL TO AGREEMENT CONCLUDED AT MADRID APRIL 14, 1891, CONCERNING THE INTERNATIONAL REGISTRATION OF TRADEMARKS.

*International Union for the Protection of Industrial Property.*

*Union Internationale pour la Protection de la Propriété Industrielle.*

#### SECOND FINAL PROTOCOL.

#### DEUXIÈME PROTOCOLE FINAL.

The undersigned, representing States which have adhered to the Madrid agreement of April, 1891, concerning the international registration of trade-marks, assembled in conference at Brussels, December 1, 1897, submit to their respective Governments the following project:

*Additional act to the agreement of April 14, 1891, concerning the international registration of trade-marks, concluded between (enumeration of contracting States).*

The undersigned, duly authorized by their respective Governments, have by common consent and under reserve of ratification agreed as follows:

#### FIRST ARTICLE.

Article 2 of the agreement shall be as follows:

"ART. 2. Are assimilated to the subjects or citizens of the contracting States, the subjects or citizens of States which have not adhered to the present agreement, *who upon the territory of the restricted union constituted by the latter, fulfill the conditions of article 3 of the general convention.*"

Article 3 shall be as follows:

"ART. 3. The International Bureau shall immediately register the marks deposited in accordance with article first. It shall give notice of this registration to the contracting States. The registered marks shall be published in a supplement to the Journal of the International Bureau by means of a cut furnished by the depositor.

Les soussignés, représentants des États ayant adhéré à l'Arrangement de Madrid du 14 avril 1891 concernant l'enregistrement international des marques de fabrique ou de commerce, réunis en Conférence à Bruxelles le 1<sup>er</sup> décembre 1897, soumettent à leurs Gouvernements respectifs le projet dont la teneur suit:

*Acte additionnel à l'Arrangement du 14 avril 1891 concernant l'enregistrement international des marques de fabrique ou de commerce conclu entre (Énumération des États contractants).*

Les soussignés, dûment autorisés par leurs Gouvernements respectifs, ont, d'un commun accord, et sous réserve de ratification, arrêté ce qui suit:

#### ARTICLE PREMIER.

L'article 2 de l'Arrangement aura la teneur suivante:

"ART. 2. Sont assimilés aux sujets ou citoyens des États contractants les sujets ou citoyens des États n'ayant pas adhéré au présent Arrangement qui, sur le territoire de l'Union restreinte constituée par ce dernier, satisfont aux conditions établies par l'article 3 de la Convention générale."

L'article 3 aura la teneur suivante:

"ART. 3. Le Bureau international enregistrera immédiatement les marques déposées conformément à l'article 1<sup>er</sup>. Il notifiera cet enregistrement aux États contractants. Les marques enregistrées seront publiées dans un supplément au journal du Bureau international au moyen d'un cliché fourni par le déposant.

<sup>1</sup> NOTE.—Amendments and additions, both in words and sentences, are in italics.

*"If the depositor claim the color as a distinctive element of his mark he shall be required:*

*"1. To declare it, and to accompany his deposit by a description which shall make mention of the color.*

*"2. To join to his application copies in color of the said mark, which shall be annexed to the notices given by the international bureau. The number of these copies shall be fixed by the rules of procedure.*

"In view of the publicity to be given to the registered marks in the different States, each Government shall receive gratuitously from the international bureau such number of copies of said publication as it shall see fit to demand."

There is inserted in the agreement an article 4 *bis* as follows:

"ART. 4 BIS. Whenever a mark already deposited in one or more of the contracting States has been subsequently registered by the international bureau in the name of the same owner or of his assignee the international registration shall be considered as substituted in place of the prior national registrations without prejudice to the rights already acquired thereby."

Article 5 shall be as follows:

"ART. 5. In the countries where their legislation so authorizes, the Governments to which the international bureau shall give notice of the registration of a mark shall have power to declare that protection can not be given to such mark within their territory. Such objection shall not be made except under the conditions which, by virtue of the convention of 20th March, 1883, apply to a mark already deposited with the national registration.

"They shall exercise this right within the period provided by their national law, and at the latest within a year from the notice provided by Art. 3, indicating at the same time to the international bureau their reasons for refusal.

"The notice of the said declaration thus given to the international bureau shall be transmitted by it without delay to the Government of the country of origin and to the owner of the mark. The interested party shall have the same means of redress as if the mark had been deposited directly by him in the country where the protection is refused."

There is inserted in the agreement an article 5 *bis* as follows:

"ART. 5 BIS. The International Bureau shall deliver to anyone who shall demand it, under payment of a fee fixed by the rules of procedure, a copy of the entries on the register relating to any deposited mark."

"Si le déposant revendique la couleur à titre d'élément distinctif de sa marque, il sera tenu:

"1. De le déclarer, et d'accompagner son dépôt d'une description qui fera mention de la couleur;

"2. De joindre à sa demande des exemplaires de ladite marque en couleur, qui seront annexés aux notifications faites par le Bureau international. Le nombre de ces exemplaires sera fixé par la Règlement d'exécution.

"En vue de la publicité à donner, dans les États, aux marques enregistrées, chaque Administration recevra gratuitement du Bureau international le nombre d'exemplaires de la susdite publication qu'il lui plaira de demander."

Il est inséré dans l'Arrangement un article 4 *bis* ainsi conçu:

"ART. 4 BIS. Lorsqu'une marque, déjà déposée dans un ou plusieurs États contractants, a été postérieurement enregistrée par le Bureau international au nom du même titulaire ou de son ayant cause, l'enregistrement international sera considéré comme substitué aux enregistrements nationaux antérieurs, sans préjudice des droits acquis par le fait de ces derniers."

L'article 5 aura la teneur suivante:

"ART. 5. Dans les pays où leur législation les y autorise, les Administrations auxquelles le Bureau international notifiera l'enregistrement d'une marque auront la faculté de déclarer que la protection ne peut être accordée à cette marque sur leur territoire. Un tel refus ne pourra être opposé que dans les conditions qui s'appliqueraient, en vertu de la Convention du 20 mars 1883, à une marque déposée à l'enregistrement national.

"Elles devront exercer cette faculté dans le délai prévu par leur loi nationale, et, au plus tard, dans l'année de la notification prévue par l'article 3, en indiquant au Bureau international leurs motifs de refus.

"Ladite déclaration ainsi notifiée au Bureau international sera par lui transmise sans délai à l'Administration du pays d'origine et au propriétaire de la marque. L'intéressé aura les mêmes moyens de recours que si la marque avait été par lui directement déposée dans le pays où la protection est refusée."

Il est inséré dans l'Arrangement un article 5 *bis* ainsi conçu:

"ART. 5 BIS. Le Bureau international délivrera à toute personne qui en fera la demande, moyennant une taxe fixée par le Règlement, une copie des mentions inscrites dans le Registre relativement à une marque déterminée."



Article 8 shall be as follows:

"ART. 8. The government of the country of origin shall fix at its discretion and receive for its own profit a fee which it shall collect from the owner of the mark for which international registration is demanded.

"To such fee shall be added an international fee of 100 francs for the first mark and 50 francs for each of all other marks deposited at the same time by the same owner. The annual proceeds of these fees shall, under the supervision of the international bureau, be distributed equally between the contracting States, after deduction of the common expenses necessary to the execution of this agreement."

There is inserted an article, 9 bis, as follows:

"ART. 9 BIS. When a mark entered in the international register shall be assigned to a person established in a contracting State other than the country of origin of the mark, notice of the assignment shall be given to the international bureau by the government of said country of origin. The international bureau shall register the assignment, and after having received the assent of the government to which the new owner belongs shall give notice to the other governments and publish it in its journal.

"The present provision does not have the effect of modifying the laws of the contracting States, which prohibit the assignment of the mark without the simultaneous conveyance of the industrial or commercial establishment whose products it distinguishes.

"No assignment of a mark inscribed in the international register, made on account of a person not established in one of the contracting States, shall be registered."

## ARTICLE II.

The closing protocol, signed at the same time as the agreement of April 14, is suppressed.

The present additional act shall have the same force and duration as the agreement to which it relates.

It shall be ratified and the ratifications thereof shall be exchanged at Brussels in the form adopted by this agreement as soon as may be, and at the latest within the period of one year.

It shall go into effect three months after such exchange.

In witness whereof the undersigned have signed the present additional act.

Done at Brussels, the — of —, —.

The respective governments are invited to sign the above project within six

L'article 8 aura la teneur suivante:

"ART. 8. L'Administration du pays d'origine fixera à son gré, et percevra à son profit, une taxe qu'elle réclamera du propriétaire de la marque dont l'enregistrement international est demandé. A cette taxe s'ajoutera un émolument international de 100 francs pour la première marque, et de 50 francs pour chacune des marques suivantes, déposées en même temps par le même propriétaire. Le produit annuel de cette taxe sera réparti par parts égales les États contractants par les soins du Bureau international, après déduction des frais communs nécessités par l'exécution de cet Arrangement."

Il est inséré un article 9 bis conçu comme suit:

"ART. 9 BIS. Lorsqu'une marque inscrite dans le registre international sera transmise à une personne établie dans un État contractant autre que le pays d'origine de la marque, la transmission sera notifiée au Bureau international par l'Administration de ce même pays d'origine. Le Bureau international enregistrera la transmission et, après avoir reçu l'assentiment de l'Administration à laquelle ressortit le nouveau titulaire, il la notifiera aux autres Administrations et la publiera dans son journal.

"La présente disposition n'a point pour effet de modifier les législations des États contractants qui prohibent la transmission de la marque sans la cession simultanée de l'établissement industriel ou commercial dont elle distingue les produits.

"Nulle transmission de marque inscrite dans le registre international, faite au profit d'une personne non établie dans l'un des pays signataires, ne sera enregistrée."

## ARTICLE 2.

Le Protocole de clôture signé en même temps que l'Arrangement du 14 avril 1891 est supprimé.

Le présent Acte additionnel aura même valeur et durée que l'Arrangement auquel il se rapporte.

Il sera ratifié, et les ratifications en seront échangées à Bruxelles, dans la forme adoptée pour cet Arrangement, aussitôt que faire se pourra, et au plus tard dans le délai d'une année.

Il entrera en vigueur trois mois après cet échange.

En foi de quoi les soussignés ont signé le présent Acte additionnel.

Fait à Bruxelles, le — — —, —.

Les Gouvernements respectifs sont invités à signer le projet ci-dessus dans un



months; the signature and the exchange of ratifications shall take place in the manner designated in said additional act.

#### RULES OF PROCEDURE.

Modifications submitted to the approval of the contracting governments.

Insert in the regulations an article 6 bis, as follows:

"ART. 6, BIS. The fee provided by article 5 of the agreement for the copies or extracts from the register is fixed at 2 francs for each extract."

Modify article 7 as follows:

"ART. 7. The changes taking place in the ownership of a mark, and which shall have been the object of the notice provided by articles 9 and 9 bis of the agreement, shall be entered in the register of the international bureau. The latter shall give notice in its turn to the contracting governments and shall publish them in its journal, taking into account the special provisions of article 9 bis when the new owner is not established in the country of origin of the mark."

Modify the first paragraph of article 11 as follows:

"ART. 11. The present rules shall remain in force as long as the agreement to which they relate."

Done in one single copy at Brussels, December 14, 1897.

For Belgium: A. Nyssens, L. Capelle, Georges De Ro, J. Dubois.

For Brazil: F. Vieira Monteiro.

For Spain: El Marqs. De Bertemati, Eduardo Toda.

For France: Montholon, C. Nicholas, Michel Pelletier.

For Italy: R. Cantagalli, C. F. Gabba, S. Ottolenghi.

For The Netherlands: Snyder Van Wissenkerke.

For Portugal: F. Quintella De Sampayo, Jayme De Séguier.

For Switzerland: Alphonse Rivier, L. R. De Salis.

For Tunis: Montholon, Etienne Blade.

délai de six mois; la signature et l'échange des ratifications auront lieu de la manière consignée dans l'Acte additionnel.

#### RÈGLEMENT D'EXÉCUTION.

Modifications soumises à l'approbation des Administrations contractantes.

Insérer dans le Règlement un article 6 bis ainsi conçu.

"ART. 6, BIS. La taxe prévue par l'article 5 bis de l'Arrangement pour les copies ou extraits du registre est fixée à 2 francs par extrait."

Modifier l'article 7 en lui donnant la teneur suivante:

"ART. 7. Les changements survenus dans la propriété d'une marque, et qui auront fait l'objet de la notification prévue par les article 9 et 9 bis de l'Arrangement, seront consignés dans le registre du Bureau international. Ce dernier les notifiera à son tour aux Administrations contractantes et les publiera dans son journal, en tenant compte des dispositions spéciales de l'article 9 bis, quand le nouveau propriétaire ne sera pas établi dans le pays d'origine de la marque."

Modifier le premier alinéa de l'article 11 de la manière suivante:

"ART. 11. Le présent Règlement restera en vigueur aussi longtemps que l'Arrangement auquel il se rapporte."

Fait en un seul exemplaire, à Bruxelles, le quatorze décembre, 1897.

Pour la Belgique: A. Nyssens, L. Capelle, Georges de Ro, J. Dubois.

Pour le Brésil: F. Vieira Monteiro.

Pour l'Espagne: El marq<sup>s</sup> de Bertemati, Eduardo Toda.

Pour la France: Montholon, C. Nicholas, Michel Pelletier.

Pour l'Italie: R. Cantagalli, C. F. Gabba, S. Ottolenghi.

Pour les Pays-Bas: Snyder Van Wissenkerke.

Pour le Portugal: F. Quintella de Sampayo, Jayme de Séguier.

Pour la Suisse: Alphonse Rivier, L. R. de Salis.

Pour la Tunisie: Montholon, Etienne Bladé.

## CHAPTER IV.

### PROPOSITION FOR THE AMENDMENT OF THE CONVENTION CONCLUDED AT PARIS, MARCH 20, 1883, PRESENTED BY THE UNITED STATES TO THE BRUSSELS CONFERENCE OF 1897.

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Article 2 of the Convention, as it now stands, gives the right to the subjects or citizens of each of the contracting States to secure the same protection, so far as concerns patents for inventions, trade or commercial marks, and commercial names, in all the other States of the union that the respective laws thereof now, or may hereafter, accord the subjects or citizens, not only as regards the extent or duration of protection, but also as regards the fees for the issuance of the patent and for continuing the protection given by the patent in force during the period named therein, and also as regards the inventions which may be protected by patent.

In the United States the fees for the grant of a patent for an invention are but \$35, of which \$15 is required upon filing the application and \$20 prior to the issuance of the patent. The patent is granted for seventeen years, except in certain cases, and it continues in force for the full term for which it is granted without the payment of further fees.

In certain of the States of the union not only are fees required upon deposit of the application and issuance of the patent, but further fees in the form of annual taxes are required for the continuance of the protection given by the patent as issued, the patent lapsing if these taxes are not paid. The aggregate amount of these fees in some of the States of the union is many times the fees required by the United States. For instance, in Great Britain, as stated in the "*Tableau comparatif*, published in a recent number of *La Propriété Industrielle*, the fee payable on filing the complete specification is £4 sterling (say \$20). This pays for the continuance in force of the patent for four years. For the fifth year a tax of £5 (say \$25) is required; for the sixth year a tax of £6 (say \$30), and so on, increasing £1 each year. The aggregate amount of the fees for a patent of fourteen years is thus £99, or nearly \$500.

In France annual taxes of 100 francs (say \$25) are required, aggregating for a fifteen-year patent 1,500 francs (say \$300).

In Austria, under the law of January 11, 1897, the fee payable on the filing of the application is 10 florins (say \$4) and the annual taxes for a fifteen-year patent aggregate over 1,900 florins (say \$800).

It does not seem just that a subject or citizen of a foreign State should secure from the United States protection for his invention, trade or commercial mark for a less sum than is required of citizens of the United States for like protection by the State of which he is a subject or citizen, and it is believed that the convention should not restrict the United States from requiring, if it shall seem best to do so, that subjects or citizens of other States should pay for the grant and continuance of protection the same fees which are required for like protection by other States from citizens of the United States.

Further, it does not seem just that a greater protection to inventions than that which is extended by the State of which the inventor is a subject or citizen, or in which he is domiciled at the time of making his invention, should be extended by the United States. That, for instance, a subject or citizen of Austria (not yet, it is true, one of the contracting States) should be entitled to protection in the United States for the product of a chemical process, while in his own State he is entitled only to protection for a particular process for its manufacture and is not entitled to protection for the product, does not seem just, particularly as a citizen of the United States who has invented a product of a chemical process, for which he is entitled to protection in the United States, is not entitled to such protection in Austria as is now afforded the Austrian inventor in the United States.

So, too, with reference to Switzerland. The Swiss patent laws do not recognize as entitled to protection either a chemical process or the product of such process unless it is susceptible of being represented by a model, while the citizen of Switzerland is entitled to protection in the United States for chemical processes and products of chemical processes, as well as many other inventions which can not be represented by models.

Any State of the Union should be entitled to refuse, at its option, to subjects or citizens of another State the protection which is refused by that other State to its subjects or citizens.

For these reasons the United States Government proposes to amend article 2 by adding the following paragraphs:

*Provided*, That a subject or citizen of any one of the contracting States applying for a patent for invention, trade or commercial mark, or commercial name in another of the contracting States may, at the option of the latter State, be required to pay for the issuance and continuance in force of the patent applied for fees equal in amount to the fees required of a subject or citizen of the State in which the patent is applied for, for the issuance and continuance in force of a patent for invention, trade or commercial mark, or commercial name, in the State of which the applicant is a subject or citizen.

*Provided further*, That an invention not the subject of a patent in the country of origin may, at the option of another State of the Union, be refused protection in that State.

Country of origin shall be considered the country of which the inventor is a subject or citizen, or in which he is domiciled at the time of the first deposit of an application for an invention.

Article 4 of the convention is not suited to the wants of American inventors.

The amendment of section 4887 of the Revised Statutes of the United States approved March 3, 1897, which will take effect January 1, 1898, will eliminate from our law the feature of the dependence of the United States patent on prior patents for the same invention previously taken in foreign countries. This amendment, while removing one reason for the proposition of the United States at Madrid that the period of delay should begin at the date of the issue of the United States patent, namely, that the grant of a prior foreign patent would limit the latter to the term of the former, does not obviate another difficulty which springs from our system of preliminary examination.

In our system the papers deposited with the application for a patent, and forming part thereof, are: (1) An application therefor in writing to the Commissioner of Patents; (2) "a written description of the invention or discovery, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact



terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, an explanation of the principle thereof, and the best mode in which he (the inventor) has contemplated applying that principle so as to distinguish it from other inventions, and in which he (the inventor) shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery" (Revised Statutes, section 4888); (3) drawings "when the nature of the case admits of drawings." (Revised Statutes, section 4889.)

Specifications and drawings are submitted to the examination of skilled persons in the Patent Office, called examiners, who often find that the inventor has improperly described or misapprehended his invention and has claimed more than he had a right to claim as new. If it is found that the invention has been known or used by others in the United States, or has been patented or described in any printed publication in any country before his invention, the application is refused and no patent thereon issued. If, however, the claims of the application are merely broader than the invention and include therein matter which is shown by the prior state of the art to be old, then the applicant may amend his specification and claims so as to limit them to his actual invention, and this being done the patent is issued upon the amended specification and claims. Such amendments are always restrictive in their nature, and the applicant is never permitted to broaden his claim to cover an invention not within the description contained in the application as filed. It is found from the records of the Patent Office that of the applications for patents filed since the year 1880 nearly one-third were rejected for want of patentable novelty, the remaining two-thirds were found patentable, and in all but those in which the final fee was not paid within the time required by law patents were issued.

By amendment of the specification and claims forming a part of the application the inventor is enabled to separate the new from the old and to claim what he has in fact invented. It is this amended application which should be the subject of refileing in the different States of the Union under article 4. But as in certain cases the examination may not be completed for a considerable period of time, and the inventor may be desirous of immediately exploiting his invention in other countries of the Union or of avoiding the risk of intermediate publication or other acts which would vitiate his patent, he should be allowed to deposit his application in the several States of the Union with a description of his invention as filed in the country employing the preliminary examination, and afterwards to amend the same so as to make it conform to the patent issued on the first application.

In the case of an application filed in another country and afterwards in a country employing the preliminary examination under claim of priority, then the specification and claims there allowed should be taken as equivalent to the prior application for the purposes of article 4.

The United States Government therefore proposes to amend article 4 by adding the following paragraph:

The application for a patent of invention of an industrial model or design, or a trade-mark above mentioned, may be amended in the part describing or claiming the invention, model, or design, in conformity with the description and claim allowed and forming part of the patent issued in countries requiring a preliminary examination; but the description and claim shall not be construed to extend in any State of the Union greater protection to the invention than in the country of origin.

## CHAPTER V.

### REPORT OF THE UNITED STATES DELEGATES TO THE BRUSSELS CONFERENCE OF 1897.

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BRUSSELS, *December 15, 1897.*

SIR: We, the delegates from the United States to the Brussels Conference under the Convention for the Protection of Industrial Property, concluded at Paris March 20, 1883, respectfully report that we have attended and participated in all the meetings of the Conference which began on December 1 and adjourned December 14 to meet again after certain diplomatic correspondence shall have been concluded.

The conference was more largely attended than either of its predecessors held at Rome and Madrid. It was especially remarkable for the active part taken in its proceedings by States not yet adhering to the Union, viz, Austria-Hungary, Germany, Chile, Ecuador, Japan, Mexico, and Turkey.

Of the unionist States Belgium was represented by four delegates and a secretary, Brazil by one delegate, Denmark by one, France by three, Great Britain by three delegates, a technical adviser, and a secretary, Italy by three delegates, the Netherlands by one, Norway by one, Portugal by two, Servia by one, Spain by two, Sweden by one, Switzerland by two, Tunis by two (one of whom was the French minister to Belgium, who also appeared for France), making with ourselves thirty-one delegates.

Each country had but one vote, but the advantage of a number of delegates in committee and other work, often going on simultaneously, was apparent.

The nonunionist States were represented as follows: Austria-Hungary by two delegates, Germany by three, Chile by one, Ecuador by two, Japan by three, Mexico by one, Turkey by two.

The International Bureau was represented by M. Henri Morel, the director.

#### 1. PROPOSITION OF THE UNITED STATES TO AMEND ARTICLE 2 IN THE INTEREST OF RECIPROCITY AND SOLUTIONS PROPOSED BY OTHER MEMBERS OF THE CONFERENCE.

We learned at the very opening of the Conference that most, if not all, of the other States of the Union had been instructed to oppose the proposition of the United States to add a paragraph to article 2 allowing reciprocity as to fees, and also as to the subject-matter of patents. We therefore asked that the proposition be sent to the committee on patents, where there seemed to be a better opportunity of proper consideration than in the open sessions of the Conference. We found unanimous opposition to the proposition in the committee, which could not be removed by argument. The statement of "motives" given in



support of the additional paragraph—which show the lack of reciprocity in the matter of patent grants between the United States and the other nations of the Union—did not carry weight with the other delegates, because, as they said, there were other solutions of the difficulties pointed out in the “motives” which were not inconsistent with their understanding of the principle laid down in article 2, viz, that citizens of any State of the Union shall enjoy in every other State the same rights as citizens of the latter.

The solutions referred to were the requirements from both citizens and aliens in case of an application abroad for a patent for an invention prior to an application for a patent therefor in the United States.

(a) Of the payment of the same fees in the United States as required in the country (or one of the countries to be designated) where previously applied for.

(b) Of a limitation of the patent granted in the United States in such case to the same subject-matter as protected by patent in the country (or one of the countries to be designated) where previously applied for—e. g., if the laws of said country allow the grant of a patent for a process only and not for the product of the process—that then no patent shall be granted in the United States for the product, but only for the process.

(c) Of a condition in the patent granted in the United States in such case that it shall become null in case the invention is not worked in the United States or licenses are not granted thereunder as required by the laws of the country (or one of the countries to be designated) where previously applied for.

It was pointed out that it is not likely that our citizens will first apply for patents abroad, whereas it is most probable that those who reside in those States which enforce the laws against our citizens to which we object will first apply in such countries and come under the limitations imposed in the interests of reciprocity.

Such provisions are not new in our law. An example is found in the patent act approved March 3, 1897, which amended section 4887 of the Revised Statutes so as to limit the grant of patents to both citizens and aliens for inventions for which applications had been previously made in other countries. This statute was not objected to in the Conference because of any claim that it is not in full accord with article 3 of the Convention.

The committee, after the discussion which brought out the suggestions for the solution of our objection to the Convention because not reciprocal toward us, reported that—

The committee finds that the proposition of the Government of the United States is inspired by ideas which are in formal opposition to the terms of article 2 and the general spirit of the Convention. Under these circumstances it has rejected the proposition with the unanimity of its members, except the United States.

We immediately replied, in substance, that the United States has always maintained the principle that its national legislation should be as liberal as possible in its provisions concerning patents for inventions; but that a number of countries have, on the contrary, maintained, or introduced into their laws since the Convention of 1883, serious restrictions to the detriment of American citizens, which the Convention does not sufficiently minimize; that its results are reciprocally unequal, and sometimes wholly unjust to the individual members of the Union.

We further said that the United States has sought a means of remedying this inequality by a modification of the Convention itself,



and that if the Conference, by adopting the views of the committee, should not accept the proposition of the United States, it would probably be obliged to introduce restrictions into its legislation in order to preserve, as far as possible, its interests which are now sacrificed.

No criticism was attempted upon the stand taken by us.

## 2. PROPOSITION OF THE UNITED STATES TO AMEND ARTICLE 4 SO AS TO REMOVE ANY QUESTION AS TO THE EFFECT OF AMENDMENT OF APPLICATION.

The United States supplemented the propositions of the International Bureau of Berne to amend and add to article 4 by a proposition to add an explanatory clause in regard to amendments made in the application for a patent in the United States, because of the requirements of the Patent Office.

All the proposed amendments of article 4 were examined with care and the evident intent to give the inventor a free period of time before the applications succeeding the first application for a patent during which he might do those things—such as a publication of a description of the invention, its working, or its introduction, which (if happening before the application) would render a patent in most of the European countries of the Union invalid.

The question has been asked by our people: "What is the effect of the words 'by a third party' (*par un tiers*) in article 4, and also what is the effect of the amendment of the application in our Patent Office on an application made under the Convention?"

The committee on patents of the Conference recommended that the words "*par un tiers*" be suppressed, which recommendation was adopted by the Conference.

The committee further reported, as follows:

The subcommittee, after having established by the explanation of the "motives" that the proposition of the United States applies only to the exercise of the right of priority, is of the opinion that the proposition is unnecessary, since it is incontestable that the restrictions given to the original description during the preliminary examination can not prejudice the right of priority as established by article 4.

The further statements made on the minutes of the Conference seem to settle any doubt as to the construction to be given to article 4. It seems clear, therefore, that with the suppression of the words "*par un tiers*," if agreed to by the contracting States and the interpretation given to the article by the Conference, an American inventor can apply for a patent for his invention in the United States and within the period of seven months thereafter can make a similar application in any of the other States of the Union and obtain a valid patent, notwithstanding the absence of absolute novelty as to the public before and at the time of the application. In other words, that an applicant in the United States for a patent for an invention not theretofore described or made known so as to be unpatentable in other countries of the Union may go into such country and offer his invention for sale like any other commodity during a period of seven months.

The proposition of the International Bureau to amend article 4 so that each State of the Union should fix for the application for a patent first deposited with it a date of commencement of the period of delay of priority at a point between the date of the filing of the application and the issue of the patent was withdrawn before article 4 was considered.

## 3. PROPOSITIONS OF OTHER STATES.

It is to be regretted that so few of the States of the Union complied with the resolution, adopted on the motion of the delegates from the United States at the Madrid Conference, that propositions for the amendment of the Convention should be presented in advance of the Conference. On account of such neglect some of the delegates were without instructions on important questions which were raised, and instead of the work being finished at the conference important parts were postponed for diplomatic correspondence. Excuses were made that the Conference was called in advance of the time originally set (May 1, 1898), at the earnest request of Spain, which desired an interpretation of the Madrid agreement of April 14, 1891, relating to false indications of origin. This interpretation, it was stated, would have some bearing upon a litigation then in progress in France over wine, alleged to bear a false indication of origin while in transit through France to England and Belgium.

The International Bureau presented in advance of the Conference a very exhaustive series of propositions covering the whole ground of the convention as well as of the agreements of Madrid. These propositions were made after long observation of the workings of the Convention by the officials of the International Bureau, and also in view of the discussion which the Convention had provoked in many countries, and at a congress concerning the protection of industrial property held at Vienna in October, 1897. A copy of such propositions is sent herewith.

The Netherlands proposed to add to article 4 the words "regularly made," so that the period of priority for designs, industrial models, and trade-marks should only run from a deposit regularly made. It further proposed to exclude from trade-marks entitled to registration "proper or commercial names which the depositor is not entitled to use," meaning the names of strangers adopted without authority. (Art. 6, par. 4.)

It further objected to the amendment of article 10 proposed by the International Bureau as too broad.

Belgium also objected to the new article 4 *bis* proposed by the International Bureau and offered a substitute.

The propositions of the International Bureau, of the Netherlands, of Belgium, and of our Government were the only ones relating to the Convention of 1883 submitted prior to the Conference.

Spain proposed amendments to both of the agreements of Madrid and the Netherlands to the agreement for the international registration of marks.

Propositions of the French delegation were presented on December 1. They relate to persons assimilated to citizens of contracting States (article 3), and also to "unfair competition in trade"—a subject not provided for in the Convention. The proposition of the British delegation to limit the trade-marks entitled to registration under the Convention (article 6) was also presented on the same day.

Immediately after the opening of the Conference the Netherlands modified their proposition in regard to article 10 of the Convention, and Germany, Italy, and Sweden severally proposed modifications of article 4 *bis*, proposed by the International Bureau. Later Belgium, Hungary, and Servia made propositions. We transmit copies of the



various propositions herewith. It will be observed that the propositions of the International Bureau as originally printed were modified in the "Tableau Général des Propositions."

After considering the various propositions the Conference adopted a first final protocol relating to the Convention of 1883, and those States which had adhered to the Madrid agreement of 1891 in relation to international registration of trade-marks adopted what is called a second final protocol in relation thereto.

#### 4. FIRST FINAL PROTOCOL ADOPTED BY THE CONFERENCE.

The amendments to the Convention adopted, and which now go to the various States of the Union for ratification, are annexed hereto as Appendix A.

The amendments and reasons therefor may be briefly stated as follows:

*Article 3.*—The amendment to article 3 provides that citizens of a country not forming a part of the Union may be entitled to the advantages of the Convention to the same extent as the citizens of any country which is a member of the Union, if they are either domiciled in the latter country or maintain "effective and serious" industrial or commercial establishments therein. This amendment was intended to prevent the advantages of the Convention going to citizens of nonadhering countries who might maintain very small or trivial establishments as a pretense for obtaining such advantages.

*Article 4.*—The amendment to article 4 by striking out the words "by a third party" (*par un tiers*) removes a possible difficulty in the application of the article which might arise from an interpretation that the permitted disclosure, working, or importation could only be made by a third party, thus excluding the inventor himself from the right to publish, exploit, or introduce his invention, which right is the very thing desired by the United States, as before stated.

*Article 4 bis.*—A new article, entitled article 4 *bis*, provides for the mutual independence of patents applied for in the different States of the Union by persons entitled to the rights granted by the convention.

We supported this proposed new article, as instructed by you.

In order to avoid any confusion in regard to the interpretation hereafter to be given to the second paragraph, which reads: "This provision shall apply to all patents existing at the time of its entering into force," we called attention to it in the regular meeting and found that it was the unanimous sense of the Conference that the paragraph was not applicable to existing United States patents, but only to those patents whose terms might be shortened by the laws of those States of the Union in which provision is made for a shortening of the term on the lapsing of patents for the same inventions in other States.

An existing United States patent can not be affected by what may take place in regard to a patent for the same invention abroad. The limitation of the terms of the United States patents imposed by section 4887 was a determination at the moment of the grant of the patent of its term, and therefore the duration of the patent is unaffected by the subsequent expiration of a foreign patent for the same invention by reason of nonpayment of taxes or nonworking.

While there exist no patents in the United States which can be affected by article 4 *bis*, it may still affect advantageously the foreign patents of American citizens, and is, therefore, a provision in the interest of our people.



*Article 9.*—The amendment to article 9 is merely a permission to those States which do not practice seizure to substitute in place thereof the exclusion of the offending goods.

*Article 10.*—The amendment to article 10 is the introduction of the “producer” and of his “products” to the protection of the Convention. This is intended to cover agricultural products and is of great interest to the American people as large exporters of such products. The amendment further extends the number of “interested parties” entitled to take proceedings for the suppression of infringements from those dwelling in a locality to all those dwelling in the region in which the locality is situated.

*Article 11.*—The amendment to article 11 is to make the protection accorded to exhibits at international exhibitions more efficient, but it would seem that the addition of the words “according to the legislation of each country” takes away much of the force of the article.

*Article 14.*—The amendment to article 14 strikes out the words “the next meeting shall take place in 1885 at Rome.” A conference was actually held in Rome in 1886. The amendment seems to be a matter of taste merely.

*Article 16.*—The amendment to article 16 fixes with greater certainty the date of adhesion of a new State to the Convention and allows such State a choice of such date.

*Recommendation.*—These amendments can in no instance, in our opinion, prejudice the citizens of the United States, and should be adopted.

##### 5. SECOND FINAL PROTOCOL ADOPTED BY MEMBERS OF THE UNION ADHERING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF TRADE-MARKS.

The United States has not adhered to the Madrid agreement of April, 1891, in relation to the international registration of marks, but as your instructions required us to take part in the perfecting of this agreement, we gave the same attention.

The amendments to this agreement which were adopted by the States adhering thereto are annexed as Appendix B.

The amendments and reasons therefor may be briefly stated as follows:

*Article 2.*—The amendment to article 2 provides for a limitation of the advantages of the agreement to those persons who, on the territory of the restricted union created by the agreement, shall fulfill the conditions of article 3 of the general convention.<sup>1</sup>

*Article 3.*—The amendment to article 3 provides for the publication of registered marks by means of a stereotype furnished by the registrant. This replaces the description of the mark previously allowed. The amendment further provides for a claim to the color of the mark and means for determining the same.

*Article 4 bis.*—This new article provides for the substitution of international for State registration without prejudice to the rights acquired by the latter.

It is apparently the intention to make the International Bureau at Berne the center of a cheap registration which shall be efficient over the territory of all the adhering States. The desirability of such

<sup>1</sup> Amended article 3 of the Convention is referred to at page 182, ante.

registration is apparent on reference to the German trade-mark law now in force, which provides that the first applicant for the registration of a mark used by him in Germany is entitled to registration, although the very same mark may have been previously and publicly used by someone else for many years.

*Article 5.*—The amendment to article 5 limits the right of an adhering State to declare that protection will not be accorded to a trade-mark, except on the conditions applicable to a mark for which national registration is applied for under the Convention of March 20, 1883.

The only condition contained in the Convention is that registration may be refused if the object for which it is demanded is considered as contrary to good morals or to public order. (Article 6, Convention.)

This amendment is a step forward both in the way of liberty of adoption of marks and of uniformity in their protection.

*Article 5 bis.*—This is a new article providing for the furnishing of copies of the entries made in the register relative to any mark.

*Article 8.*—The amendment to article 8 provides that the fee of the International Bureau, in addition to that of the State of origin of the mark, shall be 100 francs for the first mark and 50 francs for every additional mark deposited at the same time by the same proprietor.

The great cost of registration by private enterprise in the various commercial countries of the world is set forth in the "motives" accompanying the propositions of the International Bureau and is also a matter of common knowledge.

*Article 9 bis.*—This is a new article, as follows:

When a mark entered in the international register shall be assigned to a person established in a contracting State other than the country of the origin of the mark, notice of the assignment shall be given to the International Bureau by the Government of said country of origin. The International Bureau shall register the assignment, and after having received the assent of the Government to which the new owner belongs shall give notice to the other Governments and publish it in its journal. The present provision does not have the effect of modifying the laws of the contracting States which prohibit the assignment of the mark without the simultaneous conveyance of the industrial or commercial establishment whose products it distinguishes.

No assignment of a mark inscribed in the international register made on account of a person not established in one of the contracting countries shall be registered.

We annex a copy of the agreement for the international registration of marks, together with a translation, for the better understanding of the amendments, Appendix D.

We are of the opinion that registration under this agreement would be of advantage to the citizens of the United States both as respects economy of registration and security in the enjoyment of their marks, and we recommend that steps be taken to secure to them such advantages.

## 6. PROPOSITIONS LEFT TO DIPLOMATIC CORRESPONDENCE.

The propositions in regard to which the Conference arrived at no conclusions, and which provoked the most discussion and took up the greater part of its time, were left to diplomatic correspondence, to be undertaken by the Belgian Government.

These propositions relate, respectively:

To the duration of the period of delay of priority (patents, art. 4);

To the forfeiture of patents for nonworking (art. 5);

To the admission of trade-marks to registration (art. 6);

To the usurpation of marks used but not registered (art. 7 *bis*, new);

To unfair competition (concurrence déloyale, art. 10 *bis*, new).



## A. DURATION OF PERIOD OF PRIORITY.

The propositions of the International Bureau that the period of delay of priority granted by article 4 be extended from six months for European States and seven months for the United States to a uniform period of twelve months was in reality pressed by the German delegates, who stated that their Government could not adhere to the Convention unless such extension was granted, for the reason that it took about nine months to complete the examination of a patent in the German patent office, wherefore a delay of six months would be without advantage to their citizens. They further stated that it was just that an applicant should have the benefit of the examination made by the Government and its opinion thereon before being required to determine what other applications he should make.

It was pointed out by the French delegates in opposition that the period during which the inventor was not compelled to make his application subjected the manufacturer who wished to undertake the exploitation of a new invention to a long delay prior to the determination of the question whether the invention could be used or not; and further, in some cases where he was ignorant of a prior application and entered upon the manufacture, to unjust loss. The present article contains conditions so onerous upon their people that they would not consent to their extension.

Our remark on this statement was that in practice, as illustrated in the United States, a new invention had to be brought to the attention of the public by the inventor before it was taken up by the manufacturer, and that the latter was therefore put upon his guard as to the use of the invention. The period of delay of priority was in fact a period of time allowed to the inventor in which to take advantage of the laws provided for his protection, and might be regarded, from the point of view of the manufacturer to whose attention the inventor had caused his invention to be brought, as though it had been kept secret.

We also remarked that the only other case that there could be was that of a separate invention by the manufacturer, which raises a different question, viz, that of the rights of independent inventors.

We voted for the proposition to extend the period of priority to twelve months, explaining, however, the limitation in our own law of seven months after application abroad in which application may be made in the United States, a period not of priority as understood under the convention, but of limitation only.

The countries voting for the extension were Belgium, Brazil, Spain, the United States, Italy, Norway, the Netherlands, Sweden, and Switzerland. Those voting against were France, Portugal, Servia, and Tunis. Denmark abstained from voting, the Danish delegate having stated that the extension would require a change in their law, which now fixed the period of priority at seven months.

We believe that the extension of the period of priority to twelve months would give our inventors many advantages, some of which are stated in the "motives" for the second proposition of the United States, and that such extension would not conflict with the intent of the Congress in passing the patent act of March 3, 1897, since that act permits of the public user of inventions in the United States for two years before application for a patent, and further because it was stated by the committee on patents prior to the passage of that law



that the period of seven months was taken in order to conform to the convention of 1883.

We recommend the adoption of this proposition.

#### B. FORFEITURE OF PATENTS FOR NONWORKING.

It was proposed to extend the period after the grant of a patent during which it could not be forfeited for nonworking to three years.

This proposition, like the last referred to, was offered by the International Bureau and pressed by the German delegates, who made it also a condition of adhesion to the Convention.

It has been claimed by our citizens that the working of patents taken out by them abroad is a great burden, as it often happens that either the invention is slow in its advance in public favor, or that one establishment can better supply the public demand through better facilities of manufacture or otherwise than a number.

On the other hand, the argument is urged by the countries which require working that it is unfair to the people to grant what may become obstructive patents to the advantage of strangers and without any corresponding compensation.

During the session of the Conference a society of patent agents of Brussels passed resolutions which state so clearly the position taken by some of the delegates in the Conference that we translate them:

Considering that, as a patent is a privilege granted by society on the condition that it profit from the discovery, as well from the point of view of the inventive spirit of the people which it stimulates as the material advantages which it procures, that that condition should be realized during the life of the patent and not alone at its expiration, the moment when the invention has often lost its value;

Considering that the laws of the various countries have almost unanimously required the obligation to work (*exploiter*);

Considering that, as working (*exploitation*) includes manufacture as well as use, use in this country alone of the product manufactured abroad is not sufficient;

Considering that, as the principle is universally recognized that national industry can not be tributary to foreign industry, the introduction in default of the obligation to work would be a cause of considerable harm to commerce and industry;

Considering that an account should be taken of the economic conditions of countries and of the marked inferiority in such conditions, which is found in some of them;

Considering that, as the provisions of the international Convention are drawn not only for the profit of the inventor but also in the general interests, its effect can not be to modify the legal system that each country has believed that it ought to adopt for the defense of the interests of its people; that this principle has been notably embodied in section 2 of article 5 of the Convention;

Considering that the obligation to work is not so onerous when the patentee has the faculty of representation in each country or to grant licenses; but, further, that in certain cases the actual conditions may be mollified by taking the offer of the invention under equitable conditions to industry and commerce as constructive working;

Considering, especially from the point of view of Belgium, that it is useful to recall what was said by Mr. Jobard, author of the project of law in regard to the obligation to work in the Kingdom in the course of the year which follows the beginning of the introduction abroad:

"We have considered the matter from a point of view which responds especially to the fear that an inventor will draw from abroad only those objects for which he has obtained a patent."

*Resolved, unanimously, That the International Conference (a) should maintain the obligation prescribed by the various laws to work inventions, with this modification, that the patentees may excuse their inaction for cause, especially by offers which they may have made on conditions equitable to commerce and industry; (b) should decide that the introduction by the patentee of the thing patented into the country where the patent has been granted can only be allowed as an exception.*

The principle of compulsory working is embodied in the oldest of patent laws, that of France, and is also found in some of the most recent, such as Russia, Austria, Hungary, and Switzerland. Compulsory license was introduced by England into the patent act of 1883. The German law of 1891 combines the features of both. For convenience of reference we have added an appendix (J) containing some of the laws in regard to compulsory working and compulsory license.

Obstructive patents which are used to prevent the manufacture or use of a patented article or the use of a patented process or machine in the country granting the patent were recognized in the Conference as an evil. An example was given of owners of an English patent for a dye who would not make use of or sell the dye in England, because they wanted to sell in England cloth dyed abroad with the dye also made abroad. Proceedings, it was said, had been taken under the compulsory-license section of the English patent law to compel a license under the patent to the English weavers who desired to use the dye.

The particular proposition brought before the Conference by the International Bureau near its close and voted upon was as follows:

Nevertheless the patent can not be declared lapsed because of nonworking in the country until after a minimum period of three years, and in the case where the patentee does not justify his inaction.

Shall be considered as justification of inaction the fact that the patentee has offered licenses on equitable terms by means of publications recognized as sufficient and that these offers have been fruitless.

The subcommittee did not adopt the proposition, but offered as a substitute:

The patentee shall remain subject to the obligation to work his patent conformably to the laws of the countries where he introduces the patented article. The patent can never lapse because of nonworking until after a delay at the least of — years and in the case when the patentee does not justify the cause of his inaction.

The substitute was not adopted by the Conference, which passed a vote on the first clause of the proposition of the international bureau as to the length of the delay. This was put to vote twice; first a period of two years was voted unanimously, and then a period of three years by all the States except France, Portugal, Servia, and Tunis, which voted in the negative.

The remainder of the first paragraph, "and in the case where the patentee does not justify his inaction," was sustained by all those who voted, including ourselves, but Belgium, Denmark, and Sweden abstained from voting.

The question of giving an example of such justification as in the second paragraph was negatived.

It is apparent that the abolition of working altogether would be an act of reciprocity toward the United States, which now grants unrestricted patents to citizens of countries which impose such a condition.

The exemption for a period of three years, or even two years, as unanimously voted, may be accepted as a step toward such reciprocity.

#### C. THE ADMISSION OF TRADE-MARKS TO REGISTRATION.

The question, What should be a trade-mark entitled to registration under the Convention? was discussed at great length in committee.



The proposition of Great Britain presented at the opening of the Conference was as follows:

Article 6 to be maintained in its present form, with addition of the following provisions:

This ground of refusal is applicable to marks containing—

(a) Public arms and decorations.

(b) A word or words referring to the nature or quality of the goods, or a geographical word or words, unless the depositor state in his application that he lays no claim to any exclusive right to the use of these words or names.

(c) The name or names of a person or company unless such name be printed or woven in a distinctive shape, or consist of the written signature in original or facsimile of the person or company which makes the deposit.

Paragraph 4 of the final protocol to be suppressed. (Original English text.)

The statement of reasons accompanying the proposition is annexed as Appendix F. In substance, the statement alleges that article 6 and the interpreting protocol—

appear to authorize the foreign depositor to claim protection for a mark for which registration would not be accorded to a national, because the local law does not allow of such a mark being considered as entitled to registration.

An instance may be quoted which will prove to the Conference the danger of allowing the registration of marks without any restriction. If, for instance, some one succeeded in getting the words "pig iron" registered as a trade-mark in one of the contracting States, would all the States of the Union be bound to grant protection for these words, even England and the United States, where no other terms exist for designating the substance?

It would be contrary to the interests of all Unionists to grant to an individual the exclusive right of using terms bearing on the nature or quality of goods, geographical names, or names of individuals or societies. Such words or names should always remain public property; no one can wish a monopoly in them to be granted to a private person.

The proposition was referred to a subcommittee, which reported the different opinions of its members by name and that an amendment to replace paragraph 1 of article 6 had been offered by the Chevalier Beck de Mannagetta, delegate from Austria, viz:

No trade-mark regularly deposited in the country of origin can be refused registration in the other countries of the Union except for the reasons which shall be equally applicable to marks of nationals.

That this amendment was accepted by the delegates of Great Britain and the Netherlands.

The report further said that the amendment implies the abrogation of paragraph 4 of article 6, as well as the entire provision No. 4 of the final protocol.

The report gave rise to a long discussion, of which the most salient feature was the distinction between old marks adopted to conform to no special prescribed form and those which may now be adopted under rules and regulations provided by some of the members of the Union.

As to marks long in use and clearly indicative of origin, there does not seem to be the same reason to apply strict rules as to new marks adopted to designate some new object of trade or manufacture or some new merchant or artisan.

Further, there was a clear separation in the debate between those countries which make the registration of the mark attributive of property, like Germany, and those where the registration is merely declaratory of a right, like France. In the one case the administrative officer passes once for all upon the validity of the mark in view of a certain standard set up by the law, and in the other case the regis-



tration is merely formal and the courts pass upon the validity of the mark in case of dispute.

Article 6 was again sent to the committee, and the British delegates submitted a revised text of their original proposition, as follows:

The English delegation proposes to maintain in its integrity article 6 of the convention, as well as No. 4 of the final protocol, with the addition of the following provision:

"It shall be permissible to each of the contracting States to refuse deposit in the following cases:

"1. Marks consisting exclusively of the name or names either of a person or of a company, unless these names be presented for deposit in a distinctive shape, or consisting of the signature in original or in facsimile either of the person or of the company which makes the deposit.

"2. Marks consisting either of a designation necessary for the indication of the nature or quality of products or of geographical names, unless the depositor in his application make a declaration to the effect that he lays no claim to any exclusive right to the use of these designations or names by themselves and without prejudice to the protection to which indications of origin are entitled.

"Denominations which do not indicate origin, as well as invented names in the two preceding cases (1 and 2), shall continue to be protected.

"3. Marks which include public arms or decorations without sanction from the proper authorities."

The committee reported nonagreement upon a form of amendment and a general discussion again arose, in which the British delegates said that it seemed indispensable to state in the Convention that registration which would give an exclusive right of use of such marks as contain geographical names could not be allowed, and the French delegates again affirmed that the spirit of the Convention required that marks be registered such as they are (*telle quelle*). The question as to what should be severally done with the two classes of marks, new and old, seemed to be wholly unobserved, although such a distinction is specially made in the English law, and the contest was waged on a right given by registration which might not thereafter be removed.

At a later session of the Conference the committee reported that they had again considered the revision of article 6, and that the British delegation had again offered its proposition in the form above.

The general discussion which followed showed a great diversity of opinion as to the proper interpretation of article 6 in connection with No. 4 of the final protocol. It seemed to the German and Austria-Hungarian delegates that under the article as it is when read in connection with final protocol No. 4 they would have a right to refuse registration to marks which did not conform to their law, e. g., descriptive marks, those which had fallen into the public domain, and objects which could not be considered as marks. This was disputed by the French delegates, and the question of what constitutes a trade-mark was again gone over, the whole discussion being tinged, as before, with the color of the attributive or the declarative position taken by each State, or by the views of those who favored the decision of the validity of trade-marks by administrative officers rather than by the courts after discussion by opposing counsel.

The provisional vote on the British proposition was as follows: In favor, Brazil, Denmark, Spain, Great Britain, Norway, The Netherlands, Servia, Sweden, Switzerland; against, the United States, France, Portugal, and Tunis. Belgium abstained.

We are of opinion that the proposed amendment of Great Britain goes too far. There are many old marks in use in the United States

which may have been adopted without sufficient consideration, but which by their age have now lost their descriptive character and taken on a secondary meaning. These are not in the same category as new marks, and ought not to be subject to an arbitrary standard which did not exist when they were adopted. By the Convention as it is all such marks are protected—at least ought to be.

**D.—THE USURPATION OF MARKS USED BUT NOT REGISTERED.**

This question is very intimately associated with that of registration, which we have just discussed. The countries whose laws make the registration attributive of right will not recognize marks which are used only, but are not registered, whereas those countries which make the registration declarative only do regard the age and extent of use of the mark in question.

In Germany the registration is attributive and carries with it certain property rights, the first applicant who fulfills the condition of the law being given the sole right to use the trade-mark, no matter how short his use, thus cutting off the rights acquired by any other person by a use for no matter how many years. Further, we should say that this does not rest in theory, but has become a matter of practice, although the law only entered into effect October 1, 1894. In anticipation of the effect of the law in giving the mark to the first applicant in case of rival dealers it is said that more than 8,000 applications were filed on one day at the entering into effect of the law.

The laws of France may be cited as an example of declaratory legislation. The registration in France is merely a declaration of claim which must be made before suit is brought, but the decision as to the validity of the mark is left to the courts. Our own legislation is in effect the same.

The International Bureau proposed the following new article to remedy the evident evil effect produced by trade-mark laws attributive of property, viz:

**ARTICLE 7 bis.** A mark known in commerce as designating the goods produced or sold by a person fulfilling the conditions of article 2 or 3 of the convention, or an imitation of that mark, can neither be validly registered for the benefit of another, nor fall into the public domain in the other contracting States, even if no steps have been taken for the registration of the same.

The Belgian delegation proposed as an amendment that article 7 bis should read as follows:

**ARTICLE 7 bis.** A trade-mark can not fall into the public domain, nor be validly registered by another in one of the States of the Union as long as it shall be the subject of a first right in the country of origin.

The subcommittee on marks, to whom the propositions were referred, discussed also a third proposition drafted by the French delegates, viz:

A mark regularly registered in the country of origin and not registered in the other countries of the Union can not be legally appropriated by a third party in these countries if this appropriation has been made in bad faith. In case of appropriation made in good faith, if the originator of the mark proves his priority, he can introduce his products into the country of the second user without giving the latter the right to bring an action.

The original proposition of the International Bureau being brought up for consideration at the afternoon session of December 11, the committee to whom it had been referred reported that the delegates from



Austria-Hungary, and the United States, France, Italy, the Netherlands, and Sweden had united in proposing to the Conference the text agreed to at Madrid, viz:

A trade-mark can not fall into the public domain in one of the States of the Union as long as it shall be the subject of an exclusive right in the country of origin.

Also that France and the International Bureau had withdrawn their propositions.

In the discussion which followed, both the Swedish and Servian delegates stated that the proposed amendment was in opposition to the laws of their respective countries, which make registration attributive of property.

The proposition being put to vote, all the States whose laws made the registration declarative of property only, voted in the affirmative, viz, Belgium, France, Italy, the Netherlands, Portugal, Switzerland, Tunis, and the United States. There was one vote in the negative—Servia—and five abstaining, viz, Brazil, Denmark, Great Britain, Norway, Sweden, and Spain.

It is clearly in the interest of those countries like the United States, whose laws make the registration of marks declaratory of right only, that some such amendment to the Convention should be adopted as a safeguard against the loss of marks by registration by others in countries whose trade-mark laws are attributive of property and give the mark to the first comer.

#### E.—UNFAIR COMPETITION IN TRADE.

The Conference has reserved for diplomatic correspondence substantially the whole subject of trade-mark protection. It has left to that correspondence the admission of trade-marks to registration, the usurpation of old marks not registered, and unfair competition in trade. We have seen the difficulties growing out of the different systems of registration, and suggest that the introduction of this latter protection to trade into the Convention will mitigate much of the hardship which is likely to arise from the lawful adoption and registration by strangers in their own country of old marks in other countries. There may be unfair competition in trade which will be restrained by the courts without the element of the infringement of a valid trade-mark. The two rights may exist side by side, as in France, England, and the United States.

The special proposition before the Conference offered by France is as follows:

The beneficiaries of the Convention (articles 2 and 3) shall enjoy in all the States of the Union the protection against unfair competition accorded to nationals.

We think that a provision in this tenor should be added to the convention.

#### 7. COLLECTIVE MARKS.

The proposition of the International Bureau (IV) for the making of an additional agreement in relation to marks of collective origin between such members of the Union as chose to sign the same was abandoned because of the clearly expressed opinion among the members of the Conference that it would be disadvantageous to the well-being of the Union under the convention of 1883 to create any more subsidiary unions or allow any further subsidiary agreements.



The desirability of the protection of marks indicating collections of individuals was universally conceded, and the suggestion was made that they should be brought under the convention itself.

The subcommittee on marks, to which the proposition of the International Bureau was referred, reported that they had agreed to propose to insert in the Convention the following:

Collective marks shall be protected in the same manner as individual marks on condition that legal protection shall have been acquired in the country of origin.

In every instance this protection shall not be accorded except to the extent that the legislation of each contracting State permits.

After a discussion which brought out the statement that such marks were not the subject of protection in some countries, the words "in the case" were added to the second paragraph, so that the same would read "Except in the case and to the extent." The proposition thus amended was put to vote, with the result of eight affirmative and four negative votes, and three abstaining.

A proposition of the French delegates as follows:

"The provisions of article 6 are applicable to collective marks," was then put to vote, with the result of eight votes in the affirmative and six in the negative, one abstaining.

On the suggestion of the president the Conference passed the following resolution:

The Conference expresses the desire that collective marks shall be protected in the same manner as individual marks in the countries of the Union.

#### 8. RESOLUTIONS ADOPTED BY THE CONFERENCE.

In addition to the resolution adopted by the Conference that collective marks should be protected, a desire was also expressed in regard to the completion of legislation for the protection of industrial property, as follows:

That those of the States of the Union which do not possess laws upon all the branches of industrial property (patents for inventions, industrial designs or models, trade-marks, trade names, indications of origin) complete their legislation therein as soon as possible.

*Industrial designs and models.*—A resolution was also adopted (but by a vote of 9 to 2, some abstaining) as follows:

The Conference expresses the desire that the legislation of each of the contracting States shall permit the depositors of industrial models or designs to obtain legal protection therefor during ten years at the least.

This resolution gave rise to some discussion as to the principle on which such right is based, whether it was not analogous to copyright, and a stranger to patent right. This was the only theoretical proposition presented to a very practical Conference.

A resolution to provide for the international registration of industrial designs and models, proposed by the International Bureau, was withdrawn on its being shown that in certain countries industrial designs and models are deposited in sealed envelopes.

*Patent drawings.*—The Conference adopted the following:

The Conference expresses the desire that an understanding between the States of the Union concerning the production of drawings to be annexed to applications for patents should be had, so that one sole and same drawing multiplied by technical process can be utilized for the applications for patents deposited in each of the States.

*Propositions should be forwarded to International Bureau prior to conference.*—In order to avoid the difficulties arising from delegates being without instructions, to which we have referred, we renewed the resolution which was introduced by our predecessors at Madrid, that the propositions of the members of the Union for the amendment of the Convention should be sent in in advance of the next Conference, and the same was adopted.

#### 9. RESOLUTIONS INTRODUCED BY FRANCE.

The delegates from France presented the following resolution :

That the Government of the United States of America attempt in every way to provide as soon as possible Federal legislation which will replace local legislation in reference to trade-marks, and will insure an easier and more efficient suppression of trade-mark infringements.

This resolution was evidently introduced in ignorance of the position already taken by the United States in prior Conferences. In replying, we referred to the minutes of the Conference at Paris, 1880 (p. 150), which reports a statement by Mr. Putnam, delegate from the United States, as follows :

The plenipotentiary of the United States of America having declared that by the terms of the Federal Constitution the right to legislate concerning trade-marks is, in a certain measure, reserved to each of the States of the American Union, it is apparent that the provisions of the convention will only be applicable within the limits of the constitutional powers of the high contracting parties.

This statement was incorporated into the protocol of that Conference.

We further said that the Federal law provides that owners of trade-marks used in commerce with foreign nations, provided such owners shall be domiciled in the United States or located in a foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, may obtain registration of such trade-marks.

Also, that it is the opinion of some lawyers in the United States that, under the clause of the Constitution giving the Congress the power to regulate commerce between the States, there might be added by law to those trade-marks which are now registered under the existing law the trade-marks used in commerce among the several States. But such a law relating, as it must, solely to marks not used in foreign commerce would not change the rights of aliens in the least.

That as to legal proceedings for the suppression of infringement aliens have all the rights of citizens.

Further, that so far as relates to the protection of marks from a point of view strictly interior, the Conference is not interested.

No vote was taken upon the resolution, it being apparent that the United States had acted in good faith. There was also an evident feeling that the resolution went too far and was directed to the interior policy of the United States, with which the Conference had no concern.

#### 10. REQUIREMENTS OF GERMANY BEFORE ADHESION TO THE CONVENTION.

The three German delegates, Mr. Hauss, Geheimer Ober-Regierungs-rath, Counsel Reporter in the Department of the Interior of the Empire; the Count d'Arco-Valley, Counsel of Legation, First Secretary of the Imperial Embassy at London; Mr. Robolski, Geheimer Regierungs-rath, Member of the Imperial Patent Office, made known the

requirements of Germany for adhesion to the Convention to be an amendment extending the period of priority to twelve months, and an amendment extending the period after grant of the patent during which the same need not be worked to three years. They further made a demand for compulsory license, but did not insist thereon.

The German delegates took a most active part in all the discussions and proceedings of the Conference.

We annex the statements of the German delegates presented at the opening of the Conference, as Appendix G.

#### 11. ACCEPTANCE OF THE INVITATION OF THE UNITED STATES.

In accordance with our instructions, we invited the Conference to determine the United States as the next place of meeting. We are glad to report that the invitation was accepted.

We are, dear sir, very respectfully,

BELLAMY STORER.  
FRANCIS FORBES.

Hon. JOHN SHERMAN,  
*Secretary of State.*

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APPENDIX A.—First final protocol, adopted at Brussels (convention). (See ante, p. 182.)

APPENDIX B.—Second final protocol, adopted at Brussels (international registration of trade-marks). (See ante, p. 185.)

APPENDIX C.—Supplemental convention, concluded at Madrid, April 15, 1891. (See ante, p. 156.)

APPENDIX D.—Agreement concerning the international registration of trade-marks, Madrid, April 14, 1891. (See ante, p. 160.)

APPENDIX E.—Agreement concerning the suppression of false indications of origin of goods, Madrid, April 14, 1891. (See ante, p. 158.)

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#### APPENDIX F.

#### PROPOSITION OF THE BRITISH DELEGATES.

[Article 6. Final Protocol No. 4.]

Article VI, to be maintained in its present form, with addition of the following provisions:

“This ground of refusal is applicable to marks containing—

“(a) Public arms and decorations.

“(b) A word or words referring to the nature or quality of the goods, or a geographical word or words, unless the depositor state in his application that he lays no claim to any exclusive right to the use of these words or names.

“(c) The name or names of a person or company, unless such name be printed or woven in a distinctive shape, or consist of the written signature in original or facsimile of the person or company which makes the deposit.”

Paragraph 4 of the final protocol to be suppressed.

#### STATEMENT OF REASONS.

The application of Article VI and of No. 4 of the final protocol has given rise in England to rather serious difficulties. The Conference may be reminded that the true principle of the Union, established in article 2 of the Convention, consists in this,



that subjects of each of the contracting States are entitled to enjoy in the other States the same advantage as, and not superior advantages to, nationals.

Article VI in its present form and the interpreting protocol appear to authorize the foreign depositor to claim protection for a mark for which registration would not be accorded to a national, because the local law does not allow of such a mark being considered as entitled to registration.

The government of her Britannic Majesty hesitates to give their assent to a provision in virtue of which a stranger might claim in England advantages superior to those enjoyed by nationals, and it seems difficult to them to make the stipulations of Article II tally with those of Article VI and of No. 4 of the final protocol. The British delegates beg the conference to give due weight to this difficulty.

The Convention, taken as a whole, appears to aim at securing a right of priority for obtaining registration, rather than an absolute right to such registration, and at laying down that the depositor ought to submit to local law in every country where he claims registration.

An instance may be quoted which will prove to the Conference the danger of allowing the registration of marks without any restriction; if, for instance, some one succeeded in getting the words "pig iron" registered as a trade-mark in one of the contracting States, would all the States of the Union be bound to grant protection to these words, even England and the United States, where no other term exists for designating the substance?

It can, moreover, be affirmed that the principle of the British proposal should be admitted by all the States as resulting from international law.

It would be contrary to the true interests of all Unionists to grant to an individual the exclusive right of using terms bearing on the nature or quality of goods, geographical names, or names of individuals or societies. Such words or names should always remain public property; no one can wish a monopoly in them to be granted to a private person.

Difficulties have already arisen in regard to this matter in England, and the Government of Her Britannic Majesty considers the moment to have come when the real bearing of the provisions on this point should be defined.

Acting on this theory, the British delegates venture to submit to the favorable consideration of the Conference their proposal, which aims at inserting in the convention a series of exceptions to the principle which appears to be involved in the present text of Article VI and of No. 4 of the final protocol. This proposal keeps in view the amendments proposed by the International Bureau and by the administration of the Netherlands. Should it be accepted, No. 4 of the final protocol would cease to be of use and be suppressed.

#### APPENDIX G.

#### STATEMENT OF GERMAN DELEGATES.

The Imperial Government has submitted the preliminary draft of the International Bureau, which has been transmitted to it in view of the coming conference of unionist Governments for the protection of industrial property, to a detailed examination.

German industry has always deeply approved the tendency of the Union to facilitate as much as possible the obtaining and working of patents, of industrial designs or models, and of trade-marks in other countries than the country of origin; and in removing by provisions stipulated in conventions the difficulties which result from the differences between national laws. The Imperial Government, on its part, has desired to give expression to the interest which it bears in the efforts of the Union by sending representatives to the conferences of Rome and Madrid. If the German Empire has not joined the Union up to this time, such abstention on its part is explained by certain peculiarities in the articles of the Union—peculiarities which appear irreconcilable with the interior legislation of Germany.

Besides some questions of less importance, the article concerning the manner of fixing the delay of priority (Article 4 of the Convention) and that on the retention of the provision imposing the obligation of working (Article 5) have especially tended to raise a doubt in the Imperial Government as to the possibility of its adhesion to the Union. If a solution of these two questions, guarding the interests of German industry as much as that of foreign industry, can be found, the Imperial Government would be disposed to take into consideration the question of its adherence to the Union. It is with lively satisfaction that it has learned of the preliminary draft of the International Bureau, and has recognized an endeavor to resolve the difficulty worthy of attention.

As to the details of the preliminary draft, the Imperial Government allows itself to make the following observations:

1. According to the propositions concerning Article 4, each of the States of the Union is to have the power to fix for itself, in applications for patents, the point of departure of the delay of priority at any moment during the time comprised between the date of the receipt of the application and that of the delivery of the patent. This proposition is evidently suggested by the desire to recognize the conditions in those States which deliver a patent only after a minute preliminary examination. But the restriction to which that proposition is subject would lead to serious difficulties from the German point of view, because it is not permitted in any case, no matter what may be the point of departure of the delay of priority, to move the efficacy of the right of priority back of the point of departure of the delay. Under these conditions Germany can not, as she has done in the special conventions signed with Austria, Hungary, Italy, and Switzerland, calculate the delay from the deliverance of the patent, since in that case the publication of the application before the deliverance of the patent would put in question the novelty of the invention in the other States of the union.

Also, the Imperial Government can not admit the date of the publication of the application as the point of departure, since it is not always possible to prevent the secret of the application being divulged before the publication. The inventor himself is frequently interested in making his invention known to the public, or in commencing its industrial exploitation. Besides, in both cases the right of priority of the German inventor would not be preserved, inasmuch as his application for a patent would not have priority over applications made in other countries of the Union in the interval between the application and its publication in Germany, or the deliverance of the German patent.

The propositions relating to Article 4 can not, therefore, furnish the Imperial Government an acceptable basis of further negotiations unless the effect of the priority were to be moved back of the date of the first application. We are far from overlooking that the States which fix the point of departure at a date after that of the first application would obtain thereby an actual prolongation of the delay of priority. If such a prolongation does not seem acceptable, it only remains to seek another basis of understanding, while maintaining the same point of departure for all the countries.

In that case the Imperial Government can not lose sight of the circumstance that the preliminary examination to which patent applications are subjected in Germany requires considerable time, and that on an average more than six, and frequently more than seven, months are necessary, reckoning from the date of the application until the inventor has acquired any certainty as to the result. Even admitting that the duration of the delay of priority be augmented by one month and extended to a period of seven months, the industrial who should make his application in the first place in Germany would hardly draw any material advantage from his right under the duration actually fixed by the provisions of the convention of the union.

It is only by prolonging the duration of priority to twelve months that the German industrial in general would draw a substantial, but always inferior, advantage to that which the priority furnishes to applicants from other countries where the industrial need not wait until a decision has been taken upon his application, but can from the beginning of the delay, if he so decide, present his invention in the other countries and make the necessary arrangements and preparations. Nevertheless, in any case we leave this to the Conference, hoping that it will take into particular consideration the question of the extension of the delay of priority to a duration of twelve months from the date of the first application.

2. The Imperial Government considers that in requiring the working of the patent under pain of forfeiture obligations at the same time onerous and in part impossible to realize are imposed on the inventor who has demanded and obtained a patent in a certain number of States, and that without real profit to industry in general. To restrain the obligation of working is, then, in its eyes one of the ends to which the efforts for an international understanding should principally be directed. It is from this point of view that it appears to it desirable to establish an article by virtue of which the actual working in one of the contracting States shall remove in all the other contracting States any prejudice resulting from lack of working. The agreement presented by the International Bureau in the preliminary draft recognizes only partly this way of looking at the question; nevertheless it appears adapted to improve the international situation of patents. If this agreement obtains the adhesion of a sufficiently large number of the States of the union, the Imperial Government considers that one of the principal reasons which has, up to this time, determined its abstinence from the Union will be considerably modified.

The difficulties raised by some of the other parts of the convention of the Union are of less importance and can be solved by reciprocal understanding.



## GERMANY'S POSITION IN REFERENCE TO CONFERENCE OF 1880, WHICH DRAFTED THE CONVENTION OF 1883.

The minutes of the Conference of Paris, 1880, state (p. 148):

"He (Mr. Kern) expressed the hope that the French Government, which has taken the initiative of the union, should continue to press foreign Governments in order to obtain new adhesions. That of Germany has not yet been obtained.

\* \* \* \* \*

"Mr. Kern recalled what is said upon this subject (adhesion) in the response of the minister of foreign affairs of the German Empire to the note of M. de Freycinet, minister of foreign affairs of France, under date of December 16, 1879, and April 21, 1880. The Prince Hohenlohe thus expressed himself in his dispatch of July 12, 1880:

"The commission charged with the examination of the proposition of the French Government, entirely aware of the importance of that question to Germany, can not admit the necessity of the German Government participating in a conference of which the result will be without doubt to profoundly modify the legislation of very recent enactment which regulates this matter over the whole Empire. Therefore, the Imperial Chancellerie, believing itself called upon to decline the invitation of your excellence, has requested me to announce it, etc."

Germany afterwards created a new patent law, April 7, 1891, and a new trade-mark law May 12, 1894.

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#### APPENDIX H.

Inventions specially excluded from protection by patent. (See p. 306.)

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#### APPENDIX I.

Laws of foreign countries in regard to compulsory working and license. (See p. 318.)

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#### APPENDIX J.

#### PARAGRAPH 1 OF ARTICLE 6 OF THE CONVENTION, ITS ORIGIN AND HISTORY.

The report of the conference of 1880 shows article 6 to have been adopted after the following proceedings:

M. Jagerschmidt proposed a draft convention containing the following article (p. 27):

"ART. 7. Le dépôt d'une marque quelconque de fabrique ou de commerce sera admis, dans tous les États de l'Union, aux risques et périls du déposant, quelle que soit la nature du produit revêtu de la marque."

(The registration of any trade-mark shall be allowed in all States of the Union at the risk and peril of the registrant, whatever be the nature of the product provided with the mark.)

When this article was reached as stated in the minutes (p. 89)—

"On the request of Mr. Demeur, Mr. Jagerschmidt stated the meaning of the article. He explained that in certain countries when a manufacturer or merchant appears to deposit a mark for pharmaceutical objects, for example, its registration is refused, because the product has not been approved by the council of hygiene and can not be put on sale. Now the mark is absolutely independent of the product, and it is of importance that its proprietor should be able to register it in order to guarantee his rights until the time when the product, forbidden to-day, shall be finally allowed."

The conference then adjourned. On the next day the minutes say (p. 97):

"He (the president) read article 7, which is as follows:

"Le caractère des dessins ou modèles industriels et des marques de fabrique ou de commerce devra être apprécié dans tous les États de l'Union d'après la loi du pays d'origine" (p. 132).

It appears from the minutes that on a formal demand by the Swiss delegate for the suppression of the words "*dessins et modèles*" and on objection raised by the same delegate to the expression "*le caractère des marques*," the Commission definitely adopted a new form presented by the Brazilian delegate, as follows:

"Dans tous les États de l'Union, le dépôt d'une marque quelconque de fabrique ou de commerce sera admis, aux risques et périls du déposant, quelle que soit la nature du produit sur lequel la marque doit être apposée." \* \* \*

(In all the States of the Union the registration of a trade-mark shall be allowed at the risk and peril of the registrant, whatever be the nature of the product upon which the mark is to be applied.)

"The article is put to vote and adopted."



The draft convention having been gone over, article by article, a new text was prepared with newly numbered articles.

Article 5 of the new draft contained four paragraphs, the first of which, corresponding in position to the first paragraph of the existing article 6, was as follows:

"Toute marque de fabrique ou de commerce valablement déposée dans le pays d'origine sera admise telle quelle au dépôt dans tous les autres Etats de l'Union" (p. 138).

(Every trade-mark validly registered in the country of origin shall be admitted, such as it is, to registration in all the other States of the Union.)

The minutes say:

"Mr. Jagerschmidt remarked that the text of the first paragraph is that which was adopted by the congress of 1878 (the congress at the Paris Exposition). \* \* \*

"The president observed that the expression validly (valablement) may be inconvenient. The deposit (registration) is simply a declaration, therefore it may be regular without being valid. It would be better to adopt the word regularly (régulièrement). \* \* \*

"The president said that before everything an understanding was necessary. Does the word valid (valable) mean that the property is definitely acquired by the depositor? \* \* \*

"Mr. Jagerschmidt sought to enlighten the discussion by reproducing an example cited before the committee of the conference. The question was first raised between France and Russia. The Russian law protects marks written in Russian characters only; no French mark could be admitted to registration in that country. After an exchange of correspondence between the two Governments it was decided that the French mark regularly registered in France should be admitted, such as it is (telles quelles), and protected in Russia, although drawn up in French characters.

"Thus, it is intended to express by article 5 that the mark shall be admitted to registration in the country of importation if it is regular in the country of origin; but an obligation on the tribunals to recognize and sustain the law of the country of origin as to validity does not result therefrom; they are only required to judge that the deposit has been regularly made. The article can, therefore, be adopted with the words regularly registered (*déposée*), or even by simply saying registered (*déposée*).

"Mr. Demeur (Belgium) said that except in countries having a preliminary examination the registration (*dépôt*) by itself does not prove the right of the registrant even in the country of origin. A judicial examination upon the validity of the mark, which examination should be judged according to the legislation of the country of origin, can therefore arise in the country where the mark shall be imported. He preferred to return, with the exception of the omission of the words designs and models, to the original text of the first paragraph of article 5 adopted at its first reading.

"The president stated the three propositions (p. 141):

"1. That of Mr. Demeur, which is the old text of article 5.

"2. The text proposed by the Chevalier de Villeneuve, delegate from Brazil, and adopted by the committee.

"3. The modification accepted by Mr. Indelli, i. e., the words regularly registered with the addition of the words admitted and protected." \* \* \*

"The text of the first paragraph of article 5 of the committee with the word 'regularly,' and the addition, and protected, is put to vote, and adopted by the majority." (P. 142).

The final text is as follows (p. 163):

"Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union."

This is translated in Treaties and Conventions between the United States and other Powers, 1776 to 1887 (p. 1170), as follows:

"Every trade or commercial mark regularly deposited in the country of origin shall be admitted to deposit and so protected in all the other countries of the union."

The translation published by Great Britain is as follows (see Kerley's Law of Trade-marks, p. 659):

"Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the union."

## ANALYSIS OF REPORT OF DELEGATES TO BRUSSELS CONFERENCE, 1897.

1. Composition of the Conference.
2. Propositions of the United States.
  - A. Addition to article 2 to make the Convention more reciprocal as to taxes, fees, subject-matter, etc. Remedies by internal legislation pointed out. Adverse action of Conference. Protest of the United States.
  - B. Addition to Article 4 in regard to amendments of applications for patents prior to grant. Declaration of Conference that such amendments have no effect on questions of priority.
3. Propositions of other States.
4. First protocol. Amendments to the Convention adopted by the Conference.
  - Art. 3. Persons assimilated to subjects or citizens; limited to those only who have effective and serious industrial establishments, etc.
  - Art. 4. Striking out "*par un tiers*" in second paragraph.
  - Art. 4 bis. A new Article providing for independence of patents taken out in different countries for the same invention.
  - Art. 9. An additional paragraph permitting the substitution of a *prohibition of importation* in place of *seizure* and making seizure in transit optional.
  - Art. 10. Adding to interested party "producer" and to "locality of product" falsely indicated "the region where said locality is situated."
  - Art. 11. International expositions shall be "granted" a temporary protection "in accordance with the legislation of each country."
  - Art. 14. Omission of sentence "The next meeting shall take place in 1885 at Rome."
  - Art. 16. Time of entering into force of an adhesion to the Union.
5. Second protocol. Amendments to the Madrid agreement concerning the international registration of trade-marks adopted by the States adhering to the said agreement.
6. Propositions left to diplomatic correspondence.
  - A. The delay of priority. (Art. 4.)
  - B. The forfeiture of patents for nonworking. (Art. 5.)
  - C. The admission of trade-marks to registration. (Art. 5.)
  - D. The usurpation of marks used but not registered. (Art. 7 bis.)
  - E. Unfair competition in trade.
7. Collective marks.
8. Resolutions adopted by the Conference.
9. Resolution introduced by France that the United States should replace local trade-marks by Federal laws.
10. Requirements of Germany before adhesion to the Convention.
11. Acceptance of the invitation of the United States.

## APPENDIXES.

- A. First final protocol, Convention of Paris of 1883, proposed by Brussels conference. (p. 182.)
- B. Second final protocol, agreement of Madrid, 1891, concerning international registration of marks, proposed by Brussels conference. (p. 185.)
- C. Convention of Paris of 1883. (p. 146.)
- D. Agreement of Madrid of 1891 concerning the international registration of marks. (p. 160.)
- E. Agreement of Madrid of 1891 concerning the suppression of false indication of origin. (p. 158.)
- F. Propositions of the British delegates as to trade-marks. (Art. 6, protocol 4, p. 208.)
- G. Statement of German delegates. (p. 209.)
- H. Inventions especially excluded from protection by patents in other countries. (p. 306.)
- I. Laws of some other countries in regard to compulsory working and license. (p. 318.)
- J. Article 6 of Convention, its origin and history. (p. 211.)
- K. Propositions of the United States. (p. 189.)

## CHAPTER VI.

### REPORT OF THE BRITISH DELEGATES TO THE BRUSSELS CONFERENCE OF 1897.

*The British Delegates to the Brussels Conference of the Union for the Protection of Industrial Property to the Right Hon. C. T. Ritchie, M. P.*

BRUSSELS, *December 15, 1897.*

SIR: We have the honor to report that, in accordance with our instructions, we have attended the conference of the Union for the Protection of Industrial Property, which met in this city on the 1st instant and closed yesterday.

Nearly all of the countries of the Union sent delegates, and among those States not parties to the Union which were represented may be mentioned Germany, which sent an able and well-equipped delegation, who took an active part in the proceedings; Austria-Hungary, which will shortly enter the Union, represented by two well-informed Delegates, and Japan, which sent three Delegates to watch but not to take part in the proceedings.

The object of the Conference was the discussion of a revision of the Convention of 1883 and of the additional Acts signed at Madrid on the 14th April, 1891.

It is not necessary for us now to recite at length the various proposals which had been put forward by the International Bureau of Berne and by the States, parties to the Union as the basis of the proceedings, many of these having been dropped or modified in the course of the discussions.

When the conference got to work it soon became apparent that the chief difficulties would be encountered in regard to the following points:

(a) Article IV of the Convention of 1883, as to the delay of priority for patents and trade-marks.

(b) Article V, respecting forfeiture of patents on account of non-working.

(c) Article VI, relative to the obligation of the contracting States to register trade-marks "Telle quelle," or in the form originally registered in another State of the Union.

(d) The Arrangement of Madrid of the 14th April, 1891, respecting false indications of origin.

We propose, in the first place, to give a short explanation of what took place on each of these points.

#### (a) DELAY OF PRIORITY FOR PATENTS.

It will be remembered that the Paris Convention of 1883 provides for the international recognition of a period which commences from the deposit in one of the States of the Union of an effective application to such State for the grant of a patent, design, or trade-mark, and



within which such applicant can, by subsequently depositing a like application in another State of the Union, enjoy in such last-mentioned State the same rights as if his application thereto had been deposited at the same time as his application to the first-mentioned State.

The above period, usually spoken of as the "period of priority for patents," is fixed by Article IV of the Convention of 1883 at six months, one month more being allowed for countries beyond sea.

Section 103 of "The Patents, Designs, and Trade-marks Act, 1883," grants a period of seven months to all foreign States to which the Act has been applied by Order in Council.

It has been made clear at the Conference that the German Government would not enter the Union unless this period could be extended to twelve months. The object of the German Government appears to be to enable the German patentees to avail themselves of the results of the official examination practiced in Germany as to novelty of invention before they decide whether they will also take out their patents in foreign States.

It has been found necessary in practice that a period of at least twelve months should be allowed for the completion of this examination.

There is at present no similar examination in the United Kingdom, otherwise the extension suggested by Germany would probably become necessary. As the English law at present stands, it would be disadvantageous to British inventors to extend the time during which British patentees are left in uncertainty whether or not they can be forestalled by means of patents taken out by foreigners in the United Kingdom under the Convention.

It would consequently be necessary, if the German proposal were hereafter entertained, to make some provision to obviate this inconvenience. This might possibly be done by requiring foreigners who apply in the United Kingdom for patents under the Convention, to file with their application a complete specification setting out fully the objects and mode of working of their patents, and by shortening the period at present allowed for the acceptance of that specification. At present a period of nine months is allowed before the complete specification must be filed, and the latter specification need not be accepted until the expiration of twelve months from the date of the application. These periods may be extended to ten and fifteen months, respectively.

The proposal put before the Conference was to extend the period of priority fixed by the Convention in the case of patents to twelve months, and in the case of trade-marks to four months in all cases.

We stated our readiness to agree to seven months for patents and four months for trade-marks, as now provided by English law. A vote on the extension to twelve months was eventually taken, with the following result :

AYES (9).	NOES (4).	ABSTENTION (1).	RESERVED VOTE (1).
Belgium.	France.	Denmark.	Great Britain.
Brazil.	Portugal.		
Spain.	Servia.		
United States.	Tunis.		
Italy.			
Norway.			
Netherlands.			
Sweden.			
Switzerland.			

Germany and Austria had no votes, not being as yet Parties to the Union.

As it was clear that unanimity could not be obtained, and bearing in mind the importance which is attached to the entry of Germany into the Union, we thought it best to reserve our vote, so as not to have the appearance of closing the door to possible future negotiations.

(b) FORFEITURE OF PATENTS FOR NONWORKING.

Several of the Contracting States are desirous of adding to the Convention provisions to mitigate the severity of the laws in force in some of the States of the Union, which provide for the forfeiture of patents which are not being worked in the countries in which they are taken out by foreigners.

The proposal on this subject, which was brought forward by the International Bureau as a basis of discussion, was to add the following two paragraphs to Article V of the convention of 1883:

[French text proposed.]

Cependant, il ne sera soumis à cette obligation qu'après un délai minimum de ——— ans, à l'expiration duquel la déchéance du brevet pourra être prononcée, si le breveté ne justifie des causes de son inaction.

Sera considérée comme une des causes justifiées d'inaction, l'absence de toute offre faite au breveté d'acquiescer de lui des licences à des conditions équitables, après qu'il aura provoqué de telles offres par des publications reconnues suffisantes.

[Translation.]

Nevertheless, he shall only be subject to this obligation after a minimum delay of ——— years, after the expiration of which judgment may be given in favor of the forfeiture of the patent if the patentee fail to account for his inaction.

The following shall be considered as one of the justifiable grounds of inaction: The absence of any offer to the patentee to acquire licenses from him on equitable terms after he shall have invited such offers by the publication of notices recognized as satisfactory.

Under the English law patents are not forfeited for nonworking, but nonworking is one of the grounds on which compulsory licenses may at any time be obtained under section 22 of the Act of 1883.

In the course of the discussions on this subject it appeared that the proposal of the Bureau was intended to affect only the forfeiture of patents, and was not designed in any way to modify the law as to compulsory licenses under section 22. No objection was therefore raised to our proposal to make this clear by substituting the words "le brevet ne pourra être frappé déchéance pour cause de non exploitation," for the words "il ne sera soumis à cette obligation," on the first line of the above paragraphs.

The proposal as thus amended would have had the effect of affording some protection against forfeiture to British patents taken out in foreign countries, while in no way affecting our law under section 22.

Considerable divergence of opinion was manifested as to the minimum period at the expiration of which a patent should be forfeitable for nonworking, the French Delegates being strongly in favor of not extending this period beyond two years, while several of the Delegates, including those of Germany, were very desirous that it should be extended to three years.

The French Delegates strongly objected to the second of the proposed additional paragraphs, which was supported by Germany and other States.

As it became evident that unanimity was not procurable on this subject the question was reserved for future consideration.

Germany will probably not join the Union unless the three years can be granted.



(c) ARTICLE VI RELATIVE TO THE OBLIGATION TO REGISTER A TRADE-MARK, "TELLE QUELLE," OR IN THE FORM ORIGINALLY REGISTERED IN ANOTHER STATE OF THE UNION.

Article VI of the Convention of 1883 is as follows:

[French text.]

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'union.

Sera considéré comme pays d'origine le pays où le déposant a son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'union, sera considéré comme pays d'origine celui appartient le déposant.

Le dépôt pourra être refusé si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

[Translation.]

Every trade-mark duly registered in the country of origin shall be admitted for registration and protected in the form originally registered in all the other countries of the union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Paragraph 4 of the Final Protocol adds the following explanations:

4. Le paragraphe 1<sup>er</sup> de l'Article VI doit être entendu en ce sens qu'aucune marque de fabrique ou de commerce ne pourra être exclue de la protection dans l'un des États de l'Union par le fait seul qu'elle ne satisferait pas, au point de vue des signes qui la composent, aux conditions de la législation de cet État, pourvu qu'elle satisfasse, sur ce point, à la législation du pays d'origine, et qu'elle ait été, dans ce dernier pays, l'objet d'un dépôt régulier. Sauf cette exception, qui ne concerne que la forme de la marque, et sous réserve des dispositions des autres articles de la convention, la législation intérieure de chacun des États recevra son application.

Pour éviter toute fausse interprétation, il est entendu que l'usage des armoiries publiques et des décorations peut être considéré comme contraire à l'ordre public dans le sens du paragraphe final de l'Article VI.

4. Paragraph 1 of Article VI is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other articles of the convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

The difficulties to which these stipulations have given rise in England are well known.

The fundamental principle of the Union, as fixed in Article II of the Convention, is that subjects of any State of the Union shall enjoy in the other States the same protection as natives for patents and trade-marks, but no more. It is difficult to reconcile this principle with the stipulations of Article VI and paragraph 4 of the Final Protocol, and the problem has already become the subject of judicial decisions and of official correspondence in England.

In accordance with our instructions, we first submitted to the Conference the following proposition, founded upon a suggestion originally made by Mr. Herbert Hughes, as a means of giving effect to the



provisions of section 10 of the Patents, Designs, and Trade-marks Act of 1888, and otherwise meeting the difficulty:

Article VI to be maintained in its present form, with addition of the following provisions:

This ground of refusal is applicable to marks containing—

(a) Public arms and decorations.

(b) A word or words referring to the nature or quality of the goods, or a geographical word or words, unless the depositor state in his application that he lays no claim to any exclusive right to the use of these words or names.

(c) The name or names of a person or Company, unless such name be printed or woven in a distinctive shape, or consist of the written signature, in original or facsimile, of the person or Company which makes the deposit.

Paragraph 4 of the Final Protocol to be suppressed.

We accompanied this proposition by the “*Exposé des Motifs*,” which forms Inclosure 1 in the present dispatch.

This proposition met with little support, and our next attempt to meet the difficulty was to concur in the making of a proposal by the Austrian Delegate to the following effect:

Replace the first paragraph of Article VI by the following:

“No trade-mark regularly deposited in the country of origin can be refused registration in the other countries of the Union, except for reasons which would equally prevent the registration of marks by natives.”

This proposal would, we believe, have secured a majority of votes, but evidently did not command the unanimity necessary for a revision of the Convention.

After a prolonged discussion lasting over several days, we recurred to our original proposal as amended in the following shape:

La Délégation Anglaise propose le maintien intégral de l'Article VI de la Convention, ainsi que du numéro 4 du protocole de clôture, en ajoutant à celui-ci la disposition suivante:

“Pourront être refusées au dépôt dans chacun des États contractants:

“1. Les marques consistant exclusivement dans le nom ou les noms soit d'une personne, soit d'une Société, à moins que ces noms ne soient présentés au dépôt sous une forme distinctive, ou qu'ils ne consistent dans la signature en original ou en fac-similé soit de la personne, soit de la Société qui opère le dépôt; cette disposition ne porte aucune atteinte à l'Article VIII de la Convention.

“2. Les marques qui se composent soit d'une désignation nécessaire pour l'indication de l'espèce ou de la qualité des produits, soit de noms géographiques, à moins que dans la demande le déposant ne déclare qu'il ne prétend à aucun droit exclusif à l'usage de ces désignations ou noms isolés, et sans préjudice de la protection due aux indications de provenance.

“Les dénominations n'indiquant pas la provenance, ainsi que les dénominations de fantaisie dans les deux cas qui précèdent (1 et 2) continueront à être protégées.

“3. Les marques qui comprennent des armoiries publiques et des décorations sans autorisation des pouvoirs compétents.”

The English Delegation proposes to maintain in its integrity Article VI of the Convention, as well as No. 4 of the final protocol, with the addition of the following provision:

“It shall be permissible to each of the contracting States to refuse deposit in the following cases:

“1. Marks consisting exclusively of the name or names either of a person or of a company, unless these names be presented for deposit in a distinctive shape, or consist of the signature in original or in facsimile either of the person or of the company which makes the deposit; this provision does not in any way infringe Article VIII of the Convention.

“2. Marks consisting either of a designation necessary for the indication of the nature or quality of products or of geographical names, unless the depositor in his application makes a declaration to the effect that he lays no claim to any exclusive right to the use of these designations or names by themselves, and without prejudice to the protection to which indications of origin are entitled.

“Denominations which do not indicate origin, as well as invented names in the two preceding cases (1 and 2), shall continue to be protected.

“3. Marks which include public arms or decorations without sanction from the proper authorities.”

It is probable that this would have been sufficient to meet the existing English law, but the form is complicated owing to the necessity of making compromises to meet the views insisted on by various Delegates, and we should not recommend that this form should be adopted as the best in case the matter should be hereafter reopened by Her Majesty's Government.

The proposition in question was put to the vote with the following result: Ayes, 9; noes, 5; abstention, 1.

Germany and Austria supported our proposal, but not being yet members of the Union had no votes.

AYES.	NOES.	ABSTAINING.	SUPPORTING WITHOUT VOTE.
Holland.	France.	Belgium.	Germany.
Switzerland.	Tunis.		Austria.
Norway.	United States.		
Sweden.	Italy.		
Denmark.	Portugal.		
Spain.			
Brazil.			
Servia.			
Great Britain.			

The practical result, therefore, was 11 to 4 in favor of our proposal. There is some reason to believe that the United States Delegate might have reconsidered his vote if the question had been reopened, and that possibly Italy might have given way if eventually unanimity had been secured.

The chief and, indeed, the only serious opponents to the principle of our proposals for an alteration of Article VI were the French Delegates, who rejected every suggestion put forward by us on this point, and who were firm in maintaining the existing text intact. We could not move them from this position, even by pointing out that the logical consequence of their attitude was that if, say, in a South American State, where the French or English language was not spoken, anyone succeeded in obtaining the registration of the words "Bordeaux," "Burgundy," or "Champagne" as trade-marks, Great Britain might be compelled, on a strict interpretation of Article VI and paragraph 4 of the Final Protocol, to register these words as trade-marks in the form originally registered, and that the exclusive use of those words would then be vested in the person so registering them, as against even wine growers in those very districts seeking to sell their wares in Great Britain.

It became clear in the course of the discussions that the practice of many States of the Union is identical with our own in this particular, though the reasons given may be different, and we consider that the decisive majority obtained on our proposal is a sufficient argument in favor of the maintenance of the existing practice of the English Courts.

The result of the vote being a failure to obtain unanimity, it was evident that Article VI of the Convention could not at present be amended, and as we did not think it desirable to make any further efforts at conciliation the question was reserved for ulterior consideration.

#### (d) FALSE INDICATIONS OF ORIGIN.

Some proposals for the amendment of the Arrangement of Madrid of the 14th April, 1891, which had been made by the International



Bureau and by the Spanish Government, were eventually dropped, after a long discussion. It was difficult to understand the exact position assumed by the Spanish, Portuguese, and French Delegates on the question whether the effects of the Arrangement of Madrid can be applied to goods and subjects of countries of the Union who have not adhered to that Arrangement. We did not think it desirable to enter into the discussion further than to explain the existing English law and practice on the point as enabling Her Majesty's Government to seize any goods, whencesoever arriving, which bear false indications of origin. We further maintained the right of Great Britain to enter into arrangements with any State of the Union by which each Contracting State should bind itself to seize all goods bearing false indications of origin.

In regard to the question of what constitutes a false indication of origin as applied to wines, we made the following declaration:

La Grande-Bretagne par sa législation actuelle donne effet pleinement et entièrement à l'Arrangement de Madrid tel qu'il existe, et la loi Municipale Anglaise ne porte aucune atteinte à cet arrangement.

Selon les Règlements de Douane en Angleterre on peut admettre en franchise des produits quelconques qui portent en caractères manifestes et apparentes une indication de provenance qui n'est pas fausse; par exemple, "Cape port," "Swiss champagne," car il est évident que dans ce cas là l'indication d'origine consiste dans la mention précise de la localité d'où viennent en vérité ces produits.

Great Britain by existing law gives complete effect to the Arrangement of Madrid in its present form, and the English Municipal law derogates in no respect from that Arrangement.

Under the Customs regulations in England any goods may be admitted to entry which bear, in clear and legible characters, an indication of origin which is not false; for example, "Cape port," "Swiss champagne," for it is evident that in such cases the indication of origin consists in the precise mention of the locality from which the goods come.

The question of false indications of origin having been disposed of by the withdrawal of all the proposed amendments, the Arrangement of Madrid remains untouched.

Toward the close of the Conference, it was found that unanimity was impossible on the three points (a), (b), and (c), above indicated, but unanimity had already been arrived at on several other proposed amendments of the Convention of 1883.

The President therefore proposed that these three points should be reserved for an attempt to come to some understanding by means of diplomatic correspondence to be initiated by Belgium, and that if an accord should be established in principle by that means, these points should be again treated at an adjourned meeting of the present Conference.

One other point would also be reserved for consideration at such an adjourned meeting, viz, the following additional article to the Convention suggested by France:

The subjects or citizens of States parties to the Convention (Articles II and III) shall enjoy, in all the States of the Union, the protection accorded to nationals against dishonest competition (concurrence déloyale).

This suggestion was received with favor by the Conference, but unanimity could not be obtained, as four Delegates, being without instructions on the point, reserved their votes.

The addition of such an Article would be of especial advantage to Great Britain in furtherance of the interests of honest trade.



The Conference ended in the signature by all the Delegates of the inclosed Final Protocol, containing proposed amendments to the Convention of 1883, which the Delegates submit for the consideration of their respective Governments.

The following observations may be made respecting the various Articles contained therein:

*Amendment to Article III.*—The words “effectifs et sérieux” are added to the original text for the purpose of ruling out establishments of a fictitious character.

*Amendment to Article IV.*—The only respect in which this Article has been altered is by striking out of the fourth line of the second paragraph the words “par un tiers” after the word “exploitation.” It had been suggested that these words might be taken to imply that the working of the patent by the applicant himself during the period of priority would invalidate subsequent registration under the Convention. The omission of the words will not necessitate any alteration in the English law; and if it has any effect on foreign patent laws, the alteration will benefit the British patentee, as it will enable him to work his patent during the period of priority without any fear of forfeiting his right to registration in any other State of the Union.

*Proposed additional Article IV bis.*—This is a new Article. Its effect will be that patents for the same invention taken out in different States of the Union will be independent of one another, and of similar patents granted outside the Union. At present, all patents taken out in England are independent of patents for the same invention taken out in foreign countries, and the new Article therefore involves no alteration in the English law. But hitherto every patent which has been granted in the United States for an invention previously patented in any foreign country has been limited so as to expire at the same time with the foreign patent. As the ordinary life of a patent is 17 years in the United States and 14 years only in the United Kingdom, when a patent has been granted in the United States for an invention previously patented in the United Kingdom, its life has been limited to 14 years from the date of application for the patent in Great Britain. This will no longer be the case, as the American law will be assimilated to the English law in this respect as from the 1st of January next.

The ordinary life of a British patent is shorter than that of a patent in any other State in the Union and, consequently, the alteration is in favor of British patentees.

The last two paragraphs of Article IV *bis* apply the Article to patents now in existence and to patents in existence in any State at the time of its accession to the Union, but the Delegate of the United States made a declaration at the final stage of the proceedings that his country could not bring in the legislation which would be necessary to carry the second paragraph of this new Article into effect, so far as the United States were concerned.

*Addition to Article IX.*—This is proposed in order to provide in this Article the alternative of prohibition which already exists in the Arrangement of Madrid relative to false indications of origin. It will probably strengthen the hands of some States who are not at present able to take effective action by means of seizure in accordance with Article IX as it stands at present.

*Addition to Article X* defines an “interested party” in a manner which seems sufficient to meet the requirements of British Trade.

*Amendment to Article XI* speaks for itself, and seems to be unobjectionable.

*Amendment to Article XIV* merely omits an unnecessary reference to the former meeting at Rome.

*Amendment to Article XVI* defines the procedure in regard to accessions to the Union in a more convenient mode than that in the existing Convention.

None of these amendments appears to give rise to any objection, or to require fresh legislation in the United Kingdom, and we venture to recommend the first Final Protocol for signature on behalf of Her Majesty's Government within the prescribed period of six months.

The second Final Protocol relates to the Madrid Arrangement for the international registration of marks, to which Great Britain is not a party. We did not, therefore, sign it, and it calls for no observation on our part.

At the end of the sittings, the United States Minister gave an invitation for the next meeting of the Union to be held at Washington, at a date to be hereafter fixed. This proposal met with general assent. We reserved the expression of the opinion of Her Majesty's Government, as we had received no instructions on the subject.

As a summary of the above Report, we may state that if the positive results of the Conference are not great, the thorough discussion to which the disputed points have been subjected may possibly clear the ground for the establishment of a general accord.

It is evident that the German Government will not join the Union unless satisfaction is given to them on two points, viz:

(1) Agreement to three years as the minimum period for the forfeiture of patents for nonworking; and

(2) The extension of the period of priority for patents from six to twelve months.

Great Britain could grant the former of these concessions without fresh legislation. Not so, however, as regards the latter.

It will be for Her Majesty's Government to consider whether, if an Agreement can be reached between Great Britain and France and the other contracting States as to Article VI, relative to the registration of a trade-mark "*telle quelle*," it is desirable or not to undertake the legislation which would be required to give effect to an extension of the period of priority for patents from six to twelve months. If this could be done, every obstacle, so far as Great Britain is concerned, would apparently be removed to the adhesion of Germany to the Union.

When the *procès-verbaux* of the conference are printed in a complete shape we shall have the honor to send copies for the use of the Board of Trade.

As regards the Final Protocol, which we have signed, we venture to express the opinion that it contains some useful amendments to the Convention of 1883, and that none of its stipulations are open to objection as regards British interests. If it be accepted by Her Majesty's Government, it will be necessary at the time of its signature by Her Majesty's minister at Brussels to make a declaration as to the extent of its application to British colonies, of which two, viz, Queensland and New Zealand, are already parties to the Union.

In concluding this dispatch, we desire to record our grateful appreciation of the support afforded to us by Her Majesty's minister, the



Hon. Sir F. Plunkett, who was always ready and able, by his influence and high position, to help us in any difficulty.

We venture also to suggest that the thanks of Her Majesty's Government are due to Mr. Herbert Hughes for his services as Technical Adviser to the British Delegates. The suggestion originally made by him for an amendment of Article VI of the Convention formed the basis of the proposals made by us to the Conference on this difficult point; and his legal knowledge and general counsel proved invaluable during the course of the proceedings.

We have also to express our thanks to Mr. Charles Somers-Cocks for his efficient services as Secretary to the British delegates.

We have, etc.,

CHARLES B. STUART WORTLEY.

H. G. BERGNE.

C. N. DALTON.

[Inclosure 1—Translation.]

*Paper presented by the British delegation to the conference.*

The application of Article VI and of No. 4 of the Final Protocol has given rise in England to rather serious difficulties. The Conference may be reminded that the true principle of the Union established in Article II of the Convention consists in this, that subjects of each of the contracting States are entitled to enjoy in the other States the same advantages as, and not superior advantages to, nationals.

Article VI in its present form and the interpreting Protocol appear to authorize the foreign depositor to claim protection for a mark for which registration would not be accorded to a national, because the local law does not allow of such a mark being considered as entitled to registration.

The Government of Her Britannic Majesty hesitate to give their assent to a provision in virtue of which a stranger might claim in England advantages superior to those enjoyed by nationals, and it seems difficult to them to make the stipulations of Article II tally with those of Article VI and of No. 4 of the Final Protocol. The British delegates beg the Conference to give due weight to this difficulty.

The Convention, taken as a whole, appears to aim at securing a right of priority for obtaining registration rather than an absolute right to such registration, and at laying down that the depositor ought to submit to local law in every country where he claims registration.

An instance may be quoted which will prove to the Conference the danger of allowing the registration of marks without any restriction; if, for instance, some one succeeded in getting the words "Pig iron" registered as a trade-mark in one of the Contracting States, would all the States of the Union be bound to grant protection to these words, even England and the United States, where no other term exists for designating the substance?

It can, moreover, be affirmed that the principle of the British proposal should be admitted by all the States as resulting from international law.

It would be contrary to the true interests of all Unionists to grant to an individual the exclusive right of using terms bearing on the nature or quality of goods, geographical name, or names of individuals or societies. Such words or names should always remain public property; no one can wish a monopoly in them to be granted to a private person.

Difficulties have already arisen in regard to this matter in England, and the Government of Her Britannic Majesty considers the moment to have come when the real bearing of the provisions on this point should be defined.

Acting on this theory, the British Delegates venture to submit to the favorable consideration of the Conference their proposal, which aims at inserting in the Convention a series of exceptions to the principle which appears to be involved in the present text of Article VI and of No. 4 of the Final Protocol. This proposal keeps in view the amendments proposed by the International Bureau and by the Administration of the Netherlands. Should it be accepted, No. 4 of the Final Protocol would cease to be of use and be suppressed.

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## CHAPTER VII.

### RESOLUTIONS ADOPTED BY THE PATENT CONGRESS HELD AT THE VIENNA EXPOSITION OF 1873.

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The following resolutions were adopted at the patent congress held at Vienna in 1873 in connection with the Vienna exposition:

I. The protection of inventions should be guaranteed by the laws of all civilized nations, because—

(a) The sense of right among civilized nations demands the legal protection of intellectual work.

(b) This protection affords, under the condition of a complete specification and publication of the invention, the only practical and effective means of introducing new technical methods without loss of time and in a reliable manner to the general knowledge of the public.

(c) The protection of invention renders the labor of the inventor remunerative, and induces thereby competent men to devote time and means to the introduction and practical application of new and useful technical methods and improvements and attracts capital from abroad which, in the absence of patent protection, will find means of secure investment elsewhere.

(d) By the obligatory complete publication of the patented invention the great sacrifice of time and of money which the technical application would otherwise impose upon the industry of all countries will be considerably lessened.

(e) By the protection of invention secrecy of manufacture, which is one of the greatest enemies of industrial progress, will lose its chief support.

(f) Great injury will be inflicted upon countries which have no rational patent laws by the native inventive talent emigrating to more congenial countries where their labor is legally protected.

(g) Experience shows that the holder of a patent will make the most effectual exertions for a speedy introduction of his invention.

II. An effective and useful patent law should be based on the following principles:

(a) Only the inventor himself, or his legal representative, should be entitled to a patent.

(b) A patent should not be refused to a foreigner.

(c) It is advisable, in carrying out these principles, to introduce a system of preliminary examination.

(d) A patent should be granted either for a term of fifteen years or be permitted to be extended to such a term.

(e) Simultaneously with the issue of a patent a complete publication of the same should take place, rendering the technical application of the invention possible.

(f) The expense of obtaining a patent should be moderate, but in the interest of the inventor progressive scale of fees should be established, enabling him to abandon, when convenient, a useless patent.

(g) Facilities should be given by a well-organized patent office to obtain in an easy manner the specification of a patent, as well as to ascertain what patents are still in force.

(h) It is advisable to establish legal rules, according to which the patentee should be induced, in cases in which the public interest may require it, to allow the use of his invention to all suitable applicants for an adequate compensation.

(i) The nonapplication of an invention in one country shall not involve the forfeiture of the patent if the patented invention has been carried into practice at all, and if it has been rendered possible for the inhabitants of such country to purchase and make use of the invention.

(k) In all other respects, and particularly as regards the proceedings in the granting of patents, the congress refers to the English, American, and Belgian patent laws, and to the draft of a patent law prepared for Germany by the society of German engineers.

III. Considering the great differences in present patent administration and the altered international commercial relations, the necessity of reform is evident; and it is of pressing moment that Governments should endeavor to bring about an international understanding upon patent protection as soon as possible.

IV. The congress empowers the preparatory committee to continue the work commenced by this first international congress, and to use all their influence that the principles adopted be made known as widely as possible and carried into practice.

V. The committee is likewise authorized to endeavor to bring about an exchange of opinions on the subject, and to call from time to time meetings and conferences of the friends of patent protection.

VI. To this end the preparatory committee is hereby appointed to act as a permanent executive committee, with power to add other members to their number, and to appoint the time and place for the next meeting of the congress, in case such a meeting should be considered necessary for the promotion of the foregoing resolutions.

#### COMMENTS BY MR. GREELEY ON THE ABOVE RESOLUTIONS.

A comparison of the statement of the essential principles of an effective and useful patent law contained in these resolutions with the United States laws relating to patents will indicate the extent to which the members of this congress had been impressed with the advantages of our system.

*(a) Only the inventor himself or his legal representatives should be entitled to a patent.*

This is characteristic of the United States law. In certain European countries, prior to 1873 and for some years thereafter, the right to a patent was not recognized as the distinctive right of the inventor. In some countries to-day anyone who secures a knowledge of an invention may secure a patent, if he is the first to apply, and may thereby obtain an exclusive right to the invention as against the inventor himself.

*(b) A patent should not be refused to a foreigner.*

Since 1832 the United States has by law recognized the right of a foreign inventor to a patent for his invention, and though by that law the foreign inventor was discriminated against in the matter of fees, a British subject being required to pay \$500 and all other foreigners \$300 for a patent, instead of the \$30 then required of citizens or residents of the United States, this discrimination was done away with by the law of 1861. Since that date the foreign inventor has been accorded the same rights as the citizen of the United States, except only that in determining the question of priority no proof of inventive acts done in any foreign country has been accepted. In many foreign countries prior to very recent years the discrimination against inventors not domiciled in the country amounted to the prohibition of the grant of a patent. In others the conditions under which an inventor not domiciled in the country could take out a patent were so onerous as to practically amount to prohibition. In practically all foreign countries a citizen of the United States may now obtain a patent for his invention on substantially the same conditions which apply in case of inventors domiciled in the country.

*(c) It is advisable, in carrying out these principles, to carry out a system of preliminary examination.*

Preliminary examination as to novelty has always been a feature of the United States law. In 1873 no European country had adopted such a system. A system of preliminary examination has since been adopted by Germany (law of July 1, 1877), by Sweden (law of May 16, 1884), by Norway (law of June 16, 1885), by Japan (law of 1888), by



Denmark (law of April 13, 1894), and Austria (law of January 11, 1897). Canada also has adopted such a system and in Russia and in Switzerland preliminary examination to a certain extent is made.

*(d) A patent should be granted either for a term of fifteen years, or be permitted to be extended to such a term.*

Prior to 1870 the term for which a patent was granted in the United States was fourteen years, with the possibility of extension for seven years additional. Since 1870 the term has been seventeen years. In some of the European countries, prior to 1873 the term was as short as five years, and in comparatively few countries was the term longer than ten years. The term is now in practically all of those countries fifteen years or longer. In Great Britain the term is fourteen years.

*(e) Simultaneously with the issue of a patent a complete publication of the same should take place, rendering the technical application of the invention possible.*

By the law of 1861 the Commissioner of Patents was authorized to print copies of patents issued. Prior to that date in very few countries were patents printed and copies readily obtainable. The practice of printing patents as issued is now very general in the more important foreign countries, though in some only an abstract is printed, and in others, patents may on certain conditions be held secret, only the title being published.

*(f) The expense of obtaining a patent should be moderate; but, in the interest of the inventor, progressive scale of fees should be established, enabling him to abandon, when convenient, a useless patent.*

The fees for obtaining a United States patent have since 1861 been fixed at \$35. In most of the European countries annual taxes increasing in amount are required to be paid on penalty of forfeiture of the patent. In some of these countries the total amount of fees necessary to be paid to keep a patent in force throughout a term of fifteen years is from \$800 to \$1,600.

*(g) Facilities should be given, by a well-organized patent office, to obtain in an easy manner the specification of a patent, as well as to ascertain what patents are still in force.*

Through the publication of patents immediately on their issue in the United States these facilities are given. In some of the European countries, as above stated under (e), patents could be kept secret, and in few countries up to 1873 or later were there adequate facilities for obtaining information as to patents granted.

*(h) It is advisable to establish legal rules, according to which the patentee should be induced, in cases in which the public interest may require it, to allow the use of his invention to all suitable applicants for an adequate compensation.*

This principle has never been adopted by the United States. It was and is carried out in the patent systems of a number of the European countries. It is by no means certain that it is not a wise principle.

*(i) The nonapplication of an invention in one country shall not involve the forfeiture of the patent, if the patented invention has been carried into practice at all, and if it has been rendered possible for the inhabitants of such country to purchase and make use of the invention.*

The forfeiture of a patent previously granted in a foreign country for failure to carry it into practice in that country or in the United States has never been held to work a forfeiture of the patent granted here. Up to 1897, the term for which such foreign patent was granted,



if less than seventeen years, determined the term of the patent granted here. The law of March 3, 1897, did away with this limitation. The wisdom of this principle is now recognized by many of the European countries.

By Mr. FORBES. Attention is called to Articles III to VI, which for the first time proposed a common agreement of Governments on the subject of patent protection, and which, through the congress held at the Paris Exposition of 1878, led up to the Convention of Paris of March 20, 1883.

## CHAPTER VIII.

### CORRESPONDENCE AND REPORTS RELATING TO THE CONFERENCES OF 1880, 1883, 1886, AND 1890.

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#### SECTION 1.

#### CORRESPONDENCE RELATING TO THE INTERNATIONAL CONFERENCE AT PARIS IN 1880.

*Mr. Evarts to Mr. Noyes.*

DEPARTMENT OF STATE,  
*Washington, October 30, 1880.*

SIR: I sent you a telegram to-day in answer to yours of yesterday, and acquainted you with the designation of yourself and Mr. Putnam as delegates of the United States to take part in the conferences and discussions of the International Industrial Property Congress, which is to be held in Paris, commencing on the 4th proximo. It now becomes necessary to supplement that telegram with brief instructions for your guidance in the matter.

The aims had in view in summoning this congress are explained very clearly and fully in the note which the French minister at this capital addressed to me on the 9th day of January last, and of which a copy is herewith transmitted to you. The subjects proposed for discussion are in a marked degree important to all countries whose trade and manufacturing industries have attained high development, and this country can not but feel the liveliest interest in any conclusions which may advance and benefit its commerce and manufactures. Nevertheless, as I replied to Mr. Outrey's note of January 9, the internal regulation of those matters by the legislation of this country is so much a matter for domestic consideration and control, especially with reference to the question of trade-marks and their Federal protection under existing treaties, that this Department can not agree to submit such questions to the proposed congress, so far as the share of the United States therein is concerned, without the reservation that the conclusions of the conference on the subject must be considered as absolutely subordinate to such legislative provisions as may hereafter be made by this country.

This reservation was made in full consonance with the proposal in Mr. Outrey's note, and particularly with its concluding clause, which looks upon the protocolized results of the contemplated congress as advisory merely, and referable to the several powers concerned, with a view to being subsequently completed, if approved by them, in the formal manner usual with international conventions.

It is believed that the familiarity of yourself and Mr. Putnam with the industrial interests of this country and the questions of law and legislation therewith connected, will obviate the necessity for any

detailed instructions on the points proposed for discussion. Much is, perforce, left to your discretion, and it is conceived that, even in advance of the receipt of this instruction, your own good judgment will have counseled the avoidance of any commitment of this Government to plans of reform which may not consult or comport with the entire legislative freedom, which, as the French Government is already aware, is reserved by us.

As you are a salaried officer of this Government, your participation in the congress is merely honorary and carries no special emoluments with it.

\* \* \* \* \*

As the congress is expected to open before this instruction reaches you, it is not deemed necessary to give you formal powers. The telegram sent to you to-day and the notification of your designation, which I have conveyed to Mr. Outrey, will doubtless serve as ample warrant for your participation in the congress.

I transmit for your information and as bearing upon the reservation herein expressed a copy of a recent important decision of the Supreme Court of the United States covering, in principle, the Federal protection of trade-marks under treaty stipulations.

Your report of the proceedings of the congress, with copies in duplicate, if possible, of the protocol of its sessions will be awaited with interest.

I am, etc.,

WM. M. EVARTS.

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*Mr. Outrey to Mr. Evarts.*

[Translation.]

LEGATION OF FRANCE IN THE UNITED STATES,  
*Washington, November 26, 1879.*

MR. SECRETARY OF STATE:

A number of importers of French goods doing business in the city of New York have just called my attention to the decision pronounced on the 17th instant by the Supreme Court of the United States on the subject of trade-marks, which they consider prejudicial to their interests. Not having as yet received an authentic copy of the decision referred to, it is impossible for me to determine to what extent it is at variance with the stipulations of the treaty of April 16, 1869. The question, however, seems to me to be one of such importance that I do not hesitate to transmit to you their original communication.

Be pleased to accept, etc.

MAX OUTREY.

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[Inclosure.]

*Messrs. Osborn, Son & Co. to Mr. Outrey.*

JOHN OSBORN, SON & Co.,  
*New York, November 24, 1879.*

SIR: The undersigned importers of merchandise from France desire to call the attention of your excellency to the decision of the Supreme Court of the United States,



filed on the 17th of November, 1879, in the cases of the *United States v. Witteman* and others, declaring unconstitutional the acts of Congress on the subject of trade-marks.

The opinion delivered contains this reservation: "The court wishes, however, to be understood as leaving the whole question of the treaty-making power of the General Government over trade-marks and the duty of Congress to pass any laws necessary to carry such treaties into effect untouched."

Relying upon the security offered by the treaty passed between France and the United States and by the laws passed to carry it into effect, the undersigned have gone to great trouble and expense for the purpose of protecting trade-marks of French citizens whose goods they import in large quantities. By the decision above referred to large interests are jeopardized and the time and expense devoted to their protection in the past go for naught.

A timely compliance by Congress with the suggestion made by the Supreme Court as to the protection of rights pledged to French citizens by the treaty of 1869 may avert great loss. Each day's delay is of importance. Until Congress takes action the owners of foreign brands and trade-marks are at the mercy of the criminals emboldened by the knowledge that the Federal courts have been stripped of the power of punishing them.

Under these circumstances we do not hesitate to call upon your excellency to use your influence for the protection of the French interests thus endangered and to pray your intervention with the Department of State, in order that the President of the United States may in his message to Congress, which meets on the first Monday of December, 1879, be induced to urge upon that body the immediate passage of a law to carry into effect the treaty with France.

In the confidence that this request will receive from your excellency that consideration which the importance of the subject demands and which the interests of French citizens have never failed to obtain from you, the undersigned beg to subscribe themselves,

Your humble and obedient servants,

John Osborn, Son & Co., 45 Beaver street; Cazade, Crooks & Reynaud, 26 South William street; E. La Montague, 53 Beaver street; Charles Graef, 65 Broad street; (an illegible signature); Fred De Bary & Co., 41 and 43 Warren street; (an illegible signature), 51 Warren street; Renaud, Francois & Co., 23 Beaver street; Edward Blackburn & Co., 10 Beaver street; Arguimbau, Wallis & Co., 29 South William street; Alfred Pacontot, 6 South William; Ives, Beecher & Co., 98 Front street; (an illegible signature), 35 Beaver street; John Duncan's Sons, 1 Union square; E. Hazard & Co., 193-198 Chambers street; H. K. & F. B. Thurber & Co., West Broadway, Reade and Hudson streets; Acker, Merrill & Condit, 130 and 132 Chambers street, Broadway and Forty-second street; C. Heerdt & Co., 93 Water street; J. H. Smith's Sons, 25 and 27 Peck slip; (an illegible signature), 12 Vesey street; (an illegible signature), 9 Whitehall street; Henry G. Schmidt & Co., 38 Beaver street; (an illegible signature), Jos. Riffard's Sons; Park & Tilford.

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*Mr. Outrey to Mr. Evarts.*

[Translation.]

LEGATION OF FRANCE IN THE UNITED STATES,  
*Washington, January 9, 1880.*

MR. SECRETARY OF STATE:

You are aware that a congress met at Paris during the universal exposition of 1878 for the purpose of considering questions relating to industrial property. The Government of the United States was represented by three delegates at this congress, which was under the honorary presidency of the minister of agriculture and commerce. Its special object was the examination of questions having reference to patents, designs, industrial models, and trade-marks.

Before adjourning the congress appointed a permanent commission, the members of which were divided into national sections, and which

was charged with the execution of the resolutions which had been adopted, and especially with bringing about the meeting of an international conference having for its mission the adoption of the measures necessary to secure as far as possible the unification of the different systems of legislation relative to industrial property.

This permanent commission, of which the delegates of the foreign governments represented at the congress were members, prepared a draft of a treaty to be concluded by the different adhering powers, the object of said treaty being to form of the contracting countries a "union for the protection of industrial property," and to fix the general principles which should, by common consent, be rendered uniformly applicable to the matter.

This draft of a treaty was transmitted by the executive committee to the minister of agriculture and commerce, with a request that he would take the necessary steps to induce the Government of the Republic to take the initiative in bringing about the assembling of an international conference to carry out the work undertaken by the congress. Mr. Teisserenc de Bort thought that it was proper to submit at first to the deliberations of an international conference only drafts of resolutions rather of an executive (administratif) than of a legislative character, easy of application, and whose adoption would not require serious modifications of the laws, which are based in various countries on different principles. He consequently requested the French section, acting as an executive committee and representing the commission of the congress, to extract from the draft of the treaty to be recommended to the governments for their adhesion those provisions which seemed to it to enter more particularly into this order of ideas. That section performed the task intrusted to it, and the result of its special work was transmitted to the minister of agriculture and commerce, who, appreciating the importance of the resolutions adopted by the congress, at once recognized that they were in all respects worthy of the solicited attention of the French Government.

His excellency the minister of foreign affairs instructs me to transmit to you a volume containing the reports of the sessions of the congress, together with a pamphlet relative to the plan presented by the executive committee, and to commend them to your most serious attention.

As you will observe, the commission has divided its work into five parts. The first comprises those questions which are common to all branches of industrial property; the second is devoted to patents; the third to industrial designs and models; the fourth to trade-marks; and the fifth to the commercial name. It has, moreover, taken care to distinguish in each one of these parts the provisions which it has thought could be immediately inserted in an international convention from those which, as they involve the modification of the laws of each country, must for the present be considered only in the light of recommendations to the various governments.

The minister of foreign affairs instructs me, in addressing this communication to you, to beg you to inform me whether the Government of the United States is disposed to send special delegates to an international conference having for its object the examination and discussion of the conclusions of the commission. He expresses the hope that the Government of the United States, sharing the views of the congress and feeling convinced, as we are, of the high importance of the



questions which have reference to industrial property, will receive these overtures with favor.

In case the labors of the conference should result in the adoption of a number of provisions suitable for incorporation in an international convention, the draft prepared by the special delegates might subsequently be invested with the signatures of the representatives of all the adhering governments, being clothed with the necessary powers for that purpose.

My Government would be glad to be informed, with as little delay as possible, of your intentions in this matter.

Be pleased to accept, etc.,

MAX OUTREY.

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*Mr. Evarts to Mr. Outrey.*

DEPARTMENT OF STATE,  
Washington, March 19, 1880.

SIR: I have the honor to acknowledge the receipt of your note of the 9th of January last, referring to the proceedings of the congress which was held at Paris during the Universal Exposition of 1878 for the purpose of considering questions relating to industrial property, and stating that the permanent commission appointed by that congress has requested the Government of France to take the initiative in bringing about the assembling of an international conference to carry out the work undertaken by the congress above mentioned; and accordingly, as instructed by the minister of foreign affairs of France, you inquire whether the Government of the United States is disposed to send special delegates to an international conference having for its object the examination and discussion of the conclusions of the commission.

Your note, moreover, states that the permanent commission above mentioned has prepared a draft of a treaty to be concluded by the different adhering powers, the object of the proposed treaty being to form, of the contracting countries, a "union for the protection of industrial property." You furthermore refer to the fact that it is proposed for the present to limit the international agreement in question to the making of such regulations as would not require serious modifications of the laws which are based in various countries on different principles, the proposed regulations being embodied in a report which has been made to the French Government, a printed copy of which accompanies your note.

I observe, as you state in your note, that the subjects to be presented for the consideration of the proposed conference are five in number, viz:

- (1) Questions common to all branches of industrial property.
- (2) Patents.
- (3) Industrial designs and models.
- (4) Trade-marks.
- (5) The commercial name.

In reply to your note, I must, in the first place, observe that the condition of the legislation of this country with regard to trade-marks is such at this time that this Department can not agree to submit that matter to the proposed conference without the reservation



that the conclusions of the conference on the subject must be considered as absolutely subordinate to such legislative provisions as may hereafter be made by this country in relation to trade-marks.

With this reservation just mentioned, this Government is willing to designate some suitable person as a special delegate to represent the United States in the proposed international conference.

Accept, etc.,

WM. M. EVARTS.

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*Mr. Outrey to Mr. Evarts.*

[Translation.]

LEGATION OF FRANCE IN THE UNITED STATES,  
*Profile House, August 10, 1880.*  
 (Received August 12.)

MR. SECRETARY OF STATE:

In the note which you did me the honor to write to me on the 19th of March last, in response to my communication of the 9th of January preceding, you were pleased to inform me that under a certain reserve the Government of the United States was disposed to accept the proposition for the meeting at Paris of the international conference to be charged with examining and discussing questions connected with the protection of industrial property. On the other hand, England, Austria-Hungary, Belgium, Italy, Russia, and Switzerland have likewise made known their assent to the project of the meeting and have announced their intention to be represented thereat.

The realization of the hope expressed by the international congress of 1878 being thus assured by these adhesions, the French Government has deemed that it is now proper to arrange for the meeting of the conference. In consequence the minister of foreign affairs charges me to invite the Government of the United States to take part in this meeting, the date of which is set for the 4th November next, and to ask it at the same time to be good enough to designate the delegates whom it may have chosen. In order to facilitate the labors of the conference it has been judged advisable to prepare a programme of the questions which would be the object of its deliberations. I have the honor to send you herewith four copies thereof.

It is, however, understood, as M. de Freycinet informs me in his communication, that the decisions of the conference can not in any manner be binding upon the powers which participate therein. The delegates will have no other mission than to study and discuss the questions which shall be submitted to them, and endeavor to come to an understanding, if it be possible, upon a scheme of rules of a nature to form part of an international convention, which would subsequently, if acceptable, be signed by the diplomatic representatives of all the adhering Governments.

I would be obliged to you, Mr. Secretary of State, to let me know if the date proposed for the meeting of the conference is acceptable to the Government of the United States.

Be pleased to accept, etc.,

MAX OUTREY.

*Programme of the principal questions to be submitted to the deliberations of the International Conference for the protection of industrial property.*

## GENERAL QUESTIONS.

1. The adhering governments have agreed to form a Union for the protection of industrial property.

2. The subjects of each one of the States of the Union shall enjoy in all the other States the same rights as the natives thereof, in the matter of patents of inventions, of designs and industrial models, of trade-marks, and any commercial use of firm names.

3. A special service of industrial property shall be established in each country; a central depot of patents of invention of designs and industrial models of trade-marks and commercial names shall be annexed thereto, and be accessible to the public. A periodical official journal shall be published for the service of industrial property. Measures shall be likewise taken for the publication of an international journal common to all the States of the union.

4. Temporary protection shall be given to patentable inventions, designs, and industrial models, as well as the marks of trade and commerce which shall be represented in international exhibitions either official or officially recognized.

## PATENTS OF INVENTIONS.

5. The act of filing an application for a patent regularly performed in one of the States of the Union shall carry with it the priority of registration in all the other States during a period of ———.

6. The introduction by patent in the countries where the patent has been issued of articles fabricated in any one of the States of the union shall not involve its annulment.

## DESIGNS AND INDUSTRIAL MODELS.

7. Designs or models deposited in any one of the States of the Union shall be guaranteed in all the other States, and the ownership shall be considered as legitimately acquired by those who make usage of it conformably to the legislation of the country of origin.

8. A deposit regularly made in one of the States of the Union shall carry with it the priority of registration in the other States during the term of ———.

## MARKS OF TRADE AND OF COMMERCE.

9. Trade-marks entered in one of the States of the union shall be guaranteed in all the other States, and property shall be considered as legitimately acquired by those who make usage of it conformably to the legislation of the country of origin.

10. Any registration regularly made in one of the States of the Union shall carry with it priority of registration in the other States during the term of ———.

11. All foreign products illicitly or unlawfully bearing the trade-mark of a manufacturer or of a merchant doing business in the country of importation, or any indication of being produced in the said country, shall be denied entry, be excluded from transit and public storage, and liable to be seized in any place whatever.

## COMMERCIAL FIRM NAMES.

The commercial name of a firm constitutes a property which should be protected without distinction of nationality and without obligation of registry.

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*Mr. Evarts to Mr. Outrey.*

DEPARTMENT OF STATE,  
Washington, October 30, 1880.

SIR: Referring to your note of the 9th of January last, acquainting me with the proposal of your Government to convene at Paris a congress to consider the international questions concerning industrial

property, and to your later note of August 10, announcing the opening of that congress on the 4th proximo, I have now the honor to inform you that, in acceptance of the invitation so tendered to this country to participate in the proposed congress, this Government has designated as its delegates thereat Mr. Edward F. Noyes, the envoy extraordinary and minister plenipotentiary of the United States near the Government of the French Republic, and Mr. James O. Putnam, the minister resident of the United States at the Court of Belgium, subject to the reserves in the matter of domestic legislation contained in my note to you of the 19th of March last.

I should be gratified if you could kindly inform your Government by cable of the appointment of these delegates.

Accept, etc.,

WM. M. EVARTS.

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## SECTION 2.

### REPORT OF DELEGATE FROM THE UNITED STATES TO THE CONFERENCE AT PARIS IN 1880.

LEGATION OF THE UNITED STATES,  
*Brussels, December 10, 1880.*

Hon. WILLIAM M. EVARTS,  
*Secretary of State.*

SIR: I have the honor to submit the following report of the proceedings of the International Congress for the Protection of Industrial Property, held at the city of Paris, November 4-20, which I attended as a delegate representing the United States.

The congress was organized on the 4th of November. All the leading European States were represented, except Germany, and several of the lesser powers.

Of the States beyond the sea the United States, Mexico, Argentine Republic, Brazil, Guatemala, Republic of Salvador, Uruguay, Venezuela, were represented. Among the delegates were several who, in their respective countries, are at the head of industrial departments and are familiar with every branch of the general subject.

The exhaustive discussions in the two preliminary congresses—that at Vienna in 1873, and in Paris in 1878—of the general principles underlying the questions which came before this congress narrowed the range of debate, and enabled the commission to proceed at once to the consideration of the specific points suggested.

The congress was opened by an address of welcome by Mr. Barthélemy St. Hilaire, the French minister of foreign affairs. He referred to the labors of the two previous congresses, which had led to the present commission, whose office it was to embody in a project of treaty relating to patents of invention, industrial designs and models, trade-marks and commercial names certain principles which all States could accept.

That what was hoped from the labors of the congress was greater security of private rights in industrial property.

Mr. Tirard, the French minister of agriculture, followed with a brief address of similar tenor. After a reference to the rapid advance in the communication of States and the progress of scientific discovery, he said that many enlightened and generous minded had felt that the



progress of civilization should be brought in harmony with the advance of science, and protection should everywhere be afforded to property, to inventions, against those who rob inventors of the just rewards of their genius, and that traders should be secured the exclusive possession of their trade-marks and commercial names.

The present commission, he stated, could not be expected to make a perfect plan for an international treaty. In view of the diversity of existing legislation that must be a work of time.

The legislation of States must be respected, but what is desirable is equal protection in all the States of the union with that granted their own citizens.

That the tendency of our time was to unify peoples by a community of interests, and nothing could contribute so much to this general movement of prosperity and pacification as universal and equal laws protective of industrial property.

These addresses were replied to in suitable terms by Minister Kern, the delegate from Switzerland. The congress then organized by the election of Senator Bozérian as president and Minister Jagerschmidt as secretary, both delegates from France. The president in a brief address presented the same general and broad views as had been expressed in the addresses of welcome. He said the congress had not to make a treaty, but a work preparatory; that it might require years to perfect an international system of laws, and if this congress should fail to perfect a satisfactory formula of a treaty a future congress might be necessary.

France had accepted from the congress of 1878 the office of preparing a project of treaty, which office had been discharged by Secretary Jagerschmidt. The "*Projet de loi*" prepared by him was accepted by the congress as the basis for discussion.

In answer to a preliminary inquiry by the president, France, Austria-Hungary, Belgium, Brazil, Italy, Portugal, Sweden and Norway, and Venezuela, through their delegates, expressed a desire that the congress should prepare a basis of an international treaty.

The delegates from Great Britain and the United States said that as yet they had not received the views of their Governments on that subject. Several delegates stated that, while their respective States had general sympathy with the objects of the congress, they took part in its deliberations with all reserves, leaving their States free to adopt or reject any treaty the congress might propose.

The president to these statements replied that the mission of the congress was to prepare a form of treaty to be submitted to the several States represented, for their free and independent action thereon; that such being the understanding, the congress could work freely for the common good.

A committee consisting of the delegates from France, England, Austria, Belgium, Italy, Portugal, and Switzerland was appointed to discuss and report upon all propositions requiring more full consideration than the congress as a body had time to give them.

The discussion of the "*projet*" as formulated was opened on the second day of the session, and it was well stated by the delegate from Italy that article 2 involved the principal idea which had led to the holding of the congress.

That idea was equal protection to the citizens or subjects of all the States of the union with that granted the citizens of their respective

States. It sought for purposes of industrial protection the unification of the treaty powers with the qualification that such foreigners should comply with the formalities and be subject to the conditions imposed upon the citizens by the internal legislation of the country. This principle was accepted. But by many of the delegates it was thought too narrow in its application, and a long debate arose upon the proposition to extend this protective feature to persons who were not citizens of either of the treaty States upon the ground that the natural rights of inventive genius were equal and no discrimination should be made against inventors for the want of citizenship.

The delegate from Italy stated that the civil code of that country granted patentees of every other country equal protection with its own citizens independent of reciprocity, and it would not favor a treaty less broad.

After protracted discussion both in committee and in congress, article 3 was adopted without a dissenting voice, by which it provided that the subjects of States not belonging to the union shall have the same rights as the citizens of the contracting States, provided they are residents or have their industrial or commercial establishments within the territory of one of the States of the union.

No act of the congress better illustrates the liberal spirit of its deliberations than this section.

The next question presented was whether a patentee in any one State of the union should have a priority of right of registration in every other State; and if so, for what length of time?

Such a concession would give to the inventor who should take out his patent in any one of the treaty States absolute protection against all rivalry during the specified period within the bounds of the union.

Great as is the advantage conferred on the diligent inventor by this provision, the congress accepted the principle with a reserve of all existing rights of third parties as a wholesome stimulus to invention and as just in itself. There was a prevailing sentiment in the congress that the inventor who increases the happiness or adds to the material wealth of nations should be recognized as the world's benefactor, and as such be protected and rewarded.

After full discussion, the time agreed upon within which an inventor, having been the first to take out a patent in one of the States of the union, might register it in either or all the other, to the exclusion of all other discoverers or registrants of the same principle or invention, was six months in European States.

In North and South American States, seven months. (Art. 4.)

As a further protection the Congress adopted a provision (art. 4, 2d par.) that a patent registered in any State of the union should not be invalidated by any other registration, by the publication of the invention, or by its working by a third party, or the exposure to sale of copies of the design or model within said six months of right of priority.

Article 4 of the original "*projet*" (being art. 5 as finally adopted) elicited much discussion. It provided that a patentee might import into a country where his patent was granted articles manufactured in other States of the union without forfeiture of his patent.

This involved a radical change of the legislation of some of the European States.

The present law of France forfeits a patent granted by it upon such importation.



The president of the congress, a delegate of France, pronounced such law "barbarous," and stated that it would be abolished.

The proposition was strenuously opposed by Switzerland upon the ground that a manufacturer, having received his patent from that country, which imposes light, if any, duty on importation, might establish his manufactory in France, where heavy duties on imported articles were imposed, and then import his articles into Switzerland and so introduce a serious competition with the industry of that country. Hungary and Belgium presented modifications of the provision.

A compromise was finally effected by adding the following qualification to the original provision:

Nevertheless the patentee shall be under obligation to work his patent (*d'exploiter son brevet*) conformably to the laws of the country into which he has introduced the objects patented. (Art. 5.)

This places the regulation of the working of the patent and the sale of the patented objects under the control of the State of the union into which the patentee deriving his patent from another State of the union has introduced his establishment or his patented objects.

It was adopted as a measure of defense of some of the free trade against the competition of the protection States, as illustrated by Minister Kern of Switzerland.

It was provided by article 11 of the proposed treaty that a temporary protection should be afforded to patented articles exhibited in the international expositions.

Trade-marks and commercial names occupied a large share of the attention of the congress, and the final agreement upon the articles relating to them was reached only after long discussion of details.

The principle of equality adopted as to the patents of invention obtains in relation to such marks and names, with the exception that the time of priority of right of registration of a trade-mark or commercial name after registering in the State of first issue is three instead of six months in European States and four months in the States of North and South America. (Arts. 2 and 4.) The same protection is secured temporarily in international expositions. (Art. 11.)

Articles 6, 7, 8, 9, and 10 refer only to trade-marks and commercial names.

Article 6 provides:

First. That any trade or commercial mark, duly registered in the country of origin, shall be admitted to registry and protected as such in every other country of the union. (This makes the law of the country of original registration applicable to it in all other States, and is the principle adopted in several international treaties.) (See p. 40 of Notes.)

Second. That the country where the registrant has his principal establishment shall be considered the country of origin.

Third. That if the principal establishment shall not be in one of the countries of the union the country of residence of the registrant shall be regarded the country of origin.

Fourth. Registration may be refused if the object for which it is asked be regarded contrary to morality and public order.

The last provision was deemed essential to protect States against the abuse of the privilege accorded.

Article 7 declares that the nature of the product bearing the mark or name shall not constitute an obstacle to its registration. It is sub-



ject to the condition in the last-named article which refers to the object of registration.

Article 8 provides that the commercial name shall be protected in all States of the union, without requirement of registration, whether or not it constitutes a part of a trade or commercial mark.

Article 9 is a modification of article 6 in the original "*projet*," and was adopted after protracted discussion both in the committee and in the congress.

Article 6 in the original "*projet*" provided that every article bearing unlawfully either the mark of trade or an established merchant in any country of the union, or an indication of the production of said country, shall be prohibited entering into the other contracting States, excluded from transit and bond, and followed by seizure, if there be occasion, through process of law.

Several States insisted upon a modification that would limit action against the articles specified in this section to the country into which they were imported.

Switzerland stated that she had spent millions of dollars to perfect her railway system, she was a great carrier for other States, and she could never consent to the stoppage of such goods in transitu; it would be an embargo on commerce. After protracted discussion article 9 received the assent of the entire congress.

It provides that such articles so unlawfully marked may be seized upon importation into any of the States of the union in which such mark or commercial name has a right to legal protection, such seizure to be made on request of the public minister or the party interested, and that in conformity with the internal legislation of each State.

This gives free transit to goods bearing false marks to the country into which they are imported, and there subjects them to seizure and the penalties of the law.

Article 10 declares that the provisions of article 9 shall be applicable to every article bearing falsely, as on indication of origin, the name of a specific locality, when that indication shall be united to a commercial name either fictitious or borrowed with a fraudulent intent. The term ("*emprunté*") "borrowed," is used for the usurpation of an existing commercial name.

It further provides that every manufacturer or trader engaged in the manufacturing or trading in such articles and established in the locality falsely indicated as the place of origin shall be regarded an interested party.

Article 11 provides that temporary protection shall be granted to patented inventions, designs, models, trade-marks, and commercial names of products exhibited at official international expositions or officially recognized.

The principal part of the labor of the congress was expended in arriving at the foregoing results.

After adoption of the articles enunciated relating to patents of invention, trade and commercial marks and names, the congress took up the subject of establishing a central international office for the information of the public in relation to patents of inventions, designs, models, and trade-marks.

Sections 12 and 13 of proposed treaty and paragraph 6 of the protocol are devoted to providing for the establishment of such a central depot, to be under the charge of the Swiss Government, already having

in charge the international offices relating to the postal and telegraph service, and for the publication of an official journal, all to be at an annual expense of not to exceed \$6,000, to be borne in equitable proportions by the treaty States, as provided.

Provision is made (art. 14) for periodical revisions of the treaty by conferences of delegates from the several States.

Article 15 of the treaty contains a very important provision. It declares that the contracting parties, respectively, reserve the right of entering separately into treaty or legislative arrangements with other States for the protection of industrial property, so far as such arrangements do not contravene the provisions of the treaty.

This seems to protect all existing international treaties and to give a large freedom for independent treaty relations.

Such was the object of the provision.

Article 16 provides that States which have not taken part in the congress may, on giving the required notice, come into the union with the same rights and relations in all respects as are granted to the treaty States.

Article 17 declares that the reciprocal engagements of the treaty are subordinated, whenever necessary, to the revision of the existing formalities and regulations under the laws of the high contracting parties, which is to be consummated with the shortest possible delay.

Article 18 provides that after adhesion of a State the treaty shall remain in force as to it an indefinite period, until the expiration of one year from the date on which notice of withdrawal shall be made.

A notice of withdrawal from the union is to be given to the Swiss Government, which is charged to receive, diplomatically, notice of adhesion.

The final article, 19, declares that the treaty shall be ratified, and the notifications exchanged in Paris within one year, or by November 20, 1881.

#### THE CLOSING PROTOCOL.

During the discussion upon article 2 of the proposed treaty, the delegate from Portugal proposed to broaden the application of the term "product" so as to include agricultural stock, etc.

The idea is embodied in paragraph 1 of the protocol, which declares that the words "industrial property" shall be understood in their broadest sense and should include agricultural as well as strictly industrial products—as wines, fruits, animals, grains, etc.

Paragraph 2 declares patents of importation and improvement as admitted by the legislation of the contracting States to be included under the name of patents of invention.

Paragraph 3 declares that the closing provision of article 2 of the treaty or convention shall not be construed as interfering with the legislation of the respective States in that which concerns the method of procedure before, or the competency of, its tribunals.

Paragraph 4 was adopted in behalf of the United States, and is in the following words:

The plenipotentiary of the United States of America having stated that by the terms of the Federal Constitution the right of legislation upon the subject of trade or business marks is to a certain extent reserved to the several States of the union, it is provided that the provisions of the treaty shall be applicable only within the constitutional powers of the high contracting parties.



I will here state all my action in this connection.

While article 2 of the "*projet*," or treaty, was under discussion, I proposed, after the words "shall enjoy," to add "within constitutional limitations," stating to the congress the peculiar relations of the Federal Government, which was of limited powers to the several States, and that owing to that feature the question of constitutionality of some legislation, especially relating to trade-marks, might be raised. The amendment was referred to the committee before which I presented the point more fully. The committee accepted the principle and recommended that it be embodied in the protocol.

A few days later I received my instructions from the State Department, advising that, in view of the domestic character of much of our legislation, especially that relating to trade-marks, and their Federal protection under existing treaties, the Government of the United States could not submit such questions to the convention without the reservation that its conclusions on those subjects be considered absolutely subordinated to the provisions of any future legislation of the country.

On the day I received the instructions I proposed, as an additional amendment, to add after the words "within constitutional limitations," the words "and upon the conditions that shall be imposed by the interior legislation of the country."

At the same time I addressed a note to the president, which he read to the congress, of which the following is a translation:

MR. PRESIDENT: I did not receive my instructions from my Government until this morning, and have had no opportunity to carefully examine them until since the meeting of the committee.

I am instructed to inform the congress that the United States can not agree to submit to the convention the question of trade-marks, and marks of commerce and their Federal protection under existing treaties without the reservation that the conclusions of the convention on those subjects be considered absolutely subordinate to such legislative provisions as may hereafter be made by the United States.

My amendment was referred to the standing committee which, while expressing a strong desire to meet the views of the United States so far as was compatible with the object of the congress, stated that it was impossible to grant the power to a member of the Union to pass laws in future which would contravene the objects of the treaty.

When it came back into the congress the same view was, with one or two individual exceptions, generally expressed.

I stated to the president that if it was the sense of the congress that my amendment was inadmissible, I wished my letter of the day preceding to form a part of the *procès verbal*, that the reservations insisted upon by the United States as the condition upon which it could accede to the convention might clearly appear on the records of the congress. To this there was general assent.

It does not appear in the *procès verbal* of the proceedings of November 17.

The sixth section of the protocol is devoted to settling the details of the international office for the protection of industrial property at Berne, Switzerland, and the publication of an official journal by it.

This international bureau was regarded of great consequence by most members of the commission; it seeks to centralize information and to bring to each of the treaty States knowledge of the progress in all its relations of industrial property.



It is in fact to be an international "patent office." Its expenses are limited to \$6,000 per annum, to be borne in equitable proportions as provided in the section.

The official language of said office is to be French.

The project of treaty and protocol were signed by all the members of the congress, but it was with the understanding that the signatures carried with them no obligation on the part of any State to accede to the convention.

They but certified the proceedings of the body.

The dispatch accompanying my instructions suggests that I give my own impressions on the general subject. I will say, first, that the peculiar relation of the Federal Government to the several States of the Union, and the consequent domestic character of much of our legislation, was appreciated by the congress, and individual members expressed to me a desire to so shape its action that the United States might be able to give its adhesion to the convention.

The congress readily adopted my amendment (paragraph 4 of protocol) relieving parties to the Union from requirements of the treaty which were not within their constitutional powers. This was a concession to the United States.

The reservations relating to the internal legislation of the several treaty States were made with the view of meeting some difficulties as marked in connection with our own legislation as in that of any other country.

The provision giving any State power to make separate treaties with other States was another important concession.

As to the great central idea of the convention, or treaty, the granting equal rights to inventors in all countries of the Union, and the exclusive right of registration in all the treaty States of patents of invention to the first registrant for a period of seven months to citizens of American and six months to citizens of European States, I have thought no country could derive so large advantage from the concession as the United States.

The inventive genius of our people in all the practical arts and industries is prominent.

Its fruits are as widespread as civilization. The rapidity with which our inventors give new and important inventions and improvements to the world is a marvel of the time. And in the very centers of European industries their works are in many branches superseding native inventions.

But I am advised that, owing to the want of adequate protection abroad, our inventors have not received the inventor's due reward. Should the United States see its way clear to give its adhesion to the convention, I think no country would be so largely benefited by its provisions.

A patent taken out by one of our citizens, if he be first in the field, gives him the command of Europe and America. He has seven months of priority of right in which to register his patent in every other of the treaty States, and the faith of every State in which he registers within that period is pledged to protect his rights.

It is true that it is a question of balancing losses and gains. An inventor in an European State has the same advantage accorded him if he be the first to secure a patent. In other words, it extends the principle of priority which now obtains in every individual State to all

countries within the treaty union, and so makes one great empire of industrial property. The just recognition of inventive genius ceases to be local, and the inventor, in character as such, becomes a citizen of the civilized world.

It is a recognition of the principle of equality of all men before the law in that which concerns the honors and rewards of inventive genius.

As a theory I think it sound.

It will be observed that the United States are expressly exempted from obligations to enact any laws or afford any protection to trade-marks or any branch of industrial property which are not within its constitutional powers. (Par. 4 of protocol.)

The judgment of the court in the cases decided at the October (1879) term of the United States Supreme Court (the *United States v. Steffens*, the *United States v. Witterman*, and the *United States v. Johnson* and others) appears, without so deciding, to recognize the power of Congress to regulate trade-marks with foreign States, and between different States of our own Union.

But should any legislation seeking so to regulate be unconstitutional, it is not required of our Government by the treaty stipulations.

Existing treaties between the United States and any other power and future treaties relating to industrial property are declared to be within the province of the Government to continue and to make. (Art. 15 of treaty.)

It will be further observed that adhesion to the treaty must be given by November 20, 1881, and that any State giving its adhesion may withdraw from the union on giving one year's notice to the Government of the Swiss Confederation.

From this brief review it will be seen that it is my own judgment that inventors of the United States and traders using marks and commercial names would find advantage in the protective features of the proposed treaty; that the unification of an international system securing protection and just reward to inventive genius would give a fresh stimulus to invention and be an element of pacification between the States so associated.

In submitting the foregoing report I have the honor, sir, to be,  
Very respectfully, your obedient servant,

JAMES O. PUTNAM,  
*Delegate from the United States.*

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### SECTION 3.

#### REPORT OF DELEGATE FROM THE UNITED STATES TO THE CONFERENCE HELD AT ROME IN 1886.

LEGATION OF THE UNITED STATES,  
*Rome, Italy, June 19, 1886.* (Received July 3.)

SIR: I have the honor to report that, in obedience to your telegraphic instruction of the 9th April, 1886, I have attended the International Convention for the Protection of Industrial Property, held in Rome from the 30th of April to the 11th of May, 1886. I have withheld my report up to the present time because I have just come into possession of the minutes of the conference, which had to be submitted to its several members before it was finally printed.

The conference was attended by representatives of Belgium, Brazil, Spain, France, Great Britain, Italy, Norway and Sweden, the Netherlands, Portugal, Servia, Switzerland, and Tunis.

These countries, with the exception of Great Britain, had become members of an International Union for the Protection of Industrial Property by virtue of articles of union agreed upon in Paris on March 20, 1883, Great Britain having acceded to this Union in 1884. The conference was also attended by representatives of the German Empire, Luxembourg, Mexico, Paraguay, Roumania, and Uruguay, and the United States of America, all of whom, like myself, appeared solely for the purpose of taking note of the proceedings of the conference and reporting to their respective Governments.

The articles of the Union adopted on the 20th of March, 1883, at Paris are set forth in the pamphlet which I herewith transmit. The objects of the Union are stated in the second of these articles, which provides that "the subjects or citizens of each of the contracting States shall enjoy in all the other States of the Union, in respect of patents, industrial models or designs, trade-marks, and commercial names, all the advantages which are actually conferred, or may be conferred hereafter, upon the subjects or citizens of any of these States by their respective laws, so that they shall have the same protection and the same legal recourse against all infringements of their rights (enjoyed by the subjects or citizens of any State) on condition of their compliance with the formalities imposed upon such subjects or citizens by the internal legislation of each State;" and in the third article, which provides that the same rights and privileges shall be extended to the subjects or citizens of States not members of the Union who have a domicile or industrial or commercial establishment on the territory of one of the States of the union.

Among the other noteworthy articles is article 5, providing "that as a condition precedent to the enjoyment of patent rights in any of the States of the Union, the owner of the patent must avail himself of it (*l'exploiter*) in conformity with the laws of the country into which the patented articles are introduced."

And also article 9, relating to the seizure of manufactured articles or articles of commerce bearing fraudulent trade-marks.

The present conference at Rome was held in compliance with article 14, which provided that the convention formed at Paris in 1883 should be subject to periodical revision, and that the next conference should be held in Rome.

Before the meeting of the conference a number of amendments to the original articles were submitted to the members by the representatives of Belgium, France, Great Britain, and Switzerland.

Several of these amendments were adopted by the conference, but only two of them appear to me to be worthy of note.

The first of them (an amendment to article 5) is in these words:

Each country is to determine for itself the sense of the term "*exploiter*."

During the course of the discussion it became evident that the object of the French representatives, by whom the amendment was proposed, was to limit the enjoyment of patent and trade-mark rights to those objects or articles actually manufactured in France, in conformity with the construction of the legal phrase "*exploiter*," as repeatedly given



by the French tribunals. It is not without significance that England voted with France for the adoption of this amendment.

Another noteworthy amendment is that to article 10, relating to the seizure of articles bearing fraudulent trade-marks, and especially the latter part of this amendment, which is to the effect that trade-marks shall not be considered fraudulent when it appears that they have been adopted with the consent of the manufacturer whose name is affixed to the manufactured product.

It is hardly necessary to say that both of these amendments were adopted in the interest of "home industries," so called, and, as was justly observed by Mr. Monzilli, who strongly protested against these amendments in the name of the Italian Government, were in derogation of the objects for which the union was formed.

I do not deem it necessary or proper to make any further comments upon the proceedings of the conference, but content myself with the observation that any State or country not yet a member of the union has the right to join it by simply notifying the Swiss Government, and through it the governments of all the other States, of its intention to do so, and that any of the States forming part of the union may withdraw from it upon a year's notice.

I announced to the conference at its first regular session, on April 30, 1886, that I attended it solely *ad referendum*, and that I signed the minutes upon the express declaration of the president that this signature imported nothing more than a certificate of their accuracy.

I have, etc.,

J. B. STALLO.

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#### SECTION 4.

#### REPORT OF DELEGATES FROM THE UNITED STATES TO THE CONFERENCE HELD AT MADRID IN 1890.

SIR: The undersigned, appointed by you in pursuance of an act of Congress approved March 6, 1890, to represent the United States in the conference of the International Union for the Protection of Industrial Property, held at Madrid, have the honor to submit the following report:

Mr. Palmer, who was designated by the act as president of the delegation, being already at his post in Madrid as United States minister to Spain, was joined by the other delegates March 30. The opening of the conference, fixed for April 1, was postponed until the following day, when a preparatory meeting was held, the conference provisionally organized, a series of rules adopted, and adjournment had until April 5. The first formal meeting was held April 7, presided over by the Marquis de la Vega de Armijo, minister of foreign affairs, assisted by the Duke of Veragua, minister of internal affairs (*fomento*), in which the delegates were welcomed on behalf of the Spanish Queen and Government, and officers elected. Mr. Moret y Prendergast, senior Spanish delegate, was chosen president, and Mr. Puccioni, senior Italian delegate, vice-president.

The following nations were represented in the conference: Belgium, Brazil, Spain, the United States, France, Great Britain, Guatemala, Italy, The Netherlands, Portugal, Norway, Sweden, Switzerland, and Tunis. Delegates were present from the International Bureau at

Berne, and Germany, though not one of the States constituting the International Union, was represented by a delegate not voting. At least eight of these States were represented by the heads of their patent offices. Each State belonging to the International Union was entitled to one vote.

Apart from the preliminary meetings, there were held nine regular sessions of the conference. A standing committee for the preparation of business also held its sessions during some part of each day. The final session of the conference was held April 14, at which the various propositions adopted were attested by the signatures of all the delegates.

On the invitation of the King of the Belgians, it was decided to hold the next conference (in 1893) in Brussels.

Four distinct propositions were adopted which the delegation have carefully translated and submit with the translations herewith. These are:

First. An arrangement concerning the repression of false indications of origin upon merchandise.

Second. An arrangement concerning the international registration of trade-marks.

Third. A protocol concerning the dotation of the international bureau.

Fourth. A protocol determining the interpretation and application of the convention of March 20, 1883.

The first project, concerning the repression of false indications of origin, though presented by the Spanish Government and the international bureau, was urgently pressed by the British delegates, being in fact the same as presented by them at Rome in 1886.

As presented, the first article of the proposition was as follows:

Every product bearing illegally a false indication of origin, in which one of the contracting States, or a place situated in one of them, shall be directly or indirectly mentioned as country or place of origin, may be seized on importation into any one of the said States. The seizure may also be effected in the State where the false indication shall have been applied, or in that which the product bearing the false indication shall have been introduced.

Out of deference to the United States this article was readily modified so as to recognize a refusal of entry as the alternative for seizure of the goods. But even with this amelioration the delegates of the United States regarded the proposition as unjust to both the manufacturer and the merchant, because limiting their dealings with one another, and proposed that after the clause "mentioned as country or place of origin" should be inserted the phrase "and by which a prejudice shall have been caused to the subjects or citizens of the said State or place." This would permit a merchant to mark his goods, of whatever origin, with his own name and place of business, using what the French call the commercial mark (*marque de commerce*).

Instead of adhering to the equitable rule that interference should follow injury, the conference added to the severity of the original article by omitting the word "illegally" from the first line, substituting "indicated" for "mentioned" before the words "as country or place of origin," and substituting "shall be" before "seized on importation."

On motion of the French delegates the third article was added, under which the merchant is entitled to put his name and address upon goods



imported; but this is required to be accompanied by the exact indication of the country or place of origin in plain characters.

The principal argument advanced by the British delegates in support of the proposition as a whole was the right of the artisans of a locality to protection in the reputation acquired by them in the manufacture of certain goods. The amendment offered by the United States delegates was not incompatible with this argument. They held that, so far as the protection of its own artisans is concerned, the question is one for domestic legislation in each State and not for conventions, and that it would be time enough to interpose for the protection of the artisans of other nations when an aggrieved party should come forward with his complaint.

The fourth article of this proposition was presented in the following form:

The courts of **each** country shall have power to decide what are the appellations which, by reason of their generic character, avoid the stipulations of the present arrangement.

On motion of Portugal, the following clause was added:

*Provided, however,* That regional appellations of origin of vineyard products are not included in the reservation fixed by this article.

The article as adopted, therefore, denies the protection of a court to a person against whom the allegation is made that he is using falsely a regional appellation upon wine and other products of the vine. It can be hardly admitted in this country that a person against whom such a charge is made shall be subject to the penalty of having his goods refused entry without having an opportunity to meet the accuser before a lawful tribunal and try the truth of the charge. In the opinion of the delegates, if there were no other reason why the United States should object to the proposed arrangement, the existence of this article in its present form makes it wholly unacceptable.

After the defeat of their amendment to the first article the United States delegates abstained from voting further upon this proposition. The Portuguese amendment was actually adopted by a vote of only six States against five adverse and three not voting. On the final vote upon the proposition as a whole it received seven votes—less than a majority of the States represented. Under these circumstances it can scarcely be regarded as embodying the sentiment of the conference.

The second proposition adopted by the conference provides a system for the international registration of trade marks. The United States delegates were prepared to assent to the general principle of such registration, but, as it had not been considered in their instructions and was in the form of a separate convention, they were not prepared to vote upon the proposition. It is apparent also that the adoption of the project by this country will involve considerable legislation to carry it into effect.

The project involves the establishment of a subordinate union of those States that see fit to accede to it; and, although its ratification is contemplated within a limited period, the way is left open for the subsequent adherence of States which for the present decline it. In the judgment of the delegation the United States should abstain from joining the projected union at the present time.

The third project relates to the dotation of the International Bureau for the Protection of Industrial Property at Berne.



As provided in the sixth paragraph of the final protocol annexed to the convention of March 20, 1883, the expenses of the bureau are supported in common by the contracting States, but, until further provided, can not exceed 30,000 francs per annum, of which the share of the United States is a little less than \$800. The Swiss Government has found the sum insufficient to enable it to organize and maintain the bureau in a suitable manner; and, while not proposing immediately to increase its expenses, has desired that the maximum allowance might be increased to 60,000 francs. In the form in which it was presented the proposition met with some objections, but all the delegations were agreed that the increased dotation was desirable. The effect of adoption of the project by the United States will be to make our maximum contributory share for the support of the bureau \$1,600. If the convention gives us any advantage at all, there can be, in the judgment of the delegation, no reasonable objection to this annual expenditure.

The fourth project is a protocol to determine the interpretation and application of some parts of the original convention. Its provisions will be briefly noticed.

*I. Assimilation of aliens.*—To provide against citizens of noncontracting States deriving advantage from the convention by virtue of establishing an insignificant business house or mere agency within one of the contracting States, it is determined that such advantage can only be claimed by a person who has his principal establishment in one of the States of the Union.

*II. Countries beyond the sea* are more distinctively defined relative to Europe.

*III. Reciprocal independence of patents.*—This paragraph provides that patents granted an inventor for the same invention in different countries shall be independent of one another. This is in harmony with the best sentiment in the United States on the subject and with bills pending before Congress, though not with the existing statute. (Sec. 4887, R. S.) The delegation found themselves authorized by their instructions to support it.

*IV. Interpretation of the word exploiter.*—Many Governments require the "working" of a patent to keep it from forfeiture, but there is a wide difference among them as to what shall constitute working. Particularly is the law of France on this subject very burdensome to the American patentee, since it demands that the article protected by patent shall be actually manufactured in France, and even makes importation of the article from abroad, except under certain very narrow conditions, a cause for forfeiture. These requirements actually render the French patent valueless to an alien in cases where an expensive plant is necessary to carry on the manufacture, and if similar requirements were made in all countries would wholly destroy the value of the Union. The American delegates felt themselves bound by their instructions (as well as by their own convictions) to oppose this proposition. They submitted a counter proposition to the effect that the patentee who works his invention in one country of the Union shall not be held to have forfeited his rights in another by reason of not working it there. This proposition, pronounced by a Belgian delegate to "approach the ideal in respect to industrial property," was, nevertheless, rejected, and the original proposition adopted by a vote of 8

to 5, Great Britain, Italy, Norway, and Sweden voting with the United States, and one not voting.

*V. Trade marks.*—This paragraph authorizes the protection of municipal and collective trade marks in the same way as those of individuals. There is no doubt of the equity of this provision, but its strict enforcement in the United States will require some modification of the existing law, and a new definition by the courts of the term trade mark, since as now interpreted here and in Great Britain it does not include the class of marks indicated. Apart from statutory provisions, the Federal and State courts recognize these marks as entitled to protection. It is believed that a bill now pending before the House of Representatives (H. R. 3812) will, if enacted, substantially provide for their registration.

The second clause of this paragraph asserts what is believed to be the established common law doctrine upon the subject to which it relates.

*VI. International expositions.*—This paragraph is intended to make more explicit the provisions of Article XI of the convention, for the temporary protection of unpatented inventions exhibited at international expositions. Such exhibition in most countries will vitiate a patent subsequently obtained. In this country it has no such effect, if patent is applied for within two years, and Article II allows a period of six months for that purpose in all the countries of the Union.

The new provisions prescribe more particularly the conditions of this privilege and make this period of temporary protection additional to the period of priority provided by Article IV of the convention. Some advantage is assured by these provisions to American citizens who desire to exhibit their inventions in international expositions before patenting them abroad. Certain formalities are to be complied with, as set forth in the fourth clause; and should this protocol be ratified this matter may be of immediate importance in view of the coming Chicago exposition.

Paragraphs VII, VIII, IX, X, and XI relate merely to matters of administration, and but for the inclusion of them in the protocol would not seem to demand ratification. No reason is seen why they should not be perfectly acceptable to all concerned. In some particulars they enhance the utility of the Union, since they provide means by which each State may be promptly informed of changes in legislation in any of the others in respect to industrial property,—sometimes a matter of great importance.

These four drafts of propositions, of which the eleven paragraphs of the protocol constitute one, are submitted to the several States forming the International Union for their acceptance. Should it seem advisable for the United States to accept any of the four, it is understood that such propositions should be signed by a plenipotentiary at Madrid, at a date not fixed, but within six months from April 4, 1890, after which they shall be subject to ratification within another six months at the latest.

Except the third proposition, for the dotation of the International Bureau at Berne, the delegation can not recommend for approval by their Government any of the propositions adopted by the conference. Many paragraphs of the fourth proposition are unobjectionable, but it can only be ratified as a whole. This delegation represented to the



conference the difficulty that might arise from this fact, and urged that each paragraph should be presented in a separate protocol, but the conference preferred to adopt it as a single instrument.

#### RESOLUTIONS ADOPTED BY THE CONFERENCE.

The conference found itself embarrassed by the presentation of matters for its consideration upon which, by reason of their being formulated so late that the several Governments had not been able to consider them fully, the delegates were uninstructed. To avoid this difficulty in the next conference, the United States offered a resolution, which with some slight modifications was adopted, expressing the desire that all propositions to modify the convention or to create separate arrangements should be presented to the International Bureau at least six months before the opening of the conference, and immediately communicated to the different powers.

In addition to the projects and resolution adopted by the conference, the delegates desire to submit their report as to other propositions which they were instructed to support, but which were rejected by the conference.

#### PROPOSITIONS OF UNITED STATES WHICH WERE REJECTED.

The leading purpose of the representatives of the United States was to secure a modification of the convention in respect to the "period of priority" instituted by Article IV. For reasons often reiterated and so well understood that they need not be repeated here, this period as it exists is practically without value to the United States; and, since it is on this that the value of the convention principally depends, the importance of having it adapted to the conditions of our law is apparent. The period of priority provided by the convention is six months from the deposit of the application. And the proposition of the United States was that it should be made to run from the official publication of the specification rather than from the deposit. This appeared to be a common ground on which all the contracting States might unite, with material advantage to those in which the patent is granted after preliminary examination, pending which the invention is kept secret, while not injurious to those in which publication occurs immediately after deposit and as a consequence thereof. In either case it assimilates the beginning of the period of priority to the date from which the patent begins to run. It is a strictly logical proposition. A patent is vitiated in most countries by reason of a prior publication in another country; and the deposit of an application in one country, unless accompanied or followed by publication, does not vitiate a patent subsequently granted in another. It seems only reasonable that any period of priority, whether long or short, should date from the act which in itself will vitiate the patent subsequently obtained abroad, rather than from an act which in itself has no such effect. And, while the proposition seemed thus reasonable in respect to the other countries of the Union, it appeared to the delegation to be a particularly favorable one for British inventors, since under their law publication does not follow deposit for many months.

It was quickly apparent that neither the logical consistency of a proposition of this character nor its adaptation to existing legal condi-



tions in certain countries, nor the fact that the present treaty arrangement is practically useless to the United States, could have any weight in the conference. The proposition was met by four objections: That any extension of the existing period of priority could not be permitted, as it was already a great embarrassment and damage to the patentee,—easily answered by the remark that no such extension was desired, but only an adjustment of the date from which it should run; second, that by a resolution of the conference at Rome in 1886 it was agreed that the terms of the existing convention should not be changed,—to this it was answered that it was not in the power of the conference of Rome to bind subsequent conferences by a resolution, while by the terms of the convention provision was made for its amendment and modification; third, patent laws in different countries had been amended to conform to the conditions of the convention, and a change in it would necessitate further legislation by parliaments upon matters which were regarded as settled. This objection is hard to answer; but it could be said with respect to some countries, as Great Britain, that the proposition appeared to be advantageous to her people, and Parliament would probably not be reluctant to legislate in favor of British interests.

The fourth objection was the most serious, and might be thus stated: At the original conference in 1880 there was a very earnest effort to find a common ground upon which all the contracting parties could stand in respect to this period of priority, and the present arrangement was reached as the best that could be agreed upon, though not in all respects satisfactory. Some other arrangement might have been agreed upon if presented, but the United States had no proposition to offer. There is no reason to believe that the present proposition of the United States might have been as acceptable as that which was adopted. The delegates went to their homes, some of them exerting themselves to have their patent laws amended to agree with the terms of the convention, and some countries not ratifying the convention until their laws were thus changed. Ten years later the United States, having ratified the convention and acceded to the Union without the formality of modifying her laws to harmonize with it, comes to the conference and demands that out of deference to her unique law an arrangement shall be altered against which her delegates made no protest when adopted, and which she, after seven years' delay, had solemnly ratified. It is too late.

The United States delegates found themselves embarrassed by this objection. They could not deny that they were asking to modify an arrangement formulated in 1880, and to which not only was no objection made on the part of their Government at the time, but in which it was presumed their Government acquiesced by virtue of its ratification of the convention of 1887. The objection seemed to them reasonable from the point of view of nations to which the present arrangement is satisfactory, and is not easily met.

The British delegates were, moreover, instructed that they were to consent to no project that was not in agreement with existing British law; and in view of the general consensus that by virtue of the resolution taken at Rome there could be no modification of the existing convention, it was useless to seek for a ground of compromise. The Swiss delegates were ready to accept the United States proposition, so far as their Government was concerned, but offered the following substitute, which they thought more likely to meet the views of the con-

ference, and which the United States delegates thought best to accept in lieu of their own:

In that which concerns patents, every State has the right to determine that for patents first applied for in it, the period of priority shall only run from the time when the description of the invention has been officially rendered public.

#### SEIZURE.

The proposition was, however, rejected, the Netherlands, Norway, Sweden, and Switzerland voting with the United States, against 8 votes adverse and 1 not voting.

The delegates were instructed to support an amendment to Article X of the convention, whereby an illicit trade-mark on imported merchandise should subject it to refusal of entry instead of to seizure, as contemplated in the terms of that article. The conference took no action on that proposition, but a declaration was made by one of its members to the effect that in the conference at Rome it had been agreed that seizure was not obligatory, but was only applicable within the limits authorized by the legislation of each State. On the demand of one of the United States delegates to know if there was any dissent from this view among the members of the present conference, it appeared there was none. The delegation therefore regard the object of the proposed amendment as substantially accomplished, and that the United States will acquit herself of her obligations under the convention whenever her laws provide for the refusal of entry of merchandise bearing false indications of origin. A serious obstacle to legislation in this country in the direction of fulfilling treaty obligations is thereby removed.

It perhaps should be remarked that in a conference of this character the United States is at a little disadvantage, by reason of the extreme liberality of her patent laws toward foreigners. The disposition was occasionally manifested among the delegates to ask concessions of some kind in return for their support of any particular proposition. But, since the patent laws of the United States already place aliens on the same footing as citizens in all respects, no concessions could be made. This liberality has been in accordance with settled policy and is perhaps on the whole advantageous, but in making international arrangements it seems unfortunate that we had not reserved something which would enable us by timely concessions to secure for our citizens reciprocal advantages in other countries.

If it should be thought that the errand of the delegation was futile in view of the barrenness in immediate practical results of the Madrid Conference, the delegates are of different opinion, since they believe that the foundations have been laid—and intimations to that effect were not lacking—for future special conventions with one or more European States upon matters of industrial property, which shall be more advantageous to the United States than the convention of 1883.

It may be questioned whether it was wise on the part of our Government to enter the international Union without first ascertaining that the convention was consistent with our laws and advantageous to our citizens, and there may be a disposition to withdraw from it. The delegates are not prepared to advise such action at present. They are sensible of the value which attaches to membership in such a union and to a voice in its conferences; and in their judgment it



would be better to adhere to it, to urge upon Congress such constitutional legislation as our obligations to it require, and to appear at Brussels in 1893, renewing our propositions or presenting such others as the conditions at that time may dictate, with the hope that they may have a more favorable reception.

There has been no legislation in the United States since ratification of the convention with the object of carrying out its provisions. The patent laws were enacted in substantially their present form in 1870 and the trade-mark law in 1881. The United States adhered to the Union in 1887. Existing statutes make no provision for reciprocity and no advantage is given by them to citizens of the States of the international Union over those enjoyed by citizens of States not members of it. Neither does any pending bill before either House of Congress propose legislation in accordance with the convention. On the contrary, there is danger of laws being enacted that are at variance with it. Under the circumstances it would be expedient if a commission could be appointed to revise the patent and trade-mark laws, in view of our international relations, in the interest of a wider market for the inventions of our citizens and of a more ample protection for their good name as manufacturers and merchants, evidenced by their trade-marks and commercial names.

The delegates can not conclude this report without expressing their appreciation of the courtesies extended to them by the Spanish Government. All public institutions interesting to the traveler, art galleries, museums, armories, and both halls of the Cortes were thrown open to them. Tickets entitling them to free transportation on all the railways leading out of Madrid were freely given to all the delegates and to the members of their families whenever they were so accompanied. They were entertained by the Minister de Fomento, and a special reception in their honor was given by the Queen Regent at the Royal Palace. Nothing was left undone to add dignity and splendor to this occasion, the memory of which will be perpetual testimony to the cordial welcome given by Spain to those who accepted her invitation to the International Conference of 1890.

We have the honor to be, very respectfully, your obedient servants,

T. W. PALMER.

F. A. SEELY.

FRANCIS FORBES.

Hon. JAMES G. BLAINE,  
*Secretary of State.*



## CHAPTER IX.

### CONVENTIONS AND TREATIES RELATING TO PATENTS AND TRADEMARKS BETWEEN FOREIGN COUNTRIES.

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#### SECTION 1.

#### CONVENTION OF MONTEVIDEO (BETWEEN SOUTH AMERICAN COUNTRIES) CONCERNING PATENTS.<sup>1</sup>

[January 16, 1889. *La Propriété Industrielle*, 1898, Année 14, p. 118.]

His Excellency the President of the Argentine Republic;  
His Excellency the President of the Republic of Bolivia;  
His Majesty the Emperor of Brazil;  
His Excellency the President of the Republic of Chili;  
His Excellency the President of the Republic of Paraguay;  
His Excellency the President of the Republic of Peru; and  
His Excellency the President of the Republic to the east of the  
Uruguay,

REPRESENTED BY

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Who, having exhibited their full powers, have been recognized in good and due form, and have taken part in the conferences and necessary discussions, are agreed upon the following provisions:

ARTICLE 1. Any person who shall have obtained a patent or privilege of invention in one of the subscribing States shall enjoy, in the other States, the rights of inventor, if, within the maximum delay of one year, he has registered his patent according to the manner determined by the laws of the country where he demands recognition of these rights.

ART. 2. The privilege shall hold the number of years fixed by the laws of the country where it is desired to put it in force. This term may, however, be reduced to that fixed by the laws of the State where the patent has been originally granted if it be of less duration.

ART. 3. Contests raised in what concerns the priority of invention shall be decided according to the date where the respective patents have been demanded in the countries which have granted them.

ART. 4. The following are considered as constituting an invention or a discovery: A new process, a mechanical or manual apparatus used for the manufacture of industrial products; the discovery of a new industrial product, and the application of improved means aiming to obtain results superior to those which are already known.

The following can not be made patentable:

1. Inventions and discoveries which shall have been made public in one of the subscribing States, or in other States not connected with the present convention.

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<sup>1</sup>According to our information this convention will be in force between the Argentine Republic, Paraguay, Peru, and Uruguay.

2. Those which may be contrary to morality and to the laws of the countries where the patents should be delivered or recognized.

ART. 5. The right of the inventor comprehends the power to derive profit from his invention and to transfer it to others.

ART. 6. Civil and criminal infringements committed by those who shall have violated the right of the inventor shall be prosecuted and punished according to the laws of the country where the wrong shall have been done.

ART. 7. For entrance into force of the present convention, it is not necessary that it shall have been ratified simultaneously by all the subscribing States. The one which shall have approved it shall give information of it to the governments of the Argentine Republic and the republic to the east of the Uruguay, in order that they give information of it to the other contracting States. This notification will take the place of exchange of ratifications.

ART. 8. The exchange of ratifications having once taken place, in the manner indicated by the preceeding article, the present convention shall enter into force from this moment for an indefinite duration.

ART. 9. If one of the subscribing States judge it advisable to withdraw from the convention, or to introduce modifications, it shall make it known to the other States; but it shall be released only after the expiration of two years after the notice, during which delay a new understanding shall be sought for.

ART. 10. Article 7 may be extended to those of the States not having taken part in the congress which desire to agree to the present treaty.

In testimony of which, etc.

(Signatures.)

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## SECTION 2.

### CONVENTION OF MONTEVIDEO (BETWEEN SOUTH AMERICAN COUNTRIES) CONCERNING TRADEMARKS.<sup>1</sup>

[January 16, 1889.]

His Excellency the President of the Argentine Republic;  
 His Excellency the President of the Republic of Bolivia;  
 His Majesty the Emperor of Brazil;  
 His Excellency the President of the Republic of Chile;  
 His Excellency the President of the Republic of Paraguay;  
 His Excellency the President of the Republic of Peru; and  
 His Excellency the President of the Republic to the east of the Uruguay.

REPRESENTED BY

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Who have exhibited their full powers, have been recognized in good and due form, and have taken part in the conferences and necessary discussions, are agreed upon the following provisions:

ARTICLE 1. Any person to whom the right to the exclusive use of a trade-mark shall have been granted in one of the subscribing States

<sup>1</sup> According to our information this convention will be in force between the Argentine Republic, Paraguay, Peru, and Uruguay.

shall enjoy the same privilege in the other States, in consideration of the observation of the formalities and conditions established by their laws.

ART. 2. The property of a trade-mark comprehends the power to put it in use, to transfer it, or to alienate it.

ART. 3. A trade-mark is considered as such when it is the sign, emblem, or external name which the merchant or manufacturer adopts or affixes to his merchandise and products, in order to distinguish them from those of other workmen or merchants who deal in articles of the same kind.

There belong also to marks of this kind those so-called designs of fabric or labores<sup>1</sup> which, by weaving or printing, are applied to the same product which is put on sale.

ART. 4. Counterfeits and falsifications of trade-marks shall be prosecuted before the courts, conformable to the laws of the State upon the territory wherein the fraud has been committed.

ART. 5. For entrance into force of the present convention it is not necessary that it shall have been ratified simultaneously by all the subscribing States. The one which shall have approved it shall give information of it to the Governments of the Argentine Republic and the Republic to the east of the Uruguay, in order that they give information of it to the other contracting States. This notification will take the place of exchange of ratifications.

ART. 6. The exchange of ratifications having once taken place in a manner indicated in the preceding article, the present convention shall enter into force from this moment for an indefinite duration.

ART. 7. If one of the subscribing States judge it advisable to withdraw from the convention or to introduce modifications, it shall make it known to the other States; but it shall be released only upon the expiration of two years after the notice, during which delay a new understanding shall be sought for.

ART. 8. Article 5 may be extended to those of the States which desire to agree to the present treaty.

In testimony of which, etc.

(Signatures.)

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### SECTION 3.

#### CONVENTION CONCLUDED DECEMBER 6, 1891, BETWEEN GERMANY AND AUSTRIA-HUNGARY, CONCERNING INDUSTRIAL PROPERTY.

[Translated and condensed for this report by Mr. Greeley from *La Propriété Industrielle*, January 1, 1892, p. 1.]

Germany and Austria-Hungary concluded on December 6, 1891, a convention for the reciprocal protection of industrial property which is of great interest. Up to the present time this matter has been regulated between the two countries by article 20 of the commercial treaty of May 23, 1881, by which the parties agreed in the matter of trademarks to accord to the foreigner the same treatment as accorded to subjects, and in the matter of patents not to consider official publications as printed publications negating the novelty of an invention until three months after publication.

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<sup>1</sup> Like signification; this term is used principally for textile products.



The first article of this convention assures to applicants in one of the countries the same treatment within the territory of the other which is accorded to subjects of that country in the matter of inventions, designs, and industrial models, trademarks, and the commercial name. The benefits of these provisions are extended by article 2 to subjects or citizens of other States who are domiciled in or have their principal establishment within the territory of one of the contracting States. These two articles are substantially the same as articles 2 and 3 of the International Convention of 1883.

Articles 3 and 4 provide for delays of priority analogous to those of the International Convention, but differ in regard to the date at which the delay of priority begins, according to the nature of the subject-matter to be protected. These articles are as follows:

ART. 3. Whenever an invention, a design or model, or a trade-mark is made the subject of an application for protection in the territory of one of the contracting parties, and, within a delay of three months, the application is also made in the territory of the other contracting party:

(a) This second application shall have priority over all others which may have been filed in the territory of the other party subsequent to the date of the first application.

(b) Circumstances arising subsequent to the date of the first application shall not negative the novelty of this application in the territory of the other party.

ART. 4. The delay of priority provided for in the preceding section begins:

(a) In case of designs and models and trade-marks at the moment of the filing of the first application.

(b) In case of inventions, at the moment of the grant of the patent on the first application.

(c) In case of objects which are applied for in Germany as models of utility (Gebrauchsmuster) and in Austria-Hungary as patentable inventions, at the moment of the filing of the application, if the latter is filed in Germany, and at the moment of the grant of the patent on the first application if the latter is filed in Austria-Hungary.

The day of filing or of the grant is not included in this delay of priority. The day on which notice is given of the decision concerning the definite grant of the patent is considered the date of the grant.

Article 5 provides that the introduction into the territory of one of the parties of a product manufactured in the territory of the other shall not work the forfeiture of the protection granted to an invention, a design, or model applicable to such product. This is almost the same as the first paragraph of article 5 of the International Convention of 1883.

Article 6 gives effect to the principle established by article 6 of the International Convention under which registration for a mark already registered in the territory of one of the parties can not be refused in the territory of the other for the reason that its composition and form do not satisfy the requirements of the local law. This is a great advance on the system established by the former commercial treaty under which each country treated the marks of the other according to its own law and could thus refuse protection to foreign marks of great value, thus encouraging unfair competition.

Article 7 of this convention protects the rights of interested parties in Austria by providing that trademarks known in the territory of one of the parties as the distinctive marks used by members of an industrial association or the inhabitants of a locality or specified district can not be used as "free marks," if they have been deposited in the territory of the other party before October 1, 1875. This date is,

in Germany, the latest date permitted for the deposit of marks in use before the law in respect thereto went into effect.

The provisions relative to the suppression of false indications of origin (article 8) go further than those of article 10 of the International Convention of 1883. They apply to indications of origin of all kinds, as provided for in the first protocol of the conference at Madrid, which took effect as to a certain number of the States of the Union within the following year.

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#### SECTION 4.

##### CONVENTIONS CONCLUDED BETWEEN GERMANY AND ITALY AND GERMANY AND SWITZERLAND CONCERNING INDUSTRIAL PROPERTY.

[Translated and condensed for this report by Mr. Greeley from *La Propriété Industrielle*, May 1, 1892, p. 55.]

Germany has concluded with Italy, under date of January 18, 1892, and with Switzerland, under date of April 13, 1892, conventions which rest, as a precedent, on the principles which are the basis of the International Convention of 1883, but differing in some particulars from that Convention.

The first two articles of these conventions, which assimilate to subjects or citizens of each State the subjects or citizens of the other contracting State and other persons who are domiciled or located in the territory of the latter, are equivalent to articles 2 and 3 of the International Convention, with this difference, that in order to be entitled to these benefits the foreigner not domiciled must have his principal establishment in one of the two countries.

In the convention between Germany and Italy the provisions respecting the effect of the delay of priority are the same as in the convention between Germany and Austria.

This is as follows:

ART. 3. The application, on the territory of one of the contracting parties, for protection for an invention, a design or model, or a trademark shall have, if it is followed within the period of delay hereinafter indicated by a like application in the territory of the other party, the following effects:

(a) The latter application shall have priority over all other applications filed in the territory of the other contracting party subsequent to the filing of the first application.

(b) The novelty of the subject-matter to which the first application relates shall not be negatived by facts arising subsequently to the latter in the territory of the other contracting party.

The corresponding article of the convention with Switzerland is as follows:

ART. 3. Whenever an application for an invention, a design or model, or a trademark is filed in the territory of one of the contracting parties, and, within a period of three months thereafter, application is made in the territory of the other, the latter shall have the same effect as if it had been filed at the date of the former.

The provision by which the date of beginning of the delay of priority is determined is in the following terms in the convention with Italy:

ART. 4. The delay of priority provided for in article 3 begins:

(a) In case of designs and models and trademarks at the moment of the filing of the first application.

(b) In case of inventions at the moment of the grant of the patent on the first application.



(c) In case of objects which are applied for in Germany as models of utility (Gebrauchsmuster) and in Italy as patentable inventions, at the moment of the filing of the first application, if the latter is filed in Germany; at the moment of the grant of the patent on the first application if the latter is filed in Italy.

The day of filing or of the grant is not included in the delay of priority.

The day on which notice is given of the decision concerning the definite grant of the patent is considered the date of the grant.

In the convention with Switzerland the last paragraph has been slightly modified in view of the fact that in Switzerland the patentee does not receive, as in Germany, an official notification concerning the grant of the patent.

The uncertainty as to the meaning of article 4 of the convention with Italy, so far as it concerns the beginning of the delay of priority in case of patents for inventions, is explained in the convention with Switzerland by inserting in the final protocol the following statement, from which it appears that the right of priority begins at the date of the filing of the application and terminates three months after the date of the above-mentioned declaration:

In construing paragraph 1 it is to be understood that an application may be made in the territory of the other party with the effect provided for in article 3 before the moment of the grant of the patent on the first application, on condition that the patent is thereafter actually granted.

In these conventions with Germany the right of priority, so far as concerns applications for patent, is much longer than that established by article 4 of the International Convention of 1883, especially as to applications filed in Germany. In that country the application for patent is followed by a preliminary examination of indeterminate length, after which the application is open for two months for opposition, which is in its turn followed by a procedure more or less long if opposition is made. It will be understood that the greater part of a year is consumed between the filing of the application and the notice to the interested party that his patent may be granted.

The following provision, one of the most important of the conventions with Italy and Switzerland, is not found in the convention with Austria. It concerns the arrangement by which the contracting States avoid, in the interest of their several applicants, the forfeiture for non-working. The following is this provision as it appears in the convention with Italy:

ART. 5. The prejudices which, under the laws of the contracting parties, result from the fact that the invention has not been worked or the design or model has not been reproduced within a certain period shall not have effect if working or reproduction takes place in the territory of the other contracting party.

In consequence, the importation into the territory of one of the contracting parties of a product manufactured in the territory of the other party shall not cause in the other the forfeiture of the protection accorded by law to said product as an invention, design, or model.

In the convention with Switzerland this second paragraph appears in the following form:

The importation into the territory of one of the contracting parties of a product manufactured in the territory of the other shall not cause, in the other, any prejudice to the legal protection based on an invention, a design, or model, or a trade-mark.

In spite of a slight difference of form, this provision is identical in its effects with that of the convention with Italy. It is to be noted that it does not annul the cause of forfeiture established by the Swiss law (art. 9 [4]) in case the object patented is imported from abroad and



at the same time the owner of the patent refuses a demand for license in Switzerland on equitable terms. This results from the following statement inserted in the final protocol:

The prejudices which, under the laws of the contracting parties, result from the refusal to grant licenses are not avoided by the provisions of article 5.

The suppression of forfeiture for nonworking is a great advance on the present condition of affairs. This has always been regarded as a result to be secured some time; but it has not been thought possible that at this date there would be found three States disposed to make this reciprocal concession, nor above all that the initiative would be taken by a country not belonging to the International Union.

In the matter of trade-marks these two conventions have an identical provision, which is equivalent to those in force in the Union on the same subject, but more concisely put. This is as follows:

ART. 6. Registration of a trade-mark registered in one of the contracting parties can not be refused to the owner of the mark in the territory of the other party, for the reason that the mark does not satisfy the requirements in force in the latter in so far as concerns the composition and configuration of the mark.

The convention with Italy contains also the following provision, which is not found in the convention with Switzerland:

ART. 7. Trademarks which belong to the public in the country of origin can not be made the subject of an exclusive right in the territory of the other party.

The convention with Italy does not contain any provision concerning the suppression of false indications of origin. That with Switzerland, on the contrary, regulates this matter by the following article:

ART. 8. Each of the contracting parties shall enact, unless such provisions are already in force, provisions against the sale and the placing on sale of products which, falsely and for the purpose of fraud, are marked as products of a locality or district situated in the territory of one of the contracting parties.

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## SECTION 5.

### CONVENTION BETWEEN SWITZERLAND AND RUSSIA CONCERNING TRADEMARKS.

[May 1-April 19, 1899.]

ARTICLE 1. The citizens and subjects of the two high contracting parties shall enjoy in the States of the other the same protection as the citizens in all that which concerns trademark property, under the condition of fulfilling the formalities prescribed on this subject by the respective laws of the two States.

In each case it is permitted, in Switzerland to Russian subjects and in Russia to Swiss citizens, to lawfully register their marks, in the form in which they have been admitted in the country of origin; provided, that they are not contrary to morals or to public order.

ART. 2. The registration in Switzerland of a Russian mark and in Russia of a Swiss mark can be refused according to the provisions of the legislation of the respective countries if the mark is not sufficiently distinguished from another mark previously registered.

Citizens and subjects of the two States can not enjoy in the other the protection of their marks to a larger extent nor for a longer period than they enjoy in their own country.

ART. 3. The deposit of marks shall take place in Switzerland at the federal office of intellectual property at Berne, and in Russia at the department of commerce and of manufacture at St. Petersburg.

The papers of the application should be written or translated into the French, German, or Italian language for Switzerland, and into the Russian language for Russia.

ART. 4. The present Convention shall be ratified and the ratifications exchanged at Berne as soon as possible.

This convention shall enter into force from the date of the exchange of ratifications, and shall remain in force until the expiration of one year from the date when the denunciation shall have been made by one of the contracting parties.

In faith of which the respective plenipotentiaries have signed the present convention and affixed their seals thereto.

Done in duplicate the May 1—April 19, 1899.

[L. s.]

BRENNER.

[L. s.]

A. DE YONINE.

NOTE.—The above Convention was approved by the Federal Chamber under date of June 17–24, 1899. The exchange of ratifications took place at Berne July 17, 1899.

## SECTION 6.

### TRADEMARK TREATIES AND CONVENTIONS BETWEEN FOREIGN COUNTRIES.

The following statement, prepared by Mr. Greeley from information furnished by the International Bureau (*La Propriété Industrielle*, August 31, 1899), showing the number of separate treaties entered into between foreign nations respecting the reciprocal protection of trademarks, indicates recognition in foreign countries, particularly those of leading commercial importance, of the importance to their foreign trade of securing protection for the trademarks of their manufacturers in other countries.

#### EUROPEAN COUNTRIES.

Austria-Hungary has treaties respecting the protection of trademarks with the following European countries: Belgium, Bulgaria, Denmark, France, Germany, Great Britain, Greece, Italy, Netherlands, Norway, Roumania, Russia, Serbia, Spain, Sweden, and Switzerland; and with the following non-European countries: The United States, Brazil, and Japan.

Belgium has such treaties with the following European countries: Austria-Hungary, Denmark, Germany, Greece, Italy, Luxemburg, Netherlands, Portugal, Roumania, Russia, and Switzerland; and with the following non-European countries: The United States, Brazil, Japan, Mexico, and Venezuela. In addition, Belgium is a party to the International Convention.<sup>1</sup>

<sup>1</sup> This Convention provides that each of the countries which are parties to it shall register and protect the trademarks of citizens and residents of each of the other countries which are parties to it. (See arts. 2, 3, 4, and 6 of the convention, p. 146.)

The following countries are at present parties to this Convention: Belgium, Brazil, Denmark (with the Faroe Islands), Dominican Republic, France (with Algeria and the French colonies), Great Britain (with New Zealand and Queensland), Italy, Japan, Netherlands (with the Dutch East Indies, Surinam, and Curaçao), Norway, Portugal, Serbia, Spain, Sweden, Switzerland, Tunis, and the United States.



Bulgaria has made treaties with the following countries: Austria-Hungary, France, Great Britain, Russia, and Serbia.

Denmark has such treaties with the following European countries: Austria-Hungary, Belgium, France, Germany, Great Britain, Netherlands, Russia, and Sweden; and with the following non-European countries: The United States, Argentine Republic, Brazil, Japan, and Venezuela. In addition, Denmark is a party to the International Convention. (See note under Belgium.)

France has such treaties with the following European countries: Austria-Hungary, Bulgaria, Denmark, Germany, Great Britain, Greece, Italy, Luxemburg, Montenegro, Norway, Roumania, Russia, Serbia, Spain, and Sweden; and with the following non-European countries: The United States, Bolivia, Brazil, Colombia, Costa Rica, Dominican Republic, Guatemala, Japan, Morocco, Mexico, Peru, South African Republic, and Venezuela. In addition, France is a party to the International Convention. (See note under Belgium.)

Germany has such treaties with the following European countries: Austria-Hungary, Belgium, Bulgaria, Denmark, France, Great Britain, Greece, Italy, Luxemburg, Netherlands, Norway, Roumania, Russia, Serbia, Sweden, and Switzerland; and with the following non-European countries: United States, Brazil, Guatemala, and Venezuela.

Great Britain has such treaties with the following European countries: Austria-Hungary, Bulgaria, Denmark, France, Germany, Greece, Italy, Montenegro, Portugal, Roumania, Russia, Serbia, Spain, and Switzerland; and with the following non-European countries: United States, Bolivia, Colombia, Ecuador, Guatemala, Japan, Mexico, and Paraguay. In addition, Great Britain is a party to the International Convention. (See note under Belgium.)

Greece has such treaties with the following European countries: Austria-Hungary, Belgium, France, Germany, Great Britain, Italy, Montenegro, Netherlands, and Switzerland.

Italy has such treaties with the following European countries: Austria-Hungary, Belgium, France, Germany, Great Britain, Greece, Luxemburg, Montenegro, and Russia; and with the following non-European countries: United States, Brazil, Colombia, Dominican Republic, Japan, Mexico, and Paraguay. In addition, Italy is a party to the International Convention. (See note under Belgium.)

Luxemburg has such treaties with the following European countries: Belgium, France, Germany, and Italy.

Norway has such treaties with the following European countries: Austria-Hungary, Denmark, France, Germany, Spain, and Sweden. In addition, Norway is a party to the International Convention. (See note under Belgium.)

Netherlands has such treaties with the following European countries: Austria-Hungary, Belgium, Denmark, Germany, Greece, Russia, and Switzerland; and with the following non-European countries: United States, Brazil, and Japan. In addition, Netherlands is a party to the International Convention. (See note under Belgium.)

Portugal has such treaties with the following European countries: Belgium, Great Britain, and Russia; and with the following non-European countries: Brazil and Japan. In addition, Portugal is a party to the International Convention. (See note under Belgium.)

Roumania has such treaties with the following European countries: Austria-Hungary, Belgium, France, Germany, and Switzerland.



Russia has such treaties with the following European countries: Austria-Hungary, Belgium, Bulgaria, Denmark, France, Germany, Great Britain, Italy, Netherlands, Portugal, Serbia, Spain, and Switzerland; and with the following non-European countries: United States and Japan.

Serbia has such treaties with the following European countries: Austria-Hungary, Bulgaria, France, Germany, Great Britain, Montenegro, and Russia, and with the United States. In addition, Serbia is a party to the International Convention. (See note under Belgium.)

Spain has such treaties with the following European countries: Austria-Hungary, France, Great Britain, Italy, Norway, Russia, and Sweden, and with the following non-European countries: United States, Japan, and Venezuela. In addition, Spain is a party to the International Convention. (See note under Belgium.)

Sweden has such treaties with the following European countries: Austria-Hungary, Denmark, France, Germany, Norway, and Spain, and with Japan. In addition, Sweden is a party to the International Convention. (See note under Belgium.)

Switzerland has such treaties with the following European countries: Austria-Hungary, Belgium, Germany, Great Britain, Greece, Netherlands, Roumania, and Russia, and with the United States and Japan. In addition, Switzerland is a party to the International Convention. (See note under Belgium.)

In addition to the treaty arrangements above mentioned, Belgium, France, Germany, and the Netherlands are parties to an arrangement for the reciprocal protection in China of the trademarks of the subjects or citizens of any one of these countries against infringement by the subjects or citizens of any other of these countries. Under this arrangement (see *La Propriété Industrielle* of August 31, 1898, and December 31, 1899) infringement may be prosecuted before the consular tribunal of the country of the alleged infringer. The trademark, in order to be entitled to this protection, must have been registered in the country of the alleged infringer.

A similar arrangement has been entered into between France and Great Britain with respect to the reciprocal protection of the trademarks of their subjects or citizens in Korea. (*La Propriété Industrielle*, January 31, 1900.)

#### CENTRAL AND SOUTH AMERICAN COUNTRIES.

Argentine Republic has treaties providing for the registration and protection of trademarks with Denmark, and with Paraguay, Peru, and Uruguay.

Brazil has such treaties with Austria-Hungary, Belgium, Denmark, France, Germany, Italy, Netherlands, and Portugal, and with the United States. In addition, Brazil is a party to the International Convention. (See note under Belgium.)

Costa Rica has such treaties with France and with Honduras.

Guatemala has such treaties with France, Germany, and Great Britain, and with Honduras and Salvador.

Mexico has such treaties with Belgium, France, Great Britain, and Italy.

Paraguay has such treaties with Great Britain and Italy, and with Argentine Republic, Peru, and Uruguay.

Peru has such treaties with France, and with Argentine Republic, Japan, Paraguay, and Uruguay.

Uruguay has such treaties with Argentine Republic, Paraguay, and Peru.

Venezuela has such treaties with Belgium, Denmark, France, Germany, and Spain.

#### OTHER COUNTRIES.

Japan has such treaties with Austria-Hungary, Belgium, Denmark, France, Germany, Great Britain, Italy, Netherlands, Portugal, Russia, Spain, Sweden, and Switzerland, and with the United States and Peru. In addition, Japan is a party to the International Convention. (See note under Belgium.)

South African Republic has such treaties with France and Germany.

## CHAPTER X.

### OPINION OF THE ATTORNEY-GENERAL OF THE UNITED STATES UPON THE CONSTRUCTION OF THE ARTICLES OF THE INTER- NATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

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#### LEGISLATION FOR THE ENFORCEMENT OF THE TREATY NECESSARY.

This treaty is a reciprocal one. Each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects and citizens. It is a contract operative in the future infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws.

DEPARTMENT OF JUSTICE,  
*Washington, D. C., April 5, 1889.*

SIR: Your predecessor, by his letter of the 15th of January, 1889, requested the opinion of the Attorney-General on the following state of facts:

Section 4902 of the Revised Statutes grants the right to file caveats preliminary to applications for patents for inventions and establishes the legal effect that shall be given to them. It also provides—

*Any citizen of the United States* who makes any new invention or discovery, and desires further time to mature the same, may \* \* \* file in the Patent Office a caveat.

It further provides—

An alien shall have the privilege herein granted if he has resided in the United States one year next preceding the filing of his caveat and has made oath of his intention to become a citizen.

By the first of these clauses the grant of the right is limited to citizens. By the second it is enlarged to include one class of aliens. The grant as a whole entitles only citizens and aliens who have been residents 1 year and have legally declared their intention to become citizens to file caveats.

It is claimed by Ferdinand Bourquin, a Swiss citizen, that the second article of a convention entered into between the United States and certain other nations, of which the Swiss Confederation was one, proclaimed on the 7th day of June, 1887 (U. S. Statutes of 1887 and 1888, treaties, 37), extends the grant of section 4902, Revised Statutes, to all subjects and citizens of the parties to the convention. That article provides—

The subjects or citizens of each of the contracting States shall enjoy in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord or shall afterward accord to subjects or citizens. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.



Congress has passed no law for the execution of this article, nor did the House of Representatives in any way consider or assent to the treaty.

Section 4902 is a part of the system of laws of the United States concerning patents for inventions. If, therefore, the article above quoted has become and is self-executing as an infraterritorial law, by virtue of the making and proclamation of the treaty by the President, by and with the advice and consent of the Senate, the claim made by Ferdinand Bourquin is valid. By the second clause of the second section of the second article of the Constitution, the power to make treaties, by and with the advice and consent of the Senate, is vested in the President. By the second clause of the sixth article of the Constitution, "all treaties made or which shall be made under the authority of the United States shall be the supreme law of the land." By the eighth clause of the eighth section of the first article the whole legislative power over the subject of patents is committed to Congress. It is found among the powers to borrow money; to coin money; to declare war; to raise and support armies; to constitute judicial tribunals; to regulate commerce, etc. It is due to the credit of the United States that the provisions concerning the treaty-making power of the President and the legislative power of Congress shall, if possible, be so construed and executed as to give full and proper effect to each and insure harmony in their exercise.

In the case of *Foster v. Neilson* (2 Peters, 314), Chief Justice Marshall, delivering the opinion of the court, in discussing the effect of the Constitution on treaties as laws, declared:

A treaty is, in its nature, a contract between two nations; not a legislative act. It does not generally effect of itself the object to be accomplished, especially so far as its operation is infraterritorial, but is carried into execution by the sovereign power of the respective parties to the instrument.

In the United States a different principle is established. Our Constitution declares a treaty to be the law of the land. It is consequently to be regarded in courts of justice as equivalent to an act of the legislature whenever it operates of itself without the aid of any legislative provision. *But when the terms of the stipulation import a contract, when either of the parties engaged to perform a particular act, the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract before it can become a rule for the court.*

The principle thus stated has been generally accepted as a true interpretation of the constitutional provisions relating to the subject of treaties. It establishes that there is a class of treaties which, without legislation, do not become self-executing as a rule of municipal law. A statement is given of such provisions of treaties as come within this class; as "when the terms of the stipulation import a contract, when either of the parties engages to perform a particular act." But the decision does not enumerate or define the limitations of the whole class. In the treaty-making power conferred on the President the implication exists that the power is to be exercised by him subject to the limitation of the Constitution. If, in time of peace, he should provide by the stipulations of a treaty for the quartering of soldiers in any house without the consent of the owner, such a stipulation would be simply void, because forbidden by the Constitution to every department of the Government. But where the Government of the United States has power under the Constitution over a subject, although that power may be vested by the Constitution exclusively in Congress, it has been claimed that in the making of treaties such power may be exercised by

the President, by and with the advice and consent of the Senate, without the cooperation of the House of Representatives or act of Congress. Issue was joined on this proposition in 1796 between the President and Senate in the affirmative, and the House of Representatives in the negative, concerning certain provisions of the Jay treaty with Great Britain. The treaty, at the end of the disagreement, remained intact, but the House of Representatives—

passed resolutions disclaiming the power to interfere in making treaties, but asserting their right, whenever stipulations were made on subjects committed to Congress by the Constitution, to deliberate on the expediency of carrying them into effect; and in legislating on several treaties then before them they struck out the words, "that provision ought to be made by law," and substituted words which declared merely the expediency of passing the necessary laws. (Sergeant's Constitutional Law, 411; Story on the Constitution, section 1841.)

In the session of 1815 and 1816 a like disagreement arose concerning a commercial treaty made in the July preceding "between the United States and Great Britain, by which it was agreed to abolish the discriminating duties on British vessels and cargoes." This disagreement was terminated with no decisive results.

The treaty between the United States and the King of the Hawaiian Islands, signed January 30, 1875, which provided for commercial reciprocity between the nations, and involved the exercise of one of the powers submitted to Congress by the Constitution, provided in its fifth article that it should not be ratified "until a law to carry it into operation should be passed by the Congress of the United States of America." (19 U. S. Stats., 627.) In execution of this treaty Congress, on the 15th of August, 1876 (19 U. S. Stats., 200) passed an act in accordance with the provisions of the treaty. The treaty by its terms, however, was clearly a contract by which, in consideration of certain special commercial privileges granted on the one part, certain other like privileges were granted on the other. Such special privileges granted in consideration of others received, the Supreme Court of the United States in the case of *Bartram v. Robertson* (122 U. S., 120) ruled, constitute a contract, Field, J., delivering the opinion (speaking of the treaty with Denmark as compared with that of the Hawaiian Islands) declaring:

Those stipulations, even if conceded to be self-executing, by the way of a proviso or exception to the general law imposing the duties, do not cover concessions like those made to the Hawaiian Islands for a valuable consideration. They were pledges of two contracting parties, the United States and the King of Denmark, to each other; that, in the imposition of duties on goods imported into one of the countries which were the product or manufacture of the other, there should be no discrimination against them in favor of goods of like character imported from any other country. They imposed an obligation on both countries to avoid hostile legislation in that respect. But they were not intended to interfere with *special arrangements with other countries founded upon a concession of special privileges*. (See also *Whitney v. Robertson*, 124 U. S., 192.)

If the treaty-making power, in all treaties whose execution required the exercise of powers committed to Congress, should uniformly provide in the treaties for their proper submission to Congress before they should be effective, consequences might be avoided which may jeopardize the credit of the nation. Under the British constitution, with reference to this subject the jurisdiction of Parliament is thus stated in 1 Todd's Parliamentary Government in England, page 610:

The constitutional power appertaining to Parliament in respect to treaties is limited. It does not require their formal sanction or ratification by Parliament as a condition to their validity. The proper jurisdiction of Parliament in such matters may be thus

defined: First, it is right to give or withhold its sanction to those parts of a treaty that require a legislative enactment to give it force and effect, as, for example, when it provides for an alteration in the criminal or municipal law, or proposes to change existing tariffs or commercial regulations. \* \* \* If a treaty requires legislative action in order to carry it out, it should be subjected to the fullest discussion in Parliament, and especially in the House of Commons, with a view to enable the Government to promote effectually the important interests at stake in their proposed alterations in the foreign policy of the nation.

It is not necessary to the decision of the question submitted to me in the matter under consideration to determine whether all the provisions of treaties, whose execution requires the exercise of powers submitted to Congress, must be so submitted, before they become law, to the courts and Executive Departments, for the treaty under consideration is a reciprocal one. Each party to it covenants to grant in the future to the subjects and citizens of the other parties certain special rights in consideration of the granting of like special rights to its subjects or citizens. It is a contract operative in the future infraterritorially. It is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws.

Very respectfully,

W. H. H. MILLER,  
*Attorney-General.*

The SECRETARY OF THE INTERIOR.



## CHAPTER XI.

### LAWS OF CERTAIN FOREIGN COUNTRIES GIVING EFFECT TO THE PROVISIONS OF THE INTERNATIONAL CONVENTION CONCLUDED AT PARIS MARCH 20, 1883, AS REGARDS PRIORITY, THE REGISTRATION OF TRADEMARKS, AND THE PROTECTION OF INVENTIONS SHOWN AT INTERNATIONAL EXPOSITIONS.

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#### SECTION 1.

##### BRAZIL.

##### (a) PATENTS.

(Law of October 14, 1882.)

ART. II. Inventors receiving privileges in other countries can obtain a confirmation of their rights in this Empire, provided that they fulfill the formalities and conditions of this law and observe the further dispositions in force applicable to the case. The confirmation will give the same rights as a patent conceded in the Empire.

SEC. 1. The priority of the property right of that inventor who, having solicited a patent from a foreign country, shall make a similar petition to the Imperial Government within seven months, will not be invalidated by facts which may occur during this period—to wit, another similar petition, the publication of the invention, and its use or employment.

SEC. 2. To the inventor who, before obtaining a patent, desires to experiment in public with his inventions, or wishes to exhibit them in an exposition, official or officially recognized, will be granted a title provisionally guaranteeing to him his right of property for a specified time and with the formalities required.

##### (b) TRADEMARKS.

(Law of October 14, 1887.)

ART. XXV. The provisions of this law are applicable to Brazilians or foreigners whose establishments are without the Empire, under the following requirements:

1. That there exists between the Empire and the nation in whose territory are the said establishments a diplomatic convention securing reciprocity of guarantee for Brazilian marks;

2. That the marks have been registered in conformity with local law;

3. That the respective model and certificate of registry have been deposited in the *Junta Commercial* of Rio de Janeiro;

4. That the certificate and explanation of the mark have been published in the *Diario Oficial*.

ART. XXVI. In case of compliance with requirements Nos. 2 to 4 of the preceding article, the provision in article 9, No. 3, shall have effect in favor of marks registered in foreign countries which signed the Convention promulgated by Decree No. 9233, of June 28, 1884, or which approved it for the space of four months, counting from the day when the registry is made according to local law.

(Regulation of December 31, 1887.)

ART. V. In favor of marks registered in foreign countries which signed the Convention promulgated by Decree No. 9233, of June 28, 1884, or which afterwards agreed to it, the provisions of article 20 of this regulation is valid for the term of four months, counting from the day when the registry is made according to local law whenever the requirements indicated in Nos. 2, 3, and 4 of the preceding article have been complied with. (Law, art. 26.)

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## SECTION 2.

### CEYLON.

(British colony—Not a party to the Convention.)

### PATENTS.

(Law of 1892.)

SEC. 24. If an inventor, being the exhibitor of his invention at an industrial or international exhibition, certified as such by the Governor, causes a petition for leave to file a specification of the invention to be delivered to or received by the Colonial Secretary within six months from the date of the admission of the invention into that exhibition, the invention shall not be deemed to have been publicly used, or made publicly known, within the meaning of this ordinance, by reason only of the invention having at any time after its admission into the exhibition been publicly used or made publicly known.

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## SECTION 3.

### DENMARK.

#### (a) PATENTS.

(Law of March 28, 1894.)

SEC. 28. When an invention is shown at an international exhibition in this country, which is acknowledged as such by the Minister of the Interior, the inventor shall have the right to obtain a patent irrespectively of the invention having during that time been so described or

applied as mentioned in sec. 1, clause 3, provided he lodges an application with the Patent Commission within six months of the invention being first shown at the exhibition. It may be provided by royal ordinance that the same shall apply to inventions which are shown at international exhibitions held in a foreign State, and acknowledged as such by the State in question.

It may also be decided by royal ordinance:

(1) That an inventor who has lodged an application for a patent for an invention in a foreign State shall have the right to obtain a patent in this country irrespectively of the invention having, during the following seven months, been so described or applied as mentioned in section 1, clause 3, provided he, in the course of that period, lodges an application for a patent in this country; and

(2) That the application so lodged in this country shall, relatively to other applications, be considered as made at the same time as the application in the foreign State.

### (b) TRADEMARKS.

(Law of April 11, 1890.)

ART. 14. The King may decree, under condition of reciprocity, that the protection given to trademarks by the present law shall be equally accorded to those who, in a foreign country, are engaged in industry of the kind mentioned in article 1. The provisions of the law shall, in consequence, be applicable in such case, provided the following special regulations with reference to filing trademarks are observed.

1. The application must be accompanied by a certificate showing that the applicant has complied with the formalities required in the foreign country for protection of his trademark.

2. The applicant shall submit to the jurisdiction of the Maritime and Commerce Tribunal of Copenhagen and designate a representative domiciled in the country who shall take action in his name.

3. The trademark is not protected to a greater degree or for a longer term than in the foreign country.

In reference to trademarks registered in countries which accord the same privileges to Danish trademarks, the King may make the following provisions:

4. The trademark, if it is not contrary to morality or to public order, shall be registered in the form in which it is protected in the foreign country.

5. If within a period of four months from the day on which the trademark is filed in the foreign country an interested party shall apply for registration in the realm, this application shall be considered, as regards the applications of others, as having been made simultaneously with the application in the foreign country.

6. If, registration having been refused for the reason mentioned in article 4, paragraph 5, after the person who claims to have previously filed or registered such mark has been summoned before the tribunals, the applicant furnishes proof that he was the original user of the trademark, but that such person has appropriated it, the tribunal may declare the applicant entitled to register the trademark, and to have the exclusive right to use the trademark for the goods on which he used it at the date on which reciprocity as to protection went into



force. But the application in this regard shall not be received after six months after the date in question, without prejudice to the right guaranteed by article 10, paragraph 3.

7. If a convention is concluded with a foreign country, the laws of which conform to the provisions of the present law, the King may decree in addition that old marks already registered in the country of origin by traders in iron and in wood (carpentry) of the country, and consisting in whole or essentially of figures, letters, or words not in distinctive form, shall enjoy, when they are protected in the foreign country, special protection in Denmark. It shall, therefore, be forbidden to all other persons to make use of the same figures, letters, or words as a trademark for the same kind of goods unless they have made use of it before reciprocity as to protection went into force. Nevertheless, no one shall be prevented from employing as a mark the initials of his name or of his firm name. Application to have this effect shall not, however, be made except within a term to be fixed by royal decree. The publication relative to such registration must state the kind of goods for which it is made, and state that it was made conformably to this provision.

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#### SECTION 4.

##### FRANCE.

##### PATENTS.

(Law of May 23, 1868.)

**ART. I.** Every Frenchman or foreigner, the author either of a discovery or invention capable of being patented in the terms of the law of the 5th of July, 1844, or of a design which can be lodged conformably to the law of the 18th of March, 1806, or persons entitled through him, may, if they are admitted to a public exhibition authorized by the Government, cause to be delivered by the prefect or subprefect in the department or district in which such exhibition is open a certificate descriptive of the article shown.

**ART. II.** This certificate assures to the person who obtains it the same rights that would be conferred upon him by a patent of invention or by a legal deposit of the design, to date from the day of admission up to the end of the third month which follows the closing of the exhibition, without prejudice to the patent which the exhibitor may take or to the deposit which he may effect before the expiration of this period.

**ART. III.** The application for this certificate must be made in the first month, at latest, of the opening of the exhibition. It must be addressed to the prefecture or subprefecture, and be accompanied by an exact description of the article to be protected, and, where possible, by a plan or drawing of the said article.

The applications, together with the decisions arrived at by the prefect or subprefect, are inscribed in a special register, which is subsequently transmitted to the ministry of agriculture, commerce, and public works, and communicated without fee to every applicant.

The certificate is delivered gratis.

## SECTION 5.

## GREAT BRITAIN.

The Patents, Designs, and Trademarks Act, 1883.

SEC. 103. (1) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign State or States for mutual protection of inventions, designs, and trademarks, or any of them, then any person who has applied for protection for any invention, design, or trademark in any such State shall be entitled to a patent for his invention or to registration of his design or trademark (as the case may be) under this act, in priority to other applicants; and such patent or registration shall have the same date as the date of the application in such foreign State.

*Provided*, That his application is made in the case of a patent within seven months, and in the case of a design or trademark within four months, from his applying for protection in the foreign State with which the arrangement is in force.

*Provided*, That nothing in this section contained shall entitle the patentee or proprietor of the design or trademark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trademark in this country, as the case may be.

(2) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trademark, shall not invalidate the patent which may be granted for the invention or the registration of the design or trademark.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trademark under this section must be made in the same manner as an ordinary application under this act: *Provided*, That in the case of trademarks any trademark the registration of which has been duly applied for in the country of origin may be registered under this act.

(4) The provisions of this section shall apply only in the case of those foreign States with respect to which Her Majesty shall from time to time by order in council declare them to be applicable, and so long only in the case of each State as the order in council shall continue in force with respect to that State.

SEC. 39. The exhibition of an invention at an industrial or international exhibition, certified as such by the board of trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the

application, provided that both the following conditions are complied with, namely—

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

(The Patents Act, 1886.)

SEC. 3. Whereas by section 39 of the patents, designs, and trade-marks act, 1883, as respects patents, and by section 57 of the same act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the board of trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so:

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom,

*Be it therefore enacted as follows :*

It shall be lawful for Her Majesty, by order in council, from time to time, to declare that sections 39 and 57 of the patents, designs, and trademarks act, 1883, or either of those sections, shall apply to any exhibition mentioned in the order in like manner as if it were an industrial or international exhibition certified by the board of trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in council may seem fit.

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## SECTION 6.

### INDIA.<sup>1</sup>

British colony—Not a party to the Convention.

### PATENTS.

(Law of 1888.)

SEC. 26. If an inventor, being the exhibitor of his invention at an industrial or international exhibition, certified as such by the Governor-General in council, causes an application for leave to file a specification of the invention to be delivered to or received by the secretary within six months from the date of the admission of the invention into that exhibition, the invention shall not be deemed to have been publicly used or made publicly known, within the meaning of this part, by reason only of the invention having at any time after admission into the exhibition been publicly used or made publicly known.



## SECTION 7.

## ITALY.

(Decree of January 16, 1898.)

Whoever shall have regularly deposited in Germany or in one of the States which have adhered to the Convention of Paris, dated March 20, 1883, an application for patent or a model of utility (*Gebrauchsmuster*), a design or industrial model, or a mark of trade or commerce, may, in effecting the same deposit in Italy, ask that mention be made in the Italian patent or certificate of the right of priority which is intended to be reserved according to the terms of article 4 of the above-mentioned Convention or of articles 3 and 4 of the Italo-German Convention of January 18, 1892, upon the condition of conforming to the provisions of the following articles:

The deposit of the application in Italy should be made—

(a) Within three months from the date of the first deposit made in a foreign country, if it relates to designs or industrial models, to models of utility or marks of trade or commerce;

(b) Within six months from the date of the first deposit made in one of the States adhering to the Convention of Paris, dated March 20, 1883, if it relates to patents for invention.

(c) Within three months from the date of the grant of the patent for invention when the application has been deposited in Germany.

For applications made in countries beyond the sea the delays of three and six months, mentioned under letters (a) and (b) of the preceding article, have been increased by one month.

## SECTION 8.

## JAPAN.

## (a) PATENTS.

(Law of March 1, 1899.)

ART. XIV. In case any person who has applied for patent of an invention in one of the countries under the treaty of Industrial Property Protection Union, shall also apply for patent of the same invention within seven months, such application shall be deemed to have been made on the date of the first application.

ART. XV. When any person exhibiting his articles in any exhibition held by the Government or by the local authorities shall intend to apply in future for a patent of the invention regarding to the same articles, he shall inform such intention to President of Patent Bureau before he exhibits them.

In the above-mentioned case, the subsequent application for patent shall be deemed to have been made on the date of such information, provided that such subsequent application shall be made within six months from the date when the articles were received in such exhibition.

In case a Universal Exhibition is held in one of the countries under the treaty of Industrial Property Protection Union, the time allowed in such country for the subsequent patent application regarding to exhibited articles shall hold valid in this Empire.

## (b) TRADEMARKS.

(Law of March 1, 1899.)

ART. IX. In case any person who applied for the registration of trademarks in one of the countries under the treaty of Industrial Property Protection Union shall apply for registration of the same trademarks within four months, the said application shall have the same effect as to have been made on the date of the first application.

ART. XX. The provisions of Patent Act, Arts. \* \* \* XV \* \* \* shall apply to trademarks.

## SECTION 9.

## MALTA.

(British colony—Not a party to the Convention.)

## PATENTS.

(Law of 1899.)

SEC. 5. Any person who has applied for protection of an invention in the United Kingdom or in any British possession, or any person who has applied for protection in any foreign State with which Her Majesty has made an arrangement for mutual protection of inventions, shall be entitled to a patent for his invention in these islands under this ordinance in priority to other applicants.

SEC. 6. With respect to foreign States the provisions of the next preceding article shall apply only in the case of those foreign States with respect to which Her Majesty shall from time to time, by order in council, declare the provisions of section 103 of the imperial act 46 and 47, Victoria, chapter 57, to be applicable, and so long only, in the case of each State, as the order in council shall continue in force with respect to that State.

## SECTION 10.

## NETHERLANDS

## TRADEMARKS.

(Law of September 30, 1893.)

ART. 3. (Last paragraph.) The person who, within the period fixed in article 4 of the International Convention of Madrid aforesaid, has sent a mark to the Bureau for Industrial Property, which, with due observance of article 6 of the Convention just mentioned, he has deposited according to the regulations in one of the States that are parties to that Convention, shall be accounted to have used that mark at the commencement of that period in the Kingdom in Europe.

ART. 7. All Netherlands subjects and foreigners living within the Kingdom in Europe, or having their chief industrial or trading estab-

lishments there, who wish to secure protection of their marks, sent in, in accordance with article 4, in other such States as are parties to the Madrid Convention, shall send to the Bureau for Industrial Property three copies more, one of which shall bear the sender's signature, together with a distinct drawing of the mark and a cliché, in accordance with the requirements of article 4.

The second paragraph of article 4 is applicable to this case.

The Bureau aforesaid shall retain the signed copy of the drawing, which shall be certified to, and shall further undertake, provided the mark is registered or as soon as possible thereafter, in accordance with the requirements of article 5 with due observance of existing regulations, the immediate application for registration at the International Bureau at Berne, and shall notify the sender of all that the last-named Bureau may advise with regard to the said mark, as also everything that may be of interest to him.

If the mark sent in, in accordance with the requirements of article 4, is not registered as prescribed by article 5, the Bureau for Industrial Property shall notify the sender that application for registration at the International Bureau at Berne can not yet be made.

ART. 8. With reservation of the provision of article 9 the Bureau for Industrial Property shall, within three days of the date of the receipt of the notice from the International Bureau at Berne, as prescribed by article 3 of the aforementioned Madrid Convention, enter the mark referred to in that notice in the public register appointed for that object, the model of the said register to be fixed by the Minister of Justice.

The announcement when received shall be certified to, and the date and number of the entry in the register added thereto.

If the international registered mark has been sent in to the Bureau for Industrial Property in accordance with the provisions of article 7, said Bureau shall notify the sender as soon as possible of such international registration, together with duly dated attest of the registration mentioned in the first paragraph of this article.

The supplement of the "journal" of the International Bureau at Berne containing the announcement of the registration of marks at that place shall be obtainable at the Bureau for Industrial Property.

From time to time notice of this last-mentioned fact shall be made in the Netherlands official organ.

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## SECTION 11.

### NEW SOUTH WALES.

(British colony—Not a party to the Convention.)

(Law of December 10, 1897.)

ART. 2. (1) If Her Majesty is pleased, by order in council, to apply the provisions in the said section 103 of the imperial act, called "The patents, designs, and trademarks act, 1883," to this colony, then any person who has applied for protection for any invention, design, or trademark in England or in any foreign State with the Government of which Her Majesty has made an arrangement under the said section



for mutual protection of inventions, designs, or trademarks, or any of them, shall be entitled to a patent for his invention, or to registration of his design or trademark (as the case may be) under this act, in priority to other applicants; and such patent or registration shall take effect from the same date as the date of the application in England or such foreign State, as the case may be.

Such application shall be made in the case of a patent within seven months, and in the case of a design or trademark within four months, from such person applying for protection in England or the foreign State with which the arrangement is in force.

Nothing in this section contained shall entitle the patentee or proprietor of the design or trademark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trademark, as the case may be, in this colony.

(2) The publication in this colony during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trademark, shall not invalidate the patent which may be granted for the invention or the registration of the design or trademark.

(3) The application for the grant of a patent or the registration of a design or the registration of a trademark under this section must be made in the same manner as an ordinary application under the act 16 Victoria, No. 24, and any acts amending the same, or the copyright act, 1879, and any act amending the same, or the trademarks act, 1865, and any acts amending the same, as the case may be. In the case of trademarks, any trademark the registration of which has been duly applied for in the country of origin may be registered under the trademarks act, 1865, and any act amending the same.

(4) The provisions of this section shall, in the case of foreign States, apply only in the case of those foreign States with respect to which Her Majesty shall from time to time, by order in council, declare the provisions of the aforesaid section 103 of the said first-recited imperial act to be applicable, and so long only in the case of each State as the order shall continue in force with respect to that State.

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## SECTION 12.

### NEW ZEALAND.

(British colony.)

(Law of 1889.)

ART. 47. The exhibition of an invention at any colonial, intercolonial, or international exhibition held at any place either within or beyond the colony, and declared by the governor by notification in the Gazette to be an "industrial exhibition" for the purposes of this act, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of

the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, subject as follows, namely:

In the case of an exhibition held at any place within the colony:

(a) The exhibitor must, before exhibiting the invention, give the registrar notice of his intention to do so; and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

In the case of an exhibition held at any place outside the colony:

The foregoing conditions shall also apply; but the Governor may exempt, either absolutely or upon such terms and conditions as he shall think fit, any exhibitor from the condition of giving previous notice to the registrar of his intention to exhibit.

ART. 106. (1) If Her Majesty is pleased by order in council to apply the provisions of section 103 of the imperial act called "The patents, designs, and trademarks act, 1883," to the colony of New Zealand, then any person who has applied for any protection for any invention, design, or trademark in England, or in any foreign State with the Government of which Her Majesty has made an arrangement under the said section for mutual protection of inventions, designs, or trademarks, or any of them, shall be entitled to a patent for his invention or to registration of his design or trademark, as the case may be, under this act, in priority to other applicants; and such patent or registration shall take effect from the same date as the date of the application in England or such foreign State, as the case may be: *Provided*, That his application is made, in the case of a patent, within twelve months, and in the case of a design or trademark within six months, from his applying for protection in England or the foreign State with which the arrangement is in force.

Nothing in this section contained shall entitle the patentee or proprietor of the design or trademark to recover damages for infringements happening prior to the date of the actual acceptance of his specification or the actual registration of his design or trademarks in this colony, as the case may be.

(2) The publication in New Zealand during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trademark, shall not invalidate the patent which may be granted for the invention or the registration of the design or trademark.

(3) The application for the grant of a patent or the registration of a design or the registration of a trademark under this section must be made in the same manner as an ordinary application under this act; but in the case of trademarks any trademark the registration of which has been duly applied for in the country of origin may be registered under this act.

(4) The provisions of this section shall, in the case of foreign States, apply only in the case of those foreign States with respect to which Her Majesty shall from time to time, by order in council, declare the provisions of the aforesaid section of the said imperial act to be applicable, and so long only in the case of each State as the order in council shall continue in force with respect to that State.

## SECTION 13.

## NORWAY.

## (a) PATENTS.

(Law of June 16, 1885.)

ART. 33. If anyone who shall have in a foreign country applied for patent for an invention within a period of seven months after such foreign application hands in an application for patent in this country for the same invention, this last application shall (in case the said foreign country grants reciprocal rights to Norwegians) be considered in relation to other applications as if it had been handed in at the same time that the application was made in the foreign State.

## (b) TRADEMARKS.

(Law of May 26, 1884.)

ART. 15. The King may decree, under condition of reciprocity, that the protection given to trademarks by the present law shall be equally accorded to those who, in a foreign country, are engaged in industry of the kind mentioned in article 1. The provisions of the law shall, in consequence, be applicable in such case, provided the following special regulations with reference to filing trademarks are observed:

1. The application must be accompanied by a certificate showing that the applicant has complied with the formalities required in the foreign country for protection of his trademark.

2. In all matters which concern the mark, the applicant shall recognize the jurisdiction of the tribunal of Christiania, and shall appoint an authorized representative domiciled in the country who shall respond in his name.

3. The trademark is not protected to a greater degree or for a longer term than in the foreign country.

In reference to trademarks registered in countries which accord the same privileges to Norwegian trademarks, the King may make the following provisions:

4. The trademark, if it is not contrary to morality or to public order, shall be registered in the form in which it is protected in the foreign country.

5. If, within a period of four months, from the day on which the trade-mark is filed in the foreign country, an interested party shall apply for registration in Norway, this application shall be considered, as regards the applications of others, as having been made simultaneously with the application in the foreign country.

6. If, registration having been refused for the reason mentioned in article 4, paragraph 5, after the person who claims to have previously filed or registered such mark has been summoned before the tribunals, the applicant furnished proof that he was the original user of the trademark, but that another knowingly appropriated it, the tribunal may declare the applicant entitled to register the trademark, and to have the exclusive right to use the trademark for the goods on which he used it at the date on which reciprocity as to protection went into



force. But the application in this regard shall not be received after six months after the date in question.

7. Finally, as regards countries the trademark laws of which conform to the provisions of the present law, the King may decree that old marks duly registered in the country of origin and composed wholly or essentially of figures, letters, or words which are not distinguished by particular and striking form, shall enjoy, when they are protected in the foreign country, a special protection in Norway. It shall therefore be forbidden to any one to make use of the same figures, letters, or words as a mark for the same kind of merchandise, unless he had made such use of them before reciprocity as to protection went into force, provided that no one is prevented from using as a mark the initials of his name or of his firm name. Registration of a mark in order to have the effect here indicated must be effected within a definite period, to be fixed by the King.

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#### SECTION 14.

##### ORANGE FREE STATE.

(Not a party to the Convention.)

##### PATENTS.

(Law of 1888.)

ART. 45. The exhibition of an invention at an international or industrial exhibition, or the publication of a description of the invention for the purposes of the exhibition in the place where the same is held, or the use of the invention during the holding of the exhibition by another person not authorized by the inventor elsewhere, shall not prejudice the right of the inventor or his legal representative to apply for and obtain provisional protection and letters patent for the invention, nor the validity of the letters patent granted upon such application, provided that both the following conditions are complied with:

(a) The exhibitor must, before exhibiting his invention, give the attorney-general written notice of his intention to do so.

(b) His application for letters patent must be made before or within six months after the opening of the exhibition.

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#### SECTION 15.

##### PORTUGAL.

##### (a) PATENTS.

(Law of December 15, 1894, as amended and finally adopted May 21, 1896.)

ART. 9. An invention shall not be considered new if it has been described in any publication within one hundred years, or has been used in Portugal or its dominions in a public manner.

The fact of the publication of descriptions, made by reason of the grant of a patent of invention in some foreign country allied with

Portugal by a special convention on this subject, shall not invalidate a patent granted in Portugal, except in the case of the application for this patent having been made to the Department of Industry after the expiration of the term of the right of priority fixed by the international convention in question.

ART. 27. The right to the grant of the privilege of invention belongs to the first to present the application accompanied by the corresponding documents to the department of industry.

The person who has regularly made an application for a privilege of invention in one of the countries allied with Portugal by a special convention on this subject shall, however, enjoy the right of priority for a patent in Portugal, reserving the rights of third parties during the term fixed by the international convention in question.

ART. 29. Whoever has obtained a patent of invention in a foreign country allied to Portugal by a convention on this subject, may, if he makes a declaration to that effect, obtain an antedate for the patent, which shall be granted to him as of the date of the patent in the country of origin.

This provision, however, only applies in cases where the patent is applied for within the term fixed for the right of priority by the international convention in question.

#### (b) TRADEMARKS.

(Law of December 15, 1894, as amended and finally adopted May 21, 1896.)

ART. 77. The registration of international marks shall be effected in the terms of the convention of Madrid of the 14th of April, 1891, and ratified on the 11th of October, 1893.

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### SECTION 16.

#### QUEENSLAND.

##### PATENTS.

(British colony.)

(Law of October 13, 1884.)

SEC. 42. The exhibition of an invention at an industrial or international exhibition, certified as such by the minister, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or the consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:

(a) The exhibitor must, before exhibiting the invention, give the registrar the prescribed notice of his intention to do so; and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

[ (Act No. 8 of 1890.) ]

SEC. 12. It shall be lawful for the governor in council, by order in council, from time to time to declare that sections forty-two and fifty-seven of the principal act, or either of these sections, shall apply to any exhibition mentioned in the order, wherever held, in like manner as if it were an industrial, intercolonial, or international exhibition certified by the minister, and to provide that the exhibitor shall be relieved from the conditions, specified in the said section, of giving notice to the registrar of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to the governor in council may seem fit.]

SEC. 80. (1) If Her Majesty is pleased by order in council to apply the provisions of the said one hundred and third section of the imperial act, called "The patents, designs, and trade-marks act, 1883," to the colony of Queensland, then any person who has applied for protection for any invention in England or in any foreign State, with the Government of which Her Majesty has made an arrangement under the said section for mutual protection of inventions, shall be entitled to a patent for his invention under this act, in priority to other applicants; and such patent shall take effect from the same date as the date of the *application*<sup>1</sup> in England or such foreign State, as the case may be.

*Provided*, That his application is made within twelve months from his applying for protection in England or the foreign State with which the arrangement is in force.

*Provided*, That nothing in this section contained shall entitle the patentee to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in this colony.

(2) The publication in Queensland, during the periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, shall not invalidate the patent which may be granted for the invention.

(3) The application for the grant of a patent, under this section, must be made in the same manner as an ordinary application under this act.

(4) The provisions of this section shall, in the case of foreign States, apply only in the case of those foreign States with respect to which Her Majesty shall from time to time, by order in council, declare the provisions of the aforesaid section of the said imperial act to be applicable, and so long only in the case of each State as the order in council shall continue in force with respect to that State.

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## SECTION 17.

### SOUTH AFRICAN REPUBLIC.

(Not a party to the Convention.)

#### PATENTS.

(Law of 1898.)

ART. 51. The exhibition of an invention at an international or industrial exhibition, or the publication of a description of the invention

<sup>1</sup>NOTE.—This word was substituted for *protection obtained* by s. 8 of act No. 5 of 1886.



during the period of the exhibition, or the use of the invention for the purposes of the exhibition in the place where the same is held, or the use of the invention during the holding of the exhibition by another person not authorized by the inventor elsewhere, shall not prejudice the right of the inventor or his legal representative to apply for and obtain provisional protection and letters patent for the invention, nor the validity of the letters patent granted upon such application, provided that both the following conditions are complied with:

(a) The exhibitor must, before exhibiting his invention, give the commissioner written notice of his intention to do so.

(b) His application for letters patent must be made before or within six months after the opening of the exhibition.

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## SECTION 18

### SPAIN.

#### PATENTS.

(Law of August 16, 1888.)

ART. I. Temporary protection for six months will be given to every invention, which can be the subject of a patent of invention, to all trademarks and to designs and industrial models shown in international exhibitions officially held in Spain or officially recognized as such.

ART. II. The term of six months shall be counted from the day on which the article was admitted into the exhibition.

During the said term the exhibition, publication, or use without the permission of the inventor shall not prevent him or his representative from applying during the said six months for a patent of invention, protection for trademarks or for designs or industrial models referred to in Article I of this decree, nor from effecting the applications necessary for securing definite protection in all the countries which constitute the International Convention for the Protection of Industrial Property.

ART. III. The said temporary protection shall be of no effect if the definitive patent be not applied for within the term of six months mentioned above.

ART. IV. A certificate of the said temporary protection shall be issued without charge.

ART. V. These certificates shall be issued by the royal commissions of the exhibitions, who shall keep a register thereof and shall communicate them forthwith to the direction general of agriculture, industry, and commerce, by which they shall be published in the Madrid Gazette and the Official Journal of Intellectual and Industrial Property of the Ministry of the Interior.

ART. VI. At the close of each exhibition the royal commission shall send the original register mentioned in the preceding article to the direction general of agriculture, industry, and commerce.

## SECTION 19.

## SWEDEN.

## (a) PATENTS.

(Law of May 16, 1884, as amended March 26, 1897.)

ART. 3. An invention shall not be considered as new if it has, prior to filing the application for a patent with the patent authorities, been so described in any printed publication to which the public has access, or is so openly worked that any person conversant with the subject may, guided by the information thus gained, work the invention, or if the object of the invention does not essentially differ from products or methods of manufacture which have before become so known.

Should an invention have been shown in an international exhibition, the fact that the invention has thereby or afterwards become known by a printed description, or through use of the invention, shall nevertheless not be an obstacle to the granting of a patent, provided the application for it is lodged within six months after the exhibition of the invention.

ART. 25. With regard to inventions protected in a State which grants reciprocity to inventions patented in the Kingdom the King may decree:

That if any person applies for a patent in the Kingdom for an invention before the expiration of a given time, which may be fixed by decree, but not to exceed seven months from the date of the application for protection of the same invention in the foreign State or three months from the publication by the competent authorities of the granting of such protection, then the application made in the Kingdom shall be considered with reference to other applications and to the restrictions mentioned in section 3 as if made simultaneously with the application in the foreign State.

This law shall come into force January 1, 1898.

## (b) TRADEMARKS.

(Law of July 5, 1884.)

ART. 16. The King may decree, after the conclusion of a convention with a foreign country and on condition of reciprocity, that the protection given to trademarks by the present law shall be equally accorded to those who, in a foreign country, are engaged in industry of the kind mentioned in Article I. The provisions of the law shall, in consequence, be applicable in such case, provided the following special regulations with reference to filing trademarks are observed:

1. The application must be accompanied by a certificate showing that the applicant has complied with the formalities required in the foreign country for protection of his trademark.

2. The interested party to whom registration has been granted shall have a representative domiciled in Sweden, who shall take action in his name in all matters relating to the mark; the former shall, as a consequence, be required, after the presentation of his application,

whenever a change of representative is made, to state the name and domicile of the representative, under penalty of having, in case it shall be stated that he has not observed this formality, the court, on the statement that may be made, officially designate a representative.

3. The trademark is not protected to a greater degree or for a longer term than in the foreign country.

In reference to trademarks registered in countries which accord the same privileges to Swedish trademarks, the King may make the following provisions:

4. The trademark, if it is not contrary to morality or to public order, shall be registered in the form in which it is protected in the foreign country.

5. If registration of a mark has been applied for before the expiration of a certain period, which may be fixed either at four months or more from the date on which the application for registration was filed in the foreign country or at three months or more from the date of publication of the official announcement of the registration, the application filed in Sweden shall, relative to other applications, be considered to have been made simultaneously with the application in the foreign country.

6. If, registration having been refused for the reason mentioned in article 4, paragraph 5, after the person or persons who uses the trademark previously filed or registered has been summoned before the tribunals the applicant furnishes proof that the trademark was originally used by him, but that another has appropriated it, the tribunal may declare the applicant entitled to register the trademark and to have the exclusive right to use it for the goods on which the provisions respecting reciprocal protection went into force. An application intended to have this effect shall not be receivable six months after the said date.

7. All trademarks which have been regularly registered in a foreign country before the reciprocal protection went into force and which are composed wholly or principally of figures, letters, or words not capable of being registered separately under the terms of article 4, shall have after their registration in Sweden, so long as they are protected in the foreign country, a special protection consisting in this, that others can not make use of the same figures, letters, or words as trademarks for the same kind of goods, provided they have not already been used as such before reciprocal protection went into force. Nevertheless the registration of these trademarks, except as concerns trademarks for iron and for wood, prevent any one from using as a trademark the initials of his proper name or those of his commercial name.

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## SECTION 20.

### SWITZERLAND.

#### PATENTS.

(Law of June 29, 1888.)

ART. 32. The citizens of countries which have concluded with Switzerland a convention to that effect may, within the period of seven months from the date of application for a patent in one of the said countries, and reserving the rights of third parties, lodge their appli-



cation in Switzerland, without circumstances which have taken place in the interval, such as another application for a patent, or the fact of publication, being brought against the validity of their application for a patent.

The same advantage shall be granted to Swiss citizens who have lodged their first application for a patent in one of the countries indicated in the preceding paragraph.

ART. 33. There shall be granted to every inventor of a patentable product exhibited in a national or international exhibition in Switzerland, upon the fulfillment of the formalities to be prescribed by the Federal Council, temporary protection for six months, commencing on the day of the admission of the product into the exhibition; during which term applications for patents which may be made or acts of publication which may take place shall not prevent the inventor from validly making within the said period the application for the patent necessary for obtaining complete protection.

When an international exhibition shall take place in a country which has concluded with Switzerland a convention to this effect, the temporary protection granted by the foreign country to patentable products exhibited in the said exhibition shall extend to Switzerland during a period not exceeding six months from the day of the admission of the product into the exhibition, and shall have the same effect as that mentioned in the preceding paragraph.

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## SECTION 21.

### TASMANIA.

#### PATENTS.

(Law of September 29, 1893.)

ART. 65. The exhibition of an invention at any colonial, intercolonial, or international exhibition held at any place either within or beyond the colony, and declared by the governor in council by notification in the Gazette to be an "industrial exhibition" for the purposes of this act, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, subject as follows, namely:

In the case of an exhibition held at any place within the colony—

- (1) The exhibitor must, before exhibiting the invention, give the registrar notice of his intention to do so; and
- (2) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

In the case of an exhibition held at any place outside the colony—

The foregoing conditions shall also apply; but the governor in council may exempt, either absolutely or upon such terms and conditions as he shall think fit, any exhibitor from the conditions of giving previous notice to the registrar of his intention to exhibit.

ART. 106. (1) If Her Majesty is pleased, by order in council, to apply the provisions of section 103 of the imperial act called "The patents, designs, and trade-marks act, 1883," to the colony of Tasmania, then any person who has applied for any protection for any invention design, or trademark, in England or in any foreign State with the Government of which Her Majesty has made an arrangement under the said section for mutual protection of inventions, designs, or trade-marks, or any of them, shall be entitled to a patent for his invention or to registration of his design or trademark, as the case may be, under this act, in priority to other applicants; and such patent or registration shall take effect from the same date as the date of the application in England or such foreign State, as the case may be: *Provided*, That his application is made, in the case of a patent, within twelve months, and in the case of a design or trademark within six months, from his applying for protection in England or the foreign State with which the arrangement is in force.

Nothing in this section contained shall entitle the patentee or proprietor of the design or trademark to recover damages for infringements happening prior to the date of the actual acceptance of his specifications or the actual registration of his design or trademark in this colony, as the case may be.

(2) The publication in Tasmania during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trademark, shall not invalidate the patent which may be granted for the invention or the registration of the design or trademark.

(3) The application for the grant of a patent for the registration of a design or the registration of a trademark under this section must be made in the same manner as an ordinary application under this act, but in the case of trademarks, any trademark the registration of which has been duly applied for in the country of origin may be registered under this act.

(4) The provisions of this section shall, in the case of foreign States, apply only in the case of those foreign States with respect to which Her Majesty shall, from time to time, by order in council, declare the provisions of the aforesaid section of the said imperial act to be applicable, and so long only in the case of each State as the order in council shall continue in force with respect to that State.

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## SECTION 22.

### VICTORIA.

#### PATENTS.

(Law of July 10, 1890.)

SEC. 55. Where Her Majesty has, by order in council, applied, or has signified her intention of applying, the provisions of section one hundred and three, or any portion thereof, of an act of the Imperial Parliament called "The Patents, Designs, and Trademarks act, 1883," as amended by any subsequent act, to Victoria, the provisions of the

last preceding section may, by order of the Governor in Council, be applied for the protection of inventions patented in the United Kingdom. Any such order in Council may be at any time revoked.

SEC. 56. (1) Notwithstanding anything in any act of Parliament contained, where any patent or like privilege for the monopoly or exclusive use or exercise in any parts out of Victoria of any invention first invented in parts out of Victoria has been obtained, a patent may be granted for such invention at any time within one year from the date of the granting of the first of any such patents or privileges, notwithstanding that such invention has been used or published in Victoria within such period of one year, and such patent, when granted, shall have the same force and effect as if such prior publication or use had not taken place.

(2) If such use or publication have been made in Victoria with the consent of the true and first inventor, for the time being such inventor shall not be entitled to a grant of letters patent under the authority of this section.

SEC. 62. The exhibition of an invention at an industrial or international exhibition, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere without the privity or consent of the true and first inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:

(a) The exhibitor must, before exhibiting the invention, give the Commissioner one month's notice of his intention to do so; and

(b) The application for a patent must be made before or within twelve months from the date of the opening of the exhibition.

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## SECTION 23.

### WESTERN AUSTRALIA.

#### PATENTS.

(Law of October 10, 1894.)

ART. 3. (1) If Her Majesty is pleased, by order in Council, to apply the provisions of the said section 103 of the imperial act, called "The patents, designs, and trade-marks act, 1883," to the colony of Western Australia, then any person who has applied for protection for any invention, design, or trademark in England, or in any foreign State with the Government of which Her Majesty has made an arrangement under the said section for mutual protection of inventions, designs, or trademarks, or any of them, shall be entitled to a patent for his invention, or to registration of his design or trademark (as the case may be) under this act, in priority to other applicants; and notwithstanding anything contained in "the patent act, 1888," or "the designs and trademarks act, 1884," such patent or registration shall take effect from the same date as the date of the application in England or such foreign State (as the case may be).



(2) Such application shall be made in the case of a patent within seven months, and in the case of a design or trademark within four months from such person applying for protection in England or the foreign State with which the arrangement is in force.

(3) Nothing in this section contained shall entitle the patentee or proprietor of the design or trademark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trademark (as the case may be), in Western Australia.

(4) The publication in Western Australia during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trademark, shall not invalidate the patent granted for the invention, or the registration of the design or trademark.

(5) The application for the grant of a patent or the registration of a design or the registration of a trademark under this section shall be made in the same manner as an ordinary application under "the patent act, 1888," or "the designs and trade-marks act, 1884" (as the case may be).

(6) In the case of trademarks, any trademark the registration of which has been duly applied for in the country of origin may be registered under this act.

(7) The provisions of this section shall, in the case of foreign States, apply only in the case of those foreign States with respect to which Her Majesty from time to time, by order in council, declares the provisions of the aforesaid section 103 of the said first recited imperial act to be applicable, and so long only in the case of each State as such order continues in force with respect to that State.

NOTE.—The above extracts are taken from the patent laws of Brazil, Ceylon, Denmark, France, India, Orange Free State, Portugal, Queensland, South African Republic, Spain, Sweden, Switzerland, and Victoria, as published in Patent Laws of the World, edition 1899 (Chartered Institute of Patent Agents, London); from the patent laws of New South Wales, New Zealand, Tasmania, and Western Australia, and the trademark law of Portugal, as published in Supplements to Carpmael's Patent Laws of the World; from the patent law of Great Britain and the trademark laws of Brazil and Netherlands, as published in the Official Gazette of the United States Patent Office; from the French translation of the patent laws of Italy, Norway, and the trademark laws of Denmark, Norway, and Sweden, as published by the International Bureau of Industrial Property at Berne in *Recueil Général de la législation, &c.*, and in *La Propriété Industrielle* (translations); from an official copy of the patent law of Malta, and from translations of the patent and trademark laws of Japan.

## CHAPTER XII.

### LAW OF CANADA AS TO OATH BY APPLICANT FOR PATENT.

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#### CANADA.

Law of 1892.

Section eight of the patent act, chapter sixty-one of the Revised Statutes, is hereby repealed, and the following substituted therefor:

\* \* \* \* \*

2. The third subsection of section ten of the said act is hereby repealed, and the following substituted therefor.

“3. Such oath or affirmation may be made before a minister plenipotentiary, *chargé d'affaires*, consul, vice-consul, or consular agent, a judge of any court, a notary public, a justice of the peace, or the mayor of any city, borough, or town, or a commissioner for taking affidavits having authority or jurisdiction within the place where the oath may be administered.”

NOTE.—The above extract is taken from the patent law of Canada, as published in the Patent Laws of the World, edition 1899 (Chartered Institute of Patent Agents, London).

## CHAPTER XIII.

### FOREIGN COUNTRIES WHICH HAVE PATENT LAWS.

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The following list of countries which at the present time provide by law for the grant of patents for inventions, with the dates of the laws at present in force, together with the statement following the list, is taken by permission from Greeley's Foreign Patent and Trademark Laws (Washington, 1899):

- Argentine Republic: Law of October 11, 1864.
- Austria: Law of June 11, 1897.
- Bahama Islands: Law of May 23, 1889; amended March 3, 1890, and June 5, 1891.
- Barbados: Law of December 12, 1883.
- Belgium: Law of May 24, 1854; amended March 27, 1857; amended July 5, 1884.
- Bolivia: Law of May 8, 1858.
- Brazil: Law of October 14, 1882.
- British Guiana: Law of July 17, 1861; revised 1895.
- British Honduras: Law of September 10, 1862.
- British New Guinea: Law of 1842.
- British North Borneo: Law of March 17, 1887.
- British South Africa (Rhodesia, Mashonaland, and Matabeleland): Law of July 6, 1897.
- Canada: Law of June 14, 1872; amended July 9, 1892, and April 1, 1893.
- Cape Colony: Law of 1860.
- Ceylon: Law of November 21, 1892.
- Chile: Law of September 9, 1840; amended August 1, 1851; amended August 16, 1856; amended July 25, 1872; amended January 20, 1883.
- Colombia: Law of May 13, 1869.
- Congo Free State: Law of October 29, 1886.
- Costa Rica: Law of June 26, 1896.
- Denmark: Law of April 13, 1894.
- Ecuador: Law of November, 3 1880.
- Fiji Islands: Law of 1879.
- Finland: Law of January 21, 1898.
- France: Law of July 5, 1844; amended May 23, 1856; amended May 23, 1868.
- French Indo-China: Law of June 24, 1893.
- Germany: Law of April 7, 1891.
- Great Britain, Statute of Monopolies of 1623: Law of August 25, 1883; amended June 25, 1886, and December 24, 1888.
- Guatemala: Law of December 17, 1897.
- Hawaii: Law of August 29, 1884; amended June 23, 1888; amended 1896.
- Hongkong: Law of April 1, 1892.
- Hungary: Law of July 14, 1895.
- India (British): Law of March 16, 1888.
- Italy: Law of October 30, 1859; amended January 31, 1864; amended August 4, 1894; amended January 16, 1898.
- Jamaica: Law of 1857; amended May 27, 1891.
- Japan: Law of March 1, 1899.
- Leeward Islands: Laws of 1876 and 1878.
- Liberia: Law of December 23, 1864.
- Luxemburg: Law of June 30, 1881.
- Malta: Law of 1899.



Mauritius: Law of 1875.

Mexico: Law of June 7, 1890; amended June 22, 1896.

Mysore: Law of 1894.

Natal: Law of 1870; amended 1871; amended January 12, 1872, and 1884.

Negri Sembilan: Law of April 9, 1896.

Newfoundland: Title XV, Cap. LIV, Consolidated Statutes.

New South Wales: Law of December 6, 1852; amended July 8, 1887; amended November 16, 1896; amended December 10, 1897.

New Zealand: Law of September 2, 1889.

Norway: Law of June 16, 1885.

Orange Free State: Law of 1888.

Perak: Law of April 29, 1896.

Peru: Law of January 28, 1869; amended January 3, 1896.

Portugal: Law of December 15, 1894; amended and finally adopted May 21, 1896.

Queensland: Law of October 13, 1884; amended November 5, 1890.

Russia: Law of May 20-June 1, 1896.

St. Helena: Law of 1872.

Selangor: Law of March 21, 1896.

South African Republic: Law of 1897.

South Australia: Law of December 21, 1877; amended 1888.

Spain: Law of July 30, 1878; August 16, 1888.

Straits Settlements: Law of 1871.

Sweden: Law of May 16, 1884; amended April 14, 1893; amended March 26, 1897, and May 28, 1897; amended May 7, 1898.

Switzerland: Law of June 29, 1888; amended March 13, 1893.

Tasmania: Law of September 29, 1893.

Trinidad and Tobago: Law of November 19, 1894.

Tunis: Law of December 26, 1888.

Turkey: Law of March 2, 1880.

Uruguay: Law of November 11, 1885.

Venezuela: Law of May 25, 1882; amended May 14, 1897.

Victoria: Law of November 25, 1889; amended July 10, 1890.

Western Australia: Law of November 26, 1888; amended 1892, and October 10, 1894.

In a number of countries other than those above named protection for inventions may be obtained by special legislative or government grant. Such protection, whatever its effect, is hardly to be classed with that afforded by a general law, and is rather in the nature of a monopoly created by a government concession for commercial purposes.

In the list above given, in which patent laws are in force to-day, are found nearly all the countries of the world which are of industrial importance. But one country in the world, the Netherlands (Holland), which has once adopted a patent law is without such law to-day. The recent date of so large a proportion of the laws given in the list is not to be understood as indicating, except in case of comparatively few, and those not the more important, that these countries were without patent laws up to the date given. These new laws, in the case of the older and more important countries, take the place of laws which have been in force for many years.

## CHAPTER XIV.

### LAWS OF CERTAIN FOREIGN COUNTRIES REQUIRING NONRESIDENT APPLICANTS FOR PATENT AND FOR REGISTRATION OF TRADEMARKS TO PLACE THEMSELVES WITHIN THE JURISDICTION OF THE COURTS OF THE COUNTRY.

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#### SECTION 1.

##### AUSTRIA.

(Not at present a party to the Convention.)

##### PATENTS.

(Law of January 11, 1897.)

SEC. 7. Any person not residing in the country may only claim the grant of a patent and the rights resulting therefrom if he has a representative residing in the country.

The name and residence of this representative, and also every change in the representation, shall, together with the power of attorney, be lodged at the patent office for entry in the register of patents.

It shall be determined by regulations what the power to be deposited at the patent office shall contain.

The place at which the representative has his residence, and in default of the same the place at which the patent office has its seat, shall serve for the business concerning the patent as residence of a patentee not residing in the country.

Delivery to the representative shall have the same legal effect as if it had been to the patentee himself.

---

#### SECTION 2.

##### BRAZIL.

##### PATENTS.

(Law of October 14, 1882.)

ART. V. SEC. 2. The patent shall lapse in the following cases:

\* \* \* \* \*

4. If a patentee residing out of the Empire does not appoint an attorney to represent him before the Government or in court.

\* \* \* \* \*

## SECTION 3.

## CANADA.

(British colony.—Not at present a party to the Convention.)

## PATENTS.

(Law of June 14, 1872.)

ART. XII. The petitioner for a patent shall, for all the purposes of this act, elect his domicile at some known and specified place in Canada, and mention the same in his petition for a patent.

## SECTION 4.

## CEYLON.

(British colony.—Not a party to the Convention.)

## PATENTS.

(Law of 1892.)

11. (1) Another book, to be called the “Address Book,” shall be kept in the office of the colonial secretary, wherein any person or persons filing a specification under this ordinance, or any person or persons in whom an exclusive privilege acquired under this ordinance, or any share or interest therein, may become vested, may from time to time cause to be stated some place in the colony where notice of any rule or proceeding relative to the exclusive privilege may be served on him or them.

## SECTION 5.

## DENMARK.

## (a) PATENTS.

(Law of April 13, 1894.)

SEC. 13. If the applicant does not reside in this country, the application shall be accompanied by a statement by the applicant to the effect that an attorney residing in this country is to represent him in all matters concerning the patent, and thus especially on his behalf to accept notices in legal actions which may be brought against him under this law; the said statement shall have an endorsement by the attorney that he accepts the power of attorney.

SEC. 23. A patent lapses:

\* \* \* \* \*

(2) When the holder of the patent goes to reside outside the realm, or the patent is assigned to a person residing outside the realm, unless a statement appointing an attorney, as prescribed in section 13, is lodged with the patent commission within six weeks thereof.



(3) When the attorney whose name has been given to the patent commission by the holder of the patent no longer will or can attend to the duties of attorney, and the holder of the patent after being informed thereof by registered letter from the patent commission, or, if his place of residence be unknown after being notified by advertisement, shall not within a term fixed by the commission lodge a statement appointing a new attorney.

(b) TRADEMARKS.

(Law of April 11, 1890.)

ART. 14. The king may decree, under condition of reciprocity, that the protection for trademarks given by the present law shall be equally accorded to those engaged, in a foreign country, in industry of the kind mentioned in article 1. The provisions of the present law shall in consequence be applicable in such case provided the following rules with reference to the filing of trade-marks are observed:

\* \* \* \* \*

2. The applicant shall submit to the jurisdiction of the maritime and commerce tribunal of Copenhagen and designate a representative domiciled in the country who shall take action in his name.

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SECTION 6.

FINLAND.

(Not a party to the Convention.)

(a) PATENTS.

(Law of January 21, 1898.)

SEC. 6. Any person wishing to obtain a patent shall make written application therefor to the Industrial Board. The application shall contain the title of the invention and particulars of the calling and address of the applicant, and shall be accompanied by; \* \* \* when the applicant resides out of the country, a power for an attorney resident within the country to speak and act for the applicant in everything concerning the patent; the calling and address of the attorney should also be given.

(b) TRADEMARKS.

(Law of February 11, 1889.)

SEC. 9. Any merchant of a country in which citizens of Finland enjoy similar privileges, may, by conforming to the regulations in reference to trademarks in force in the Grand Duchy, register a trademark which he has previously registered in his own country, and obtain protection therefor in Finland.

\* \* \* \* \*

In applying for registration \* \* \* further, he must indicate the name of a representative resident in the Grand Duchy, who shall represent him in all matters relative to the trademark.

## SECTION 7.

## GERMANY.

(Not a party to the Convention.)

## (a) PATENTS.

(Law of May 26, 1891.)

SEC. 12. Any person not residing within the realm can only claim the grant of a patent, and the right accruing therefrom, if he has appointed a representative within the realm. The latter is empowered to represent the applicant in all proceedings under this law, as also in all civil litigation concerning the patent and actions for penalties or damages. The place where the representative resides, and in the absence of such a residence, the place where the patent office is located, is to be taken as the place of jurisdiction, according to section 24 of the law on civil actions.

With the consent of the Federal Council the Imperial Chancellor can decree that a right of retaliation shall be put in force against the citizens of a foreign State.

## (b) TRADEMARKS.

(Law of May 12, 1894.)

SEC. 23. A person not having an establishment in Germany can have a claim to the protection of this law only when, according to a publication in the *Reichs Gesetz Blatt*, the State in which his establishment is situated accords to German merchandise marks protection to the same extent as to domestic marks.

The protection of a merchandise mark and the rights resulting from registry can be claimed only through the medium of a proxy residing in the country. Such proxy shall have power to represent his principal in the proceedings before the Patent Office under this law, as well as in civil actions concerning the mark; he shall also be empowered to institute penal actions. Either the court within whose protection the proxy is domiciled or that of the place where the Patent Office is situated is competent to try suits against the registered owner of a mark.

## SECTION 8.

## GREAT BRITAIN.

## TRADEMARKS.

(Patents, Designs, and Trademarks act, 1883, as amended December 24, 1888.)

SEC. 62 (6). Where the applicant for the registration of a trade-mark otherwise than under an international convention is out of the United Kingdom at the time of making the application, he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.

## SECTION 9.

## GREECE.

## TRADEMARKS.

(Law of January 16, 1893.)

ART. XIII. Foreigners and Greek subjects carrying on their industry or commerce outside of Greece shall enjoy the benefit of this law, if in the country where they are located there is a law for the protection of trademarks and a diplomatic convention for the reciprocal protection of Greek trademarks. Provided that it shall be necessary for the enjoyment of this privilege in Greece, besides the deposit of the mark, first, to produce a certificate from competent local authority, authenticated by the Greek consul, establishing the fact that the formalities required by the laws of the applicant's country to secure protection of the mark have been complied with; second, to elect before a notary a domicile at Athens; to declare in writing that the applicant submits to the jurisdiction of the Athenian Tribunals.

## SECTION 10.

## HUNGARY.

(Not a party to the Convention.)

## PATENTS.

(Law of July 7, 1895.)

SEC. 15. A person not normally residing in the country can obtain a patent, and exercise the rights originating therefrom, only after appointing, by a special power of attorney duly legalized and lodged in the Patent Office, a representative residing in the country.

Such representative is authorized to represent his client before the patent authorities and courts of law, to lodge requests relating to the application, to keeping in force the patent, to instituting penal proceedings, and to receive decisions on complaints and other decisions.

For actions against owners of patents residing abroad the court within the jurisdiction of which the representative has his residence is competent, or, if the owner has no representative, the court which has the seat of the Patent Office within its jurisdiction.

If the representative of the owner of a patent residing abroad renounces the power of attorney conferred upon him, or if he can not be found, and the owner of the patent has not appointed a new representative, or if the owner of the patent residing in the country settles abroad or can not be found, the patent authorities and the courts of law appoint a curator to represent the owner of the patent.



## SECTION 11.

## INDIA.

(British colony.—Not a party to the Convention.)

## PATENTS.

(Law of 1888.)

13. (1) Another book, to be called the Address Book, shall be kept in the Office of the Secretary, wherein any person filing a specification under this part, or any person in whom an exclusive privilege acquired under this part, or any share or interest therein may become vested, may from time to time be stated some place in British India where notice of any rule or proceeding relating to the exclusive privilege may be served on him.

## SECTION 12.

## JAPAN.

## (a) PATENTS.

(Law of March 1, 1899.)

ART. VI. Any person desiring to make an application or petition in regard to a patent, or any owner of a patent, not domiciled in the Empire, shall appoint a person domiciled in the Empire to be his agent.

Such agent shall represent his principal in any proceedings taken in the Patent Bureau which are provided for by this act or provided for by ordinances issued under this act, and in civil actions or criminal prosecutions relating to patents.

ART. VII. The President of the Patent Bureau may direct the appointment of another agent whenever in his opinion the agent appointed for the purpose relating to the patent is not satisfactory.

ART. VIII. Any person making agency in matters relating to patents, his profession shall be registered in the Patent Bureau.

The regulations regarding the registration of patent agents shall be prescribed by ordinance.

\* \* \* \* \*

ART. XXXVIII. The President of the Patent Bureau shall have the power to annul a patent under the following circumstances:

\* \* \* \* \*

(c) When the owner of a patent has, without reasonable cause, failed for more than six months to appoint and maintain the grant provided for in Article VI.

## (b) TRADEMARKS.

(Law of March 1, 1899.)

ART. XX. The provisions of the patent act, Articles VI-X \* \* \* shall apply to trademarks.

## SECTION 13.

**LUXEMBURG.**

(Not a party to the Convention.)

*(a)* PATENTS.

(Law of June 30, 1880.)

ART. 9. No one can obtain a patent nor exercise rights under a patent unless he has elected domicile in the Grand Duchy. If he is a foreigner, he must elect domicile with some one holding a power to represent him, and to whom all communications may validly be made. The domicile elected determines jurisdiction, and will be valid so long as it is not replaced by a new election of domicile in the form prescribed by article 13.

*(b)* TRADEMARKS.

(Law of May 30, 1883.)

ART. 6. Foreigners and citizen of Luxemburg, who, in accordance with the provisions of article 9, section 2, of the foregoing law, wish to enjoy the benefit of this law, must, in addition to complying with the formalities above set forth, elect domicile in the Grand Duchy.

Mention of this election, which shall be determinative of jurisdiction as well as of the diplomatic convention by which reciprocity is established, must be made in the written statement filed.

## SECTION 14.

**MYSORE.**

(Not a party to the Convention.)

## PATENTS.

(Law of 1894.)

SEC. 13. (1) Another book, to be called the address book, shall be kept in the office of the chief secretary, wherein any person filing a specification under this part, or any person in whom an exclusive privilege acquired under this part, or any share or interest therein, may become vested, may from time to time cause to be stated some place in the Territories of Mysore where notice of any rule or proceeding relating to the exclusive privilege may be served on him.

## SECTION 15.

**NEGRI SEMBILAN.**

(Dependency of Great Britain.—Not a party to the Convention.)

## PATENTS.

(Law of April 9, 1896.)

SEC. 22. A book shall be kept in the office of the British resident (such book to be open to inspection without fee) wherein every

person filing a specification shall cause to be stated, under a number corresponding with the number of the specification, some place in the State where service of any orders or proceedings for the purpose of canceling or revoking his grant of exclusive privilege, or of any other process, may be made. Any person, partnership or company from time to time being proprietors of or having shares or interests in such exclusive privilege, shall cause to be entered in such book, under such number as aforesaid, their names, together with the name of some place for the service of such orders, proceedings, and processes as aforesaid; and all such orders, proceedings, and processes shall be deemed sufficiently served on any such person, partnership, or company if a copy thereof be left at the place entered in such book, or (if any other place be substituted for the same by entry in the said book) at the place last substituted, by delivering the same to any person resident at or in charge of such place; or, if there be no person resident at or in charge of such place, and if any such person, partnership, or company shall neglect to make or cause to be made such entry, then service of such order, proceeding, or process may be effected by affixing a copy thereof in such other manner as the court may direct.

The same provision is found in the law of April 29, 1896, of Perak, section 22, and in the law of March 21, 1896, of Selangor, section 22.

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#### SECTION 16.

##### NETHERLANDS.

##### TRADEMARKS.

(Law of September 13, 1893.)

ART. 14. All persons who have no domicile within the Kingdom in Europe, on sending in the marks mentioned in article 4 or article 7, and on presenting petitions according to articles 9, 10, or 13, must select domiciles within the Kingdom.

All summonses shall be served at the domiciles selected.

---

#### SECTION 17.

##### NORWAY.

##### (a) PATENTS.

(Law of June 16, 1885.)

SEC. 13. If the applicant does not reside in Norway, etc., he must appoint in his petition an attorney resident in the country to represent him in all matters relating to the patent who may be summoned in his place. An attested copy of the power of attorney appointing the representative, and accepted by him, shall be annexed to the petition.

An application which is not signed by the applicant himself must be accompanied by a proper power of attorney in favor of the person who has signed it.

SEC. 25. A patent becomes void:

\* \* \* \* \*



(2) If the appointed attorney no longer can or will discharge his duties, and the patentee does not register with the patent commission a new attorney within three months after being warned by advertisement in the gazette designed for such publications.

(b) TRADEMARKS.

(Law of May 16, 1885.)

ART. 15. The King may decree, under condition of reciprocity, that persons in a foreign country engaged in industries such as are enumerated in article 1 shall likewise be accorded the protection of the present law. The provisions of the present law are applicable in such cases, provided the following special regulations respecting the filing of the trademarks are complied with:

\* \* \* \* \*

(2) In all matters respecting the trademark the applicant shall acknowledge the jurisdiction of the court of Christiania, and shall designate a representative domiciled in the country, who shall be empowered to act in his name.

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SECTION 18.

RUSSIA.

(Not a party to the Convention.)

PATENTS.

(Law of May 20-June 1, 1896.)

ART. 5. Whoever wishes to obtain a patent of invention or of improvement must send in person or by an agent a petition. \* \* \* If the petitioner is domiciled abroad, his application must be presented by an agent domiciled in Russia.

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SECTION 19.

SOUTH AFRICAN REPUBLIC.

(Not a party to the Convention.)

TRADEMARKS.

(Law of May 31, 1892.)

ART. 1. \* \* \* Any person not having domicile in the country may effect the deposit for registration through a representative appointed by a written power of attorney, domiciled in the country at whose house the applicant must elect his domicile.

## SECTION 20.

## STRAITS SETTLEMENTS.

(British colony—Not a party to the Convention.)

## PATENTS.

(Law of 1871.)

ART. 23. A book shall be kept in the office of the colonial secretary (such book to be open to inspection without fee), wherein every person filing a specification under this ordinance shall cause to be stated, under a number corresponding with the number of the specification, some place in the Settlement where service of any rules or proceedings for the purpose of cancelling or revoking his exclusive privilege, or of any other process, may be made. Any person, partnership, or company, from time to time, being proprietors of, or having shares, or interests in, such exclusive privilege, shall cause to be entered in such book, under such numbers as aforesaid, their names, together with the name of some place for the service of such proceedings and process as aforesaid. All such rules, proceedings, and process shall be deemed sufficiently served on any such person, partnership, or company, if a copy thereof be left at the place entered in such book, or (if any other place be substituted for the same by entry in said book) at the place last substituted, by delivering the same to any person resident at or in charge of such place; or if there be no person resident at or in charge of such place, and if such person, partnership, or company shall neglect to make or cause to be made such entry, then service of such rule, proceeding, or process may be effected by affixing a copy thereof to a conspicuous part of the supreme court house, or in such other manner as the court may direct.

## SECTION 21.

## SWEDEN.

## (a) PATENTS.

(Law of May 16, 1884.)

SEC. 4. If the applicant be not resident in the country, he must attach to the application an authorization for someone residing within the Kingdom to act as his representative, empowered to answer for him in all matters concerning the patent.

SEC. 13. If the holder of the patent go abroad, or the patent be transferred to a person not residing in the Kingdom, the holder of the patent shall be required to send in to the patent authority the power of attorney for a legal representative, as mentioned in section 4, first section. If the representative of the holder of the patent leave his country or his charge otherwise cease, the holder of the patent shall send in a power of attorney for a new representative. If no notice be taken of what in this manner is ordered, a judge can, on being notified of the facts of the case, effect the selection of a deputy for the holder of the patent.

## (b) TRADEMARKS.

(Law of July 5, 1884.)

ART. 16. The King may decree, after a convention with a foreign State, and on condition of reciprocity that the protection for trademarks given by the present law shall be equally accorded to those who are engaged in a foreign country in an industry of the kind mentioned in article 1. The provisions of the present law shall be applicable in such case, provided the following special regulations which concern the filing of marks are complied with:

\* \* \* \* \*

(2) The interested person to whom registration shall be granted shall have a representative domiciled in Sweden, who shall carry on in his name all matters concerning the trademark; he shall be required in consequence, after the presentation of the application as regards any change in representative, to state the name and domicile of the representative under penalty, in case he does not observe this requirement, that the court, in accordance with such information as may be presented, shall designate a representative.

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SECTION 22.

SWITZERLAND.

PATENTS.

(Law of June 29, 1888.)

ART. 11. A person not domiciled in Switzerland shall not be able to claim the delivery of a patent and the enjoyment of the rights resulting therefrom until he has nominated an attorney domiciled in Switzerland. The latter is authorized to represent him in all steps to be taken according to the tenor of the present law, as well as in proceedings concerning the patent.

The tribunal in whose jurisdiction the representative is domiciled shall be competent to try actions brought against the proprietor of the patent, or in default that in the jurisdiction of which the federal office is situated.

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SECTION 23.

TURKEY.

(Not a party to the Convention.)

PATENTS.

(Law of March 2, 1880.)

ART. 5. Whoever shall desire to obtain a patent of invention shall deposit, in a sealed envelope, if in Constantinople, at the Ministry of



Commerce and Agriculture, and if in the provinces at the Office of the Provincial Government, or if he prefers it, at the said ministry:

1. His application for a patent of invention.
2. A specification of his invention.
3. The drawing or samples illustrating the description.
4. A memorandum of the papers deposited.

If the applicant complies with these formalities in a place where he is not domiciled, he must elect domicile there.

NOTE.—The above extracts are taken from the patent laws of Austria, Brazil, Ceylon, Denmark, Finland, Germany, Hungary, India, Luxemburg, Mysore, Negri Sembilan, Norway, Straits Settlement, Switzerland, and Turkey, as published in Patent Laws of the World, edition 1899 (Chartered Institute of Patent Agents, London); from the patent laws of Canada, Russia, and Sweden, and the trademark laws of Germany, Greece, and Netherlands, as published in the Official Gazette of the United States Patent Office; from the French translation of the patent law of Sweden and the trademark laws of Denmark, Finland, Luxemburg, Norway, South African Republic, and Sweden, as published by the International Bureau of Industrial Property at Berne, in *Recueil Général de la législation*, etc.; and from a translation of the patent and trademark laws of Japan.

## CHAPTER XV.

### LAWS OF CERTAIN FOREIGN COUNTRIES EXCLUDING FROM PATENT PROTECTION CERTAIN CLASSES OF INVENTION.

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#### SECTION 1.

##### ARGENTINE REPUBLIC.

(Law of October 11, 1864.)

ART. 4. The following are not patentable: Pharmaceutical compositions; financial schemes; discoveries or inventions which have prior to the application been sufficiently made public, in this country or out of it, in works, pamphlets, or printed periodicals, to enable them to be carried out; those which are purely theoretical, without their industrial application being indicated; and those which are contrary to morality or the laws of the Republic.

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#### SECTION 2.

##### AUSTRIA.

(Law of June 11, 1897.)

SEC. 2. Patents shall not be granted:

1. For inventions the object or use of which is contrary to law or morality or injurious to health, or which are obviously intended to mislead the public.

2. For scientific doctrines or principles as such.

3. For inventions the subject of which is reserved for a State monopoly.

4. For inventions concerning—

(a) Articles for human food and consumption.

(b) Preparations for medicine or disinfection.

(c) Products which are obtained by chemical methods, in so far as the inventions mentioned in paragraph 4, (a) to (c), do not relate to a definite technical process for the production of such articles.

SEC. 8. \* \* \* If the patent be granted for a process, the effect shall extend also to the articles made directly by this process.

## SECTION 3.

**DENMARK.**

(Law of April 13, 1894.)

SEC. 1. Patents are granted for inventions which can be industrially utilized or the carrying out of which can be made the object of industrial gain.

The following are, however, not patentable:

(1) Inventions which, as such, can not be considered to be of any substantial importance.

(2) Inventions the exercise of which is contrary to law, morality, or public order.

(3) Inventions which at the date of the application for the patent have already been so described in some generally accessible print, or been brought so openly into use in this country that experts are thereby enabled to exercise them; and

(4) Inventions of medicines and articles of food or refreshment and of processes for the production of articles of food.

---

SECTION 4.**FINLAND.**

(Law of January 21, 1898.)

SEC. 1. A patent may be obtained for new inventions which can be used in industrial operations.

A patent may not be granted for an invention the use of which is contrary to law or morality.

If an invention has for object any article of food or medicine or a composition produced by a chemical process, a patent may not be granted for the commodity itself, but only for the particular method of manufacturing it.

---

SECTION 5.**FRANCE.**

(Law of July 5, 1844.)

ART. 3. The following are not patentable:

1. Pharmaceutical compositions or medicines of all kinds, the said objects remaining subject to the special laws and regulations for these matters, and especially to the decree of the 18th of August, 1810, relating to secret remedies.

2. Schemes and combinations relating to credit or finance.



## SECTION 6.

## GERMANY.

(Law of April 7, 1891.)

SEC. 1. Patents are granted for new inventions which allow of industrial application.

Excepted are:

(1) Inventions the application of which is contrary to the laws or public morals.

(2) Inventions relating to articles of food, whether for nourishment or for enjoyment, and medicines, as also substances prepared by chemical processes in so far as the inventions do not relate to a definite process for the preparation thereof.

SEC. 35. \* \* \* If the invention relates to a process for the production of a new substance, all substances of like nature are considered as having been made by the patented process until proof to the contrary is given.

## SECTION 7.

## HUNGARY.

(Law of July 14, 1895.)

SEC. 2. A patent can not be allowed for an invention:

1. The working of which is contrary to a law, or an ordinance, or to public morals;

2. Which relates to arms for war purposes, explosives, ammunition, fortifications or ships of war necessary for increasing the belligerent power of the Austro-Hungarian army, the navy or the Hungarian militia, provided the Minister of Commerce enters an opposition against the grant of such patent within the term named in the second paragraph of section 34;

3. For scientific theorems or principles as such;

4. For articles serving for human or animal nourishment, for medicines and articles produced by chemical processes; the process employed in making such articles can, however, be patented.

SEC. 8. \* \* \* The effect of a patent granted for a process extends also to the products produced by such process.

## SECTION 8.

## ITALY.

(Law of October 13, 1859.)

ART. 6. The following do not constitute subjects for patents:

1. Inventions or discoveries relating to industries contrary to law, morals, or public safety.

2. Inventions or discoveries which have not for their object the production of material objects.

3. Inventions or discoveries of a merely theoretical nature.

4. Medicines of whatever kind.

## SECTION 9.

## JAPAN.

(Law of March 1, 1899.)

ART. II. Patents can not be obtained for the following inventions:

(a) Those regarding food, liquor, or any other kind of refreshments;

(b) Those regarding medicine or the compounding thereof;

(c) Those capable of offending public order or good morals;

(d) Those publicly known or used before applications for patent are filed, excepting, however, those publicly known for no more than two years on the consequence of experiment.

ART. 1. \* \* \* A patent for the invention of a process grants to the patentee the exclusive right of using and exploiting the process and the effect of such patent extends to the products made by that process.

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SECTION 10.

## LUXEMBURG.

(Law of June 30, 1880.)

ART. 1. Patents will be granted for new inventions capable of being worked industrially, excepting:

1. Inventions of which the working would be contrary to law or morals.

2. Inventions which have for their object food or other articles of consumption, pharmaceutical products or substances obtained by chemical means, unless they relate to definite processes for the manufacture of these articles.

---

SECTION 11.

## NORWAY.

(Law of June 16, 1885.)

SEC. 1. Patents shall be granted for new inventions which may be beneficial to industry.

The following are excepted:

(a) Inventions the use of which would be contrary to law, morality, or public order.

(b) Inventions the object of which are articles of food, nourishment, or medicine; but a patent may be granted for a process or apparatus specially designed for manufacturing such articles.

## SECTION 12.

## PERU.

(Law of January 28, 1869.)

ART. 3. The following shall not be included in this privilege:

1. Pharmaceutical preparations or remedies of any kind whatsoever.
  2. Schemes or combinations of credits or funds; and
  3. Processes, the object of which is to establish known means for improving an industry the practice of which is free in or out of the republic.
- 

## SECTION 13.

## PORTUGAL.

(Law of December 15, 1894.)

ART. 10. Patents granted for chemical industries shall refer only to the processes, and not to the products themselves, which might be prepared by other means.

ART. 11. Pharmaceutical preparations and remedies intended for human use or for animals can not be the subjects of patents of invention, but only the processes for the manufacture of such preparations or remedies.

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## SECTION 14.

## RUSSIA.

(Law of May 20-June 1, 1896.)

ART. VI. Article 176 of the industrial law (Codified Laws, Vol. VI, part 2, issue of 1893) will remain temporarily in force.

(This article is as follows:

“Patents of invention and improvements relating to munitions of war and to the defense of the State which can only be used by the Government, such as pieces of artillery, projectiles, fuses, and other artillery accessories, armor plates, torpedoes, revolving turrets, etc., can not be granted. For inventions and improvements relating to articles used in the army, but which can also be employed by private persons, such as small arms, metallic cartridges, bullets, and other accessories to such weapons, patents may be granted on the condition that they shall have no force against the ministries of war and the navy and shall not preclude such ministries from using the above-mentioned inventions and improvements or from carrying out the necessary experiments.”)

ART. 4. Patents can not be granted for inventions and improvements—

- (a) Which consist of scientific discoveries and abstract theories.
- (b) Which are contrary to public order, morals, and decency.
- (c) Which, prior to the date when the application for the patent was lodged, have been patented in Russia or have been used there without



a patent, or which have been described in printed books or journals in sufficient detail to enable them to be reproduced.

(*d*) Which are known abroad without a patent, or which are patented there in the name of a person other than the applicant, except in the case in which the invention has been assigned to the latter.

(*e*) Which do not involve any sufficiently essential novelty (art. 3), but only insignificant modifications of inventions and improvements already known.

Further, no patent is granted for chemical, nutritious, and gustatory products, for medical compounds, or for processes and apparatus for the manufacture of the latter.

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## SECTION 15.

### SPAIN.

(Law of July 30, 1878.)

ART. 9. The following shall not be the objects of patents:

1. The result or product of the machines, apparatus, instruments, processes, or operations mentioned in the first paragraph of article 3, unless they are contained in the second paragraph of the same article.

2. The use of natural products.

3. Scientific principles or discoveries so far as they are of a mere speculative nature and are not likely to be applicable to machinery, apparatus, instruments, processes, or mechanical or chemical operations of a practical industrial nature.

4. Pharmaceutical or medical preparations of all sorts.

5. Schemes or combinations of credit or finance.

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## SECTION 16.

### SWEDEN.

(Law of May 16, 1884.)

SEC. 2. Patents shall not be granted for inventions, the working of which would be contrary to law or morals. With regard to inventions relating to provisions or medicines, patents shall not be granted for the commodity itself, only for special methods for its manufacture.

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## SECTION 17.

### SWITZERLAND.

(Law of June 29, 1888.)

ART. 1. The Swiss Confederation grants to the authors of new inventions applicable to industry and represented by models, or to their assigns, the rights specified in the present law in the form of patents of invention.

## SECTION 18.

## TUNIS.

(Law of December 26, 1888.)

ART. 3. The following shall not be patentable:

Schemes and combinations relating to credit or finance, and inventions the practice of which would be contrary to law or morality. If the invention relates to foods or medicines, the patent shall not be granted for the product itself, but only for special processes relating to its manufacture.

## SECTION 19.

## TURKEY.

(Law of March 2, 1880.)

ART. 2. The following are not patentable:

1. Pharmaceutical compounds and medicines of all kinds.
2. Financial and banking schemes and combinations.

## SECTION 20.

## URUGUAY.

(Law of November 11, 1885.)

ART. 5. Patents of privileges shall not be granted for financial schemes; for discoveries or inventions which are well known in the country or out of it in printed works, pamphlets, or periodicals; for inventions which are purely theoretical and the useful application of which is not practically demonstrated; for pharmaceutical preparations, or for inventions which are contrary to morality or to the laws of the Republic.

## SECTION 21.

## VENEZUELA.

(Law of May 25, 1882.)

ART. 17. Inventions, improvements, or new industries prejudicial to health or public order, to morals, or prior rights shall not be patented.

Pharmaceutical compositions or remedies of any sort or kind can not be patented, but remain subject to the special laws and regulations on the subject.

NOTE.—The above extracts, with the exception of that from the patent law of Japan (which is taken from a translation), are taken from the patent laws of the several countries named, as published in Patent Laws of the World, edition 1899 (Chartered Institute of Patent Agents, London).

## CHAPTER XVI.

### LAWS OF CERTAIN FOREIGN COUNTRIES PROVIDING FOR THE GRANT TO THE TRUE INVENTOR OF A PATENT FOR AN INVENTION FOR WHICH A PATENT HAS ALREADY BEEN GRANTED TO ANOTHER.

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#### SECTION I.

##### AUSTRIA.

(Law of January 11, 1897.)

SEC. 29. The patent shall be forfeited by a patentee if it be known:

1. That the patentee is not the author of the invention, or his legal successor, or is not to be regarded as such (sec. 5); or

2. That the essential contents of the application have been taken from the description, drawings, models, tools, or apparatus of another, or from a process used by him without his consent.

If one of these assumptions (1 and 2) only partially obtains, the patent shall only be partially forfeited by the patentee.

The claim for the forfeiture of a patent shall, in the first case, be made only by the author, his legal successors, and those who in the sense of section 5 are to be regarded as the author; in the second case, only by the injured party, and is limited against the patentee in good faith to within three years from the date of his entry in the register of patents.

The reciprocal claims for compensation and reclamation arising out of the forfeiture shall be decided according to the civil code and be enforced by a civil suit.

If the author or the injured party be successful, it shall be open to him, within thirty days after delivery of the legally valid decision of forfeiture, to demand the transfer of the patent to himself.

The omission of such a demand of transfer in time shall be held equivalent to renunciation of the patent.

License rights legally given by the former patentee in good faith acquired by third persons and entered in the register of patents one year previously shall, in so far as they are not affected by any legally grounded litigation caveat (sec. 25), and without prejudice to the compensation claim arising therefrom against the original patentee, remain valid in the case of such a patent transfer also against the new owner of the patent.



## SECTION 2.

## CEYLON.

(Law of 1892.)

SEC. 35. If in an action instituted in the district court at any time within fourteen years from the date of the filing of a specification of an invention under this ordinance the actual inventor proves to the satisfaction of the court that the petitioner or petitioners was or were not the actual inventor or inventors, and that at the time of the petition for leave to file the specification the petitioner or petitioners knew or had reason to believe that the knowledge of the invention was obtained by himself or themselves, or by some other person, surreptitiously or in fraud of the actual inventor, or by means of a communication made in confidence by the actual inventor to him or them, or to any person through whom he or they derived the knowledge, the court may make a decree declaring an exclusive privilege in respect of the invention to be vested, subject to the other provisions of this ordinance, in the actual inventor for a term of fourteen years from the date on which the petition was delivered to or received by the colonial secretary, and requiring the petitioner or petitioners to account for and pay over to the actual inventor the profits derived by him or them from the invention, or so much of those profits as the court, having regard to the degree of diligence exerted by the actual inventor in proceeding under this section and to all the other circumstances of the case, may see fit to require the petitioner or petitioners to pay.

## SECTION 3.

## FINLAND.

SEC. XXIV. If any one has unlawfully appropriated an invention of another person which is neither published nor openly exercised, and has obtained a patent therefor or procured a patent for an invention to which he had not the sole right, only the injured party shall on that ground plead that the patent shall be declared invalid. If in these cases the injured party prefers to demand that the whole patent or the part of it to which he has the right shall be resigned to him he is entitled to do so, such claim, however, shall not be detrimental to a third person who has in good faith made an agreement with the holder of the patent.

## SECTION 4.

## GREAT BRITAIN.

(Patents, Designs, and Trademarks act, 1883.)

SEC. 26. \* \* \*

(4) A petition for revocation may be presented by:

\* \* \* \* \*

(d) Any person alleging that he or any person through whom he claims was the true inventor of any invention included in the claim of the patentee:

\* \* \* \* \*

(8) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor, made in accordance with the provisions of this act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

The same provision is found in the law of November 16, 1896, of New South Wales (sec. 5); the law of September 2, 1889, of New Zealand (sec. 35); the law of October 13, 1884, of Queensland (sec. 29); the law of September 29, 1893, of Tasmania (sec. 38); the law of November 19, 1894, of Trinidad and Tobago (secs. 11 and 12); the law of July 10, 1890, of Victoria (sec. 47), and the law of November 26, 1888, of Western Australia (sec. 31).

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## SECTION 5.

### INDIA.

(Inventions and designs act, 1888.)

SEC. 38. If, in a suit instituted in the district court at any time within fourteen years from the date of the filing of a specification of an invention under this part, the actual inventor proves to the satisfaction of the court that the applicant was not the actual inventor, and that at the time of the application for leave to file the specification the applicant knew or had reason to believe that the knowledge of the invention was obtained by himself or by some other person surreptitiously or in fraud of the actual inventor, or by means of a communication made in confidence by the actual inventor to him or to any person through whom he derived the knowledge, the court may make a decree declaring an exclusive privilege in respect of the invention to be vested, subject to the other provisions of this part, in the actual inventor for a term of fourteen years from the date on which the specification was filed, and requiring the applicant to account for and pay over to the actual inventor the profits derived by him from the invention, or so much of those profits as the court, having regard to the degree of diligence exerted by the actual inventor in proceeding under this section, and to all the other circumstances of the case, may see fit to require the applicant to pay.

The same provision is found in the law of 1894 of Mysore, sec. 38.

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## SECTION 6.

### JAPAN.

(Law of March 1, 1899.)

ART. XXIV. In case the decision that there is conflict as to an invention is finally established, the president of the patent bureau shall

order the interested parties to present a statement regarding the origin and circumstances of the invention and shall direct an examiner to investigate the priority of the completion of the invention. The decision thereon shall be furnished to the interested parties.

ART. XXV. In case a patent already granted shall be annulled under the provisions of the preceding article and a patent shall be granted for the invention on an application, the term of such patent shall be reckoned from the date of registration of the first patent.

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#### SECTION 7.

##### ORANGE FREE STATE.

(Law of 1888.)

ART. 32. Where letters patent have been revoked on the ground of fraud, the Government may, on the application of the true inventor made in accordance with this law, grant to him new letters patent (in lieu of those revoked), which shall bear the date of the revocation of the first letters patent. These new letters patent shall, however, cease to be in force on the expiration of the term for which the first revoked letters patent were granted.

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#### SECTION 8.

##### SOUTH AFRICAN REPUBLIC.

(Law of 1898.)

ART. 38. Where letters patent have been revoked on the ground of fraud, the commissioner may, on the application of the true inventor made in accordance with this law, grant to him new letters patent (in lieu of those revoked), which shall bear the date of the revocation of the first letters patent. These new letters patent shall, however, cease to be in force on the expiration of the term for which the first revoked letters patent were granted.

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#### SECTION 9.

##### STRAITS SETTLEMENTS.

(Law of 1871.)

SEC. 29. If, upon proceedings instituted by a person claiming to be the inventor, within two years from the date of a petition to file a specification, he shall prove to the satisfaction of the supreme court that the petitioner was not the inventor, and that at the time of the petition he knew or had good reason to believe that the knowledge of the invention was obtained by himself or by some other person sur-



reptitiously or in fraud of the inventor, or by means of a communication made in confidence by the actual inventor to him or to any person through whom he derived such knowledge, the court may compel the petitioner to assign to the inventor any exclusive privilege obtained under this ordinance, and to account for and pay over the profits thereof.

NOTE.—The above extracts, with the exception of that from the patent law of Japan (which is taken from a translation), are taken from the patent laws of the several countries named, as published in Patent Laws of the World, Edition 1899 (Chartered Institute of Patent Agents, London).

## CHAPTER XVII.

### LAWS OF CERTAIN FOREIGN COUNTRIES RESPECTING COMPULSORY LICENSES.

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#### SECTION 1.

##### AUSTRIA.

(Law of January 11, 1897.)

SEC. 21. The owner of a patent for an invention which, without using an invention previously patented, can not be turned to account, shall be entitled to demand from the owner of the latter the grant of a license to use the same, if from the date of the publication of the grant of the earlier patent in the patent journal three years have elapsed, and the later invention is of considerable commercial importance.

A license granted shall entitle the owner of the earlier patent also on his side to demand a license from the subsequent patentee, which shall empower him to use the later invention, under the condition, however, that this latter stands in positive connection with the earlier invention.

If it shall appear that the grant to another of the permission to use an invention be in the public interest, any one, even if the assumptions of paragraphs 1 and 2 do not apply, and if his personal trustworthiness be shown, shall be entitled, after the expiration of three years from the date of the publication of the grant of the patent in the patent journal, to demand from the patentee permission to use the invention for his business.

If, in these cases, the license be refused by the patentee the patent office shall decide concerning the demand made, and shall determine, in case of the grant of the license, the compensation to be given, the guaranty, and also any further conditions of use, regard being had to the nature of the invention and the circumstances of the case.

If the decision be concerning the grant of a license in the public interest, the patent office shall obtain the views of the ministries concerned upon the question of the existence of the public interest, and make these views the basis of its own decision.

The foregoing provisions shall not apply to patents of the Government or war office.

SEC. 27. A patent may be wholly or partially withdrawn if the patentee or his legal successor neglects to work, or allow to be

worked, the invention in the country to a suitable extent, or to do everything necessary to insure such working. The withdrawal may in this case take place not earlier than after the expiration of three years from the date of the publication of grant of the patent in the patent journal. This time limit shall not hold good if the patentee or his legal successor, notwithstanding the invention is being worked abroad and the public interest requires working also in the country, continues to satisfy the native demand exclusively or to the greatest extent, by importation instead of by production to a proper extent in the country.

The withdrawal of the patent shall be preceded by a threat of the same, with a statement of the grounds, and fixing a suitable delay for the adequate working of the invention.

The withdrawal shall operate from the last date set out in the withdrawal notice for the period of time fixed for the legal working in the country.

These provisions shall not apply to Government or war-office patents.

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## SECTION 2.

### BOLIVIA.

(Law of May 8, 1858.)

ART. 4. The State may buy the secret of any invention useful to industry for the general benefit.

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## SECTION 3.

### DENMARK.

(Law of March 28, 1894.)

SEC. 8. In case the interest of the public demands it, it may be enacted by a law that a patented invention shall, without the consent of the holder of the patent, be used by the State, or that the patent shall become void, so that the invention becomes available for use by the public, in both cases subject to full compensation to the holder of the patent. This compensation is paid by the State, and shall, in default of mutual agreement, be determined by the estimate of four experts, two of whom are appointed by the ministry of the interior and two by the holder of the patent, together with an umpire unanimously elected by the four experts; or, in default of unanimity, with an umpire appointed by the court at the domicile of the patentee; or, if he be a foreigner, with an umpire appointed by the court of justice (*Hof-and-Statsret*), who interposes if a majority of these experts can not agree as to the amount of compensation, and who settles the compensation within the limits proposed by the experts.



## SECTION 4.

## ECUADOR.

(Law of October 18, 1880.)

ART. 4. The State may buy, for the general benefit, the secret of any invention useful to industry.

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## SECTION 5.

## FINLAND.

(Ordinance of January 21, 1898.)

SEC. 4. If the holder of the patent has not brought the invention into use within the country in the manner enacted with regard thereto, he shall be bound upon demand, upon reasonable conditions and against satisfactory security, to grant permission to another for such use.

The holder of the patent shall also be subjected to the same obligation, even if he exercises the invention within the country, in the event of the economy department of the Senate declaring, upon the representation of the person who seeks permission to use the invention, that the public advantage requires it, and also in the event of such permission being asked for by a person who otherwise can not exercise an invention of great importance subsequently patented for his account. In the latter case, however, the owner of the earlier patent may, according to circumstances, be likewise entitled, if he wishes, to use the other's invention.

If the holder of the patent refuses permission to use, which according to this paragraph he is bound to grant upon the declaration of the Senate or otherwise, the court may, upon demand of the other person, if the conditions and security are found suitable, grant him the desired right to use. If the circumstances change, the conditions in the above-mentioned case may be subjected to fresh examination.

SEC. XVII. If the holder of the patent has not within three years from the grant of the patent brought the invention into practice within the country to any considerable extent, or if the practice has been discontinued after that time, the holder of the patent shall be bound to grant permission to other persons to use the invention, as enacted in section 4 of the ordinance of this date with regard to patent rights and legal proceedings in matters relating to patents.

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## SECTION 6.

## GERMANY.

(Law of April 7, 1891.)

SEC. 11. The patent can be revoked at the end of three years from the date of the official publication of the grant. \* \* \*

(2) If it appears to be in the interests of the community that licenses to others for the use of the invention should be granted, but the owner of the patent declines to grant such licenses for reasonable compensation and adequate security.

## SECTION 7.

## GREAT BRITAIN.

(Patents, Designs, and Trademark act, 1883.)

ART. 22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

(a) The patent is not being worked in the United Kingdom; or

(b) The reasonable requirements of the public with respect to the invention can not be supplied; or

(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Substantially the same provision is found in the law of March 3, 1890, of the Bahama Islands (Sec. VII); the law of British New Guinea; the law of 1892 of Ceylon (sec. 39); the law of 1888 of India (sec. 43); the law of November 26, 1894, of Mysore (sec. 42); the law of 1896 of Negri Sembilan (sec. 16); the law of 1889 of New Zealand (sec. 33); the law of 1888 of Orange Free State (sec. 21); the law of 1896 of Perak (sec. 16); the law of 1884 of Queensland (sec. 25); the law of 1896 of Selangor (sec. 16); the law of 1898 of South African Republic (sec. 27); the law of 1893 of Tasmania (sec. 36); the law of 1894 of Trinidad and Tobago (sec. 14), and the law of November 26, 1888, of Western Australia (sec. 27).

## SECTION 8.

## HUNGARY.

(Law of July 7, 1895.)

SEC. 20. A patent can be withdrawn or revoked as a whole or in part—

If the owner of the patent has neglected to work or use his invention within the countries of the Hungarian Crown, in substance and to an adequate extent, or if he has unjustifiably interrupted such working or use, or if he has not at least done all that is necessary, according to his own and the country's circumstances and conditions, for securing and continuing such working.

This withdrawal or revocation can not, as a rule, take place until three years after the publication of the grant of the patent.

Exceptionally such withdrawal or revocation can take place at an earlier time if the owners of the patent do not meet the demands of the country by working the invention in the country, or do not permit it to be done by granting licenses, and do not fulfill this obligation within a term appointed by the patent office under due consideration of the circumstances, notwithstanding that the invention is worked

abroad and its working in the country is desirable with regard to the public interest.

2. After three years from publishing the grant of the patent, if the owner of the patent does not work his patent to an extent adequate to the demand of the country and refuse to grant other trustworthy manufacturers in the country the necessary licenses for a suitable compensation and on good security, such compensation being determined by the patent office.

Before such withdrawal or revocation the owner of the patent shall be notified, a suitable term being allowed.

The withdrawal or revocation in both cases comes into force on the decision as to such withdrawal or revocation.

A patent granted to the State can not be withdrawn or revoked.

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## SECTION 9.

### JAPAN.

(Law of March 1, 1899.)

**ART. XVI.** President of patent bureau shall have the power, whenever he thinks it necessary or he is so required by proper authorities, of limiting or refusing a patent for such inventions as are required by the public interests to be widespread, or are necessitated for military purposes, or are required to be kept in secret, or of limiting or annulling a patent already granted therefor.

In the above-mentioned cases the Government shall give to such patent applicant or patent owner a reasonable compensation.

**ART. XXXVIII.** President of patent bureau shall have power to annul a patent in case a patented invention is in the following circumstances:

(a) When a patent owner without a reasonable cause has failed to work and publish his invention in this Empire on and within three years from the date of the certificate of patent, or when having ceased for more than three years to work and publish it he has refused an offer by a third party to obtain an assignment or a use thereof on and with a reasonable term and condition.

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## SECTION 10.

### LUXEMBURG.

(Law of June 30, 1880.)

A patent may be withdrawn after three years by royal grand ducal decree, but with an appeal to the judicial committee of the council of state, if the patentee neglects to work his invention in the Grand Duchy to a suitable extent or at least to do all that is necessary to secure this working.

Similarly, after three years it may be declared by a royal grand



ducal decree, on the advice of the council of state, that the interests of the public require that the right of working a patented invention shall be granted to one or more persons who have made application. In this case the compensation and the guaranties due to the patentee from the new claimants for the working shall, in case of nonagreement, be fixed by judicial decision.

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#### SECTION 11.

##### MALTA.

(Law of 1899.)

ART. 50. The holder of a patent may be compelled to assign his right or to grant the use thereof for a consideration, to be determined by the competent civil court, if the industrial invention or modification to which the patent refers shall not have been put into use within twelve months subsequent to the concession or if its working shall have been suspended for twelve months continuously.

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#### SECTION 12.

##### NORWAY.

(Law of June 16, 1885.)

SEC. 9. If the King so decide, a patented invention may be used for the Government service without the consent of the proprietor of the patent. A patented invention which is of essential value to any particular trade or industry may, by a similar decision, be appropriated to private use. The proprietor shall be entitled in both cases to compensation, the amount of which shall, in default of an amicable arrangement, be determined by arbitration. In the first case the payments shall be made by the Government, and in the second case by the person or persons using the invention. If the compensation be fixed at a lump sum once for all it shall be paid before the invention is taken into use. If it be fixed at a royalty the arbitrators shall, if so required by the proprietor of the patent, also fix the times at which the payments shall be made and also decide the amount of security to be given to insure due compliance. The payment awarded by the arbitrators can be enforced by distraint.

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#### SECTION 13.

##### SWEDEN.

(Law of May 16, 1884.)

SEC. 17. If the King considers it necessary that a patented invention shall be open to the free use of the public or appropriated on account of the State, the patent shall be no obstacle; the patentee shall, however, be entitled to full compensation. If the amount of compensation can not be agreed upon, it shall be fixed by a special jury appointed by the court, according to the provisions for expropriation of land or homesteads required for public purposes.

## SECTION 14.

## SWITZERLAND.

(Law of June 29, 1888.)

**ART. 9.** The patent shall be forfeited.

\* \* \* \* \*

(4) If the patented article is imported from abroad and at the same time the proprietor of the patent has refused applications offered on equitable terms for Swiss licenses.

**ART. 12.** The proprietor of a patent who finds it impossible to work his invention without using an invention previously patented, may exact of the proprietor of the latter the grant of a license, if three years have elapsed since the lodging of the application for the first patent, and if the new invention has a real industrial importance.

If the license is granted, the proprietor of the first patent shall reciprocally have the right of requiring also a license authorizing him to work the new invention, provided that it has, in its turn, a real connection with the first.

All litigation which may arise out of the application of the above provisions shall be settled by the Federal tribunal, which shall determine at the same time the amount of the indemnity and the nature of the guaranties to be furnished.

**NOTE.**—The above extracts, with the exception of that from the patent law of Japan (which is taken from a translation), are taken from the patent laws of the several countries named, as published in Patent Laws of the World, edition 1899 (Chartered Institute of Patent Agents, London).

## CHAPTER XVIII.

### TREATY AGREEMENTS RELATING TO TRADEMARKS BETWEEN THE UNITED STATES AND FOREIGN NATIONS.<sup>1</sup>

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#### SECTION 1.

##### AUSTRIA-HUNGARY.

##### *Convention relative to trade-marks.*

[Concluded November 25, 1871; ratifications exchanged at Vienna April 22, 1872; proclaimed June 1, 1872.]

#### ARTICLE I.

Every reproduction of trade-marks which in the countries or territories of the one of the contracting parties are affixed to certain merchandise to prove its origin and quality is forbidden in the countries or territories of the other of the contracting parties, and shall give to the injured party ground for such action or proceedings to prevent such reproduction, and to recover damages for the same, as may be authorized by the laws of the country in which the counterfeit is proven, just as if the plaintiff were a citizen of that country.

The exclusive right to use a trade-mark for the benefit of citizens of the United States in the Austro-Hungarian Empire, or of citizens of the Austro-Hungarian Monarchy in the territory of the United States, can not exist for a longer period than that fixed by the law of the country for its own citizens. If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the countries or territories of the other of the two contracting parties.

#### ARTICLE II.

If the owners of trade-marks, residing in the countries or territories of the one of the contracting parties, wish to secure their rights in the countries or territories of the other of the contracting parties, they must deposit duplicate copies of those marks in the Patent Office at Washington and in the chambers of commerce and trade in Vienna and Pesth.

#### ARTICLE III.

The present arrangement shall take effect ninety days after the exchange of ratifications, and shall continue in force for ten years from this date.

In case neither of the high contracting parties gives notice of its intention to discontinue this convention twelve months before its expiration, it shall remain in force one year from the time that either of the high contracting parties announces its discontinuance.

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<sup>1</sup> The Convention for the Protection of Industrial Property, concluded at Paris March 20, 1883, will be found ante Chap. II, sec. 1, p. 146.



## ARTICLE IV.

The ratifications of this present convention shall be exchanged at Vienna within twelve months, or sooner if possible.

In faith whereof the respective plenipotentiaries have signed the present convention, as well in English as in German and Hungarian, and have affixed thereto their respective seals.

Done at Vienna the 25th day of November, in the year of our Lord 1871, in the ninety-sixth year of the Independence of the United States of America, and in the twenty-third year of the reign of His Imperial and Royal Apostolic Majesty.

[SEAL.]  
[SEAL.]

JOHN JAY.  
ANDRÁSSY.

On the 10th of June, 1891, the Austro-Hungarian Department of Commerce issued a decree, No. 23208, to the following effect:

Marks of subjects of Sweden and Norway, as well as (citizens) of the United States of North America, are, by reason of the special conditions of the trade-mark conventions of May 10, 1890, and of November 25, 1871, admitted to registration, even when they only consist of names, firms, and other words, if proof is produced that the same are registered in the home country.

## SECTION 2.

## BELGIUM.

*Article respecting trade-marks additional to the treaty of commerce and navigation of July 17, 1858.*

[Concluded at Brussels December 20, 1868; proclaimed July 30, 1869.]

## ADDITIONAL ARTICLE.

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens of one of the two countries may wish to secure the right of property in the other must be lodged, to wit: the marks of citizens of the United States at Brussels, in the office of the clerk of the tribunal of commerce; and the marks of Belgian citizens at the Patent Office in Washington.

It is understood that if a trade-mark has become public property in the country of its origin it shall be equally free to all in the other country.

This additional article shall have the same duration as the before-mentioned treaty of the 17th July, 1858, to which it is an addition. The ratifications thereof shall be exchanged in the delay of six months, or sooner if possible.

In faith whereof the respective plenipotentiaries have signed the same and affixed thereto their seals.

Done at Brussels in duplicate the twentieth of December, eighteen hundred and sixty-eight.

[SEAL.]  
[SEAL.]

H. S. SANFORD.  
JULES VANDER STICHELEN.

*Treaty of commerce, navigation, and trade-marks.*

[Concluded March 8, 1875; ratifications exchanged at Brussels, June 11, 1875; proclaimed June 29, 1875.]

## ARTICLE XV.

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens of one of the two countries may wish to secure the right of property in the other must be lodged, to wit: the marks of citizens of the United States, at Brussels, in the office of the clerk of the tribunal of commerce; and the marks of Belgian citizens, at the Patent Office in Washington.

It is understood that if a trade-mark has become public property in the country of its origin it shall be equally free to all in the other country.

## ARTICLE XVI.

The present treaty shall be in force during ten years from the date of the exchange of the ratifications, and until the expiration of twelve months after either of the high contracting parties shall have announced to the other its intention to terminate the operation thereof, each party reserving to itself the right of making such declaration to the other at the end of the ten years above mentioned; and it is agreed that after the expiration of the twelve months of prolongation accorded on both sides this treaty and all its stipulations shall cease to be in force.

## ARTICLE XVII.

This treaty shall be ratified, and the ratifications shall be exchanged at Brussels within the term of nine months after its date, or sooner if possible.

In faith whereof the respective plenipotentiaries have signed the present treaty in duplicate, and have affixed thereto their seals at Washington, the 8th day of March, 1875.

[SEAL.]  
[SEAL.]

HAMILTON FISH.  
MAURICE DELFOSSE.

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*Convention concerning trade-marks.*

[Concluded April 7, 1884; ratifications exchanged at Washington July 7, 1884; proclaimed July 9, 1884.]

## ARTICLE I.

Citizens of the United States in Belgium and Belgian citizens in the United States of America shall enjoy, as regards trade-marks and trade labels, the same protection as native citizens, without prejudice to any privilege or advantage that is or may hereafter be granted to the citizens of the most favored nation.

## ARTICLE II.

In order to secure to their marks the protection provided for by the foregoing article, the citizens of each one of the contracting parties shall be required to fulfill the law and regulations of the other.

## ARTICLE III.

The present arrangement shall take effect on the day of its official publication, and shall remain in force until the expiration of the twelve months following the notice, given by either of the contracting parties, of its desire for the cessation of its effects.

The ratifications of this convention shall be exchanged at Washington as soon as possible within one year from this date.

In testimony whereof the respective plenipotentiaries have signed this convention in duplicate, in the English and French languages, and affixed thereto the seals of their arms.

Done at Washington the 7th day of April, in the year of our Lord 1884.

[SEAL.]  
[SEAL.]

FREDK. T. FRELINGHUYSEN.  
THRE. de BOUNDER de MELS BROECK.

## SECTION 3.

## BRAZIL.

*Agreement concerning trade-marks.*

[Concluded September 24, 1878; proclaimed June 17, 1889.]

The Government of the United States of America and the Government of His Majesty the Emperor of Brazil, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:

The citizens or subjects of the two high contracting parties shall have in the dominions and possessions of the other the same rights as belong to native citizens or subjects in everything relating to property in marks of manufacture and trade.

It is understood that any person who desires to obtain the aforesaid protection must fulfill the formalities required by the laws of the respective countries.

In witness whereof the undersigned, duly authorized to this end, have signed the present agreement and have affixed thereto the seals of their arms.

Done in duplicate at Rio de Janeiro, the 24th day of the month of September, 1878.

[SEAL.]  
[SEAL.]

HENRY WASHINGTON HILLIARD.  
B. de VILLA BELLA.



## SECTION 4.

## DENMARK.

*Convention for the reciprocal protection of trade-marks and trade labels.*

[Concluded at Copenhagen, June 15, 1892; proclaimed October 12, 1892.]

With a view to secure for the manufacturers in the United States of America and those in Denmark the reciprocal protection of their trade-marks and trade labels, the undersigned, duly authorized to that effect, have agreed on the following dispositions:

## ARTICLE I.

The subjects or citizens of each of the high contracting parties shall in the dominions and possessions of the other have the same rights as belong to native subjects or citizens in everything relating to trade-marks and trade labels of every kind.

Provided always, that in the United States the subjects of Denmark, and in Denmark the citizens of the United States of America, can not enjoy these rights to a greater extent or for a longer period of time than in their native country.

## ARTICLE II.

Any person in either country desiring protection of his trade-mark in the dominions of the other must fulfill the formalities required by the law of the latter; but no person, being a subject or citizen of one of the contracting States, shall be entitled to claim protection in the other by virtue of the provisions of this convention, unless he shall have first secured protection in his own country in accordance with the laws thereof.

## ARTICLE III.

This arrangement shall go into effect immediately on or after the exchange of the ratifications, and shall be in force until a year after it has been recalled by the one or the other of the two high parties.

## ARTICLE IV.

The present convention shall be ratified by the President of the United States of America, by and with the advice and consent of the Senate thereof, and by His Majesty the King of Denmark, and the ratifications shall be exchanged at Copenhagen as soon as may be within ten months from the date hereof.

In witness whereof the undersigned have signed the present convention and have affixed thereto the seal of their arms.

Done at Copenhagen in double expedition the 15th June, 1892.

[SEAL.]  
[SEAL.]

CLARK E. CARR.  
REEDTZ THOTT.

## SECTION 5.

## FRANCE.

*Convention concerning trade-marks.*

[Concluded April 16, 1869; ratifications exchanged at Washington, July 3, 1869; proclaimed July 6, 1869.]

## ARTICLE I.

Every reproduction in one of the two countries of trade-marks affixed in the other to certain merchandise to prove its origin and quality is forbidden, and shall give ground for an action for damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven, just as if the plaintiff were a subject or citizen of that country.

The exclusive right to use a trade-mark for the benefit of citizens of the United States in France, or of French subjects in the territory of the United States, can not exist for a longer period than that fixed by the law of the country for its own citizens.

If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the other country.

## ARTICLE II.

If the owners of trade-marks, residing in either of the two countries, wish to secure their rights in the other country, they must deposit duplicate copies of those marks in the Patent Office at Washington, and in the clerk's office of the tribunal of commerce of the Seine, at Paris.

## ARTICLE III.

The present arrangement shall take effect ninety days after the exchange of ratifications by the two Governments, and shall continue in force for ten years from this date.

In case neither of the two high contracting parties gives notice of its intention to discontinue this convention, twelve months before its expiration, it shall remain in force one year from the time that either of the high contracting parties announces its discontinuance.

## ARTICLE IV.

The ratifications of this present arrangement shall be exchanged at Washington within ten months, or sooner if possible.

In faith whereof the respective plenipotentiaries have signed the present convention in duplicate and affixed thereto the seal of their arms.

Done at Washington the 16th day of April, in the year of our Lord 1869.

[SEAL.]  
[SEAL.]

HAMILTON FISH.  
BERTHEMY.

## SECTION 6.

## GERMANY.

*Convention respecting consuls and trade-marks.*

[Concluded December 11, 1871; ratifications exchanged at Berlin April 29, 1872; proclaimed June 1, 1872.]

## ARTICLE XVII.

With regard to the marks or labels of goods, or of their packages, and also with regard to patterns and marks of manufacture and trade, the citizens of Germany shall enjoy in the United States of America, and American citizens shall enjoy in Germany, the same protection as native citizens.

## ARTICLE XVIII.

The present convention shall remain in force for the space of ten years, counting from the day of the exchange of the ratifications, which shall be exchanged at Berlin within the period of six months.

In case neither party gives notice, twelve months before the expiration of the said period of ten years, of its intention not to renew this convention, it shall remain in force one year longer, and so on, from year to year, until the expiration of a year from the day on which one of the parties shall have given such notice.

In faith whereof the plenipotentiaries have signed and sealed this convention.

Berlin, the 11th of December, 1871.

[SEAL.]  
[SEAL.]

GEO. BANCROFT.  
B. KÖENIG.

## SECTION 7.

## GREAT BRITAIN.

*Declaration respecting trade-marks.*

[Concluded October 24, 1877; ratification advised by Senate May 22, 1878; ratified by President May 25, 1878; proclaimed July 17, 1878.]

The Government of the United States of America and the Government of her Majesty the Queen of the United Kingdom of Great Britain and Ireland, with a view to the reciprocal protection of the marks of manufacture and trade in the two countries, have agreed as follows:

The subjects or citizens of each of the contracting parties shall have, in the dominions and possessions of the other, the same rights as belong to native subjects or citizens, or as are now granted or may hereafter be granted to the subjects and citizens of the most favored nation, in everything relating to property in trade-marks and trade labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfill the formalities required by the laws of the respective countries.

In witness whereof the undersigned have signed the present declaration, and have affixed thereto the seal of their arms.

Done at London, the 24th day of October, 1877.

[SEAL.]  
[SEAL.]

EDWARDS PIERREPONT.  
DERBY.



## SECTION 8.

## ITALY.

*Declaration for the reciprocal protection of marks of manufacture and trade.*

[Concluded June 1, 1882; ratification advised by the Senate February 25, 1884; proclaimed March 19, 1884.]

## DECLARATION.

The Government of the United States of America and the Government of His Majesty the King of Italy, wishing to provide for the reciprocal protection of the marks of manufacture and trade, have agreed as follows:

The citizens of each of the high contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as belong to native citizens, or as are now granted or may hereafter be granted to the subjects or citizens of the most favored nation, in everything relating to property in trade-marks and trade labels.

It is understood that any person who desires to obtain the aforesaid protection must fulfill the formalities required by the laws of the respective countries.

In witness whereof the undersigned, having been duly authorized to this effect, have signed the present declaration, and have affixed thereto the seal of their arms.

Done in duplicate original at Washington, this 1st day of June, 1882.

[SEAL.]  
[SEAL.]

FRED'K T. FRELINGHUYSEN.  
FAVA.

[NOTE.—Inasmuch as the act of Congress entitled “An act relating to the registration of trade-marks,” approved March 3, 1881, gives the right of trade-mark registry to subjects of any foreign country which by law admits the like right for citizens of the United States, this declaration is held to be an establishment of the fact that such reciprocal privilege exists, and is therefore effective from June 1, 1882, the date of its signature.]

## SECTION 9.

## JAPAN.

*Treaty between the United States of America and the Empire of Japan—Commerce and Navigation.*

[Concluded at Washington November 22, 1894; ratification advised by the Senate February 5, 1895; ratified by the President February 15, 1895; ratified by the Emperor February 27, 1895; ratifications exchanged at Washington, March 21, 1895; proclaimed March 21, 1895.]

By the President of the United States of America.

## A PROCLAMATION.

Whereas a treaty of commerce and navigation between the United States of America and the Empire of Japan was concluded and signed by their respective plenipotentiaries at the city of Washington on the 22d day of November, 1894, which treaty, being amended by the Sen-

ate of the United States, and being in the English language, is word for word as follows:

The President of the United States of America and His Majesty the Emperor of Japan, being equally desirous of maintaining the relations of good understanding which happily exist between them, by extending and increasing the intercourse between their respective States, and being convinced that this object cannot better be accomplished than by revising the treaties hitherto existing between the two countries, have resolved to complete such a revision, based upon principles of equity and mutual benefit.

\* \* \* \* \*

#### ARTICLE XVI.

The citizens or subjects of each of the High Contracting Parties shall enjoy in the territories of the other the same protection as native citizens or subjects in regard to patents, trade-marks, and designs, upon fulfillment of the formalities prescribed by law.

\* \* \* \* \*

#### PROTOCOL.

\* \* \* \* \*

But nothing contained in this protocol shall be held to limit or qualify the right of the Japanese Government to restrict or to prohibit the importation of adulterated drugs, medicines, food, or beverages; indecent or obscene prints, paintings, books, cards, lithographic or other engravings, photographs, or any other indecent or obscene articles; articles in violation of the patent, trade-mark, or copyright laws of Japan; or any other article which, for sanitary reasons, or in view of public security or morals, might offer any danger.

\* \* \* \* \*

#### *Convention between the United States of America and the Empire of Japan.—Patents, trade-marks, and designs.*

[Concluded at Washington January 13, 1897; ratification advised by the Senate February 1, 1897; ratified by the President February 2, 1897; ratified by the Emperor March 6, 1897; ratifications exchanged at Tokyo March 8, 1897; proclaimed March 9, 1897.]

The President of the United States of America and His Majesty the Emperor of Japan, being desirous of securing immediate reciprocal protection for patents, trade-marks, and designs have resolved to conclude a convention for that purpose, and have appointed as their plenipotentiaries:

\* \* \* \* \*

Article XVI of the Treaty of Commerce and Navigation between the United States of America and Japan concluded at Washington on the twenty-fourth day, the eleventh month, the twenty-seventh year of Meiji, corresponding to the twenty-second day of November, eighteen hundred and ninety-four of the Christian Era, shall have full force and effect from the date of the exchange of ratifications of this convention.

## SECTION 10.

## NETHERLANDS.

The object of a convention is accomplished by the exchange of diplomatic notes, as follows:

(1) *Mr. de Weckherlin to Mr. Frelinghuysen*

LEGATION OF THE NETHERLANDS,  
Washington, February 10, 1883.

MR. SECRETARY OF STATE:

I have the honor herewith to transmit to your excellency a copy of the official edition of the Dutch law relative to trade-marks, bearing date of May 25, 1880.

The provisions of this law make no distinction between natives of the Netherlands and foreigners, so that citizens of the United States of America receive the same usage in the Netherlands as my countrymen as regards everything connected with the registration and protection of their trade-marks.

It consequently seems that, so far as the Netherlands are concerned, the conditions of reciprocity are fulfilled which are established for the registration and protection of foreign trade-marks in the United States of America by the act of Congress approved March 3, 1881, which allows the registration of trade-marks whose owners reside in foreign countries the laws of which grant the same privilege to the citizens of the United States of America.

I have, therefore, been instructed by my Government to beg your excellency to be pleased, if there are no objections, to cause the adoption of the measures necessary in order that subjects of the Netherlands may hereafter avail themselves in the United States of America of the act of Congress to which I have just referred.

Be pleased to accept, Mr. Secretary of State, etc.,

G. DE WECKHERLIN.

(2) *Mr. Frelinghuysen to Mr. de Weckherlin.*

DEPARTMENT OF STATE,  
Washington, February 16, 1883.

SIR: I have the honor to acknowledge the receipt of your note of the 10th instant, by which you communicate to me the text of the Netherlands law of the 25th of May, 1880, concerning marks of trade and commerce.

I have taken due note of your statement that this law makes no distinction between Nederlanders and foreigners, so that the citizens of the United States are treated in the low countries on the same footing as the natives thereof in all that concerns the registration and protection of their commercial and trade marks.

As the enacting clause of the act of Congress of March 3, 1881, "to authorize the registration of trade-marks and protect the same," provides in terms as follows: "That owners of trade-marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign



country or tribes which by treaty, convention, or law afford similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with" the requirements of that act, and as your declaration establishes the fact that the Netherlands law gives similar privileges to citizens of the United States located in the low countries, the fact of entire reciprocity of usage between the two countries in this respect may now be regarded as established and evidenced by the present exchange of diplomatic notes, and as henceforth operative without further formalities between them.

Accept, sir, etc.,

FREDERICK T. FRELINGHUYSEN.

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## SECTION 11.

### RUSSIA.

*Article respecting trade-marks, additional to the treaty of navigation and commerce of December 6-18, 1832.*

[Concluded at Washington January 27, 1868; ratifications exchanged at St. Petersburg September 21, 1868; proclaimed October 15, 1868.]

### ADDITIONAL ARTICLE.

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, shall be strictly prohibited and repressed, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeited shall be proven.

The trade-marks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other must be lodged exclusively, to wit, the marks of citizens of the United States in the department of manufactures and inland commerce at St. Petersburg, and the marks of Russian subjects at the Patent Office in Washington.

This additional article shall be terminable by either party, pursuant to the twelfth article of the treaty to which it is an addition. It shall be ratified by the President, by and with the advice and consent of the Senate of the United States, and by His Majesty the Emperor of all the Russias, and the respective ratifications of the same shall be exchanged at St. Petersburg within nine months from the date hereof, or sooner if possible.

In faith whereof the respective plenipotentiaries have signed this convention, and thereto affixed the seals of their arms.

Done at Washington the 30th day of March, in the year of our Lord 1867.

[SEAL.]  
[SEAL.]

WILLIAM H. SEWARD.  
EDOUARD DE STOECKL.

*Declaration respecting previous treaty stipulations in regard to trade-marks signed March 28, 1874.*

[Proclaimed November 24, 1874.]

## ARTICLE I.

With regard to marks of goods or of their packages, and also with regard to marks of manufacture and trade, the citizens of the United States of America shall enjoy in Russia, and Russian subjects shall enjoy in the United States, the same protection as native citizens.

## ARTICLE II.

The preceding article, which shall come immediately into operation, shall be considered as forming an integral part of the treaty of the 18<sup>th</sup> December, 1832, and shall have the same force and duration as the said treaty.

In faith whereof the undersigned have drawn up and signed the present declaration, and affixed thereto their seals.

Done in duplicate in the English and Russian languages at St. Petersburg, this 1<sup>st</sup> 8<sup>th</sup> day of March, 1874.

[SEAL.]  
[SEAL.]

MARSHALL JEWELL.  
GORTCHACOW.

## SECTION 12.

## SERBIA.

*Convention for facilitating and developing commercial relations.*

[Concluded at Belgrade, October 14, 1881; ratifications exchanged at Belgrade November 15, 1882; proclaimed December 27, 1882.]

## ARTICLE XII.

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise to show its origin and quality shall be strictly prohibited and repressed and shall give ground for an action of damages in favor of the injured parties, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other, must be registered exclusively, to wit: The marks of citizens of the United States in the tribunal of commerce at Belgrade, and the marks of Serbian subjects in the Patent Office at Washington, subject to the conditions and restrictions prescribed by the laws and regulations of the country in which the trade-marks are registered.

## SECTION 13.

## SPAIN.

*Convention concerning trade-marks.*

[Concluded June 19, 1882; ratifications exchanged at Washington April 19, 1883; proclaimed April 19, 1883.]

## ARTICLE I.

The citizens and subjects of each of the two contracting parties shall enjoy, in the dominions and possessions of the other, the same rights as the natives of the country in everything relating to the ownership of trade-marks, industrial designs or models, or of manufactures of any kind.

## ARTICLE II.

Persons desiring to secure the aforesaid protection shall be obliged to comply with the formalities required by the laws of the respective countries.

## ARTICLE III.

This convention shall take effect as soon as it shall have been promulgated in both countries; and shall remain in force for ten years thereafter, and further until the expiration of one year after either of the contracting parties shall have given notice to the other of its wish to terminate the same; each of the contracting parties being at liberty to give such notice to the other at the end of said period of ten years or any time thereafter.

The ratifications of this convention shall be exchanged at Washington as soon as possible within one year from this date.

In testimony whereof the respective plenipotentiaries have signed this convention in duplicate, in the English and Spanish languages, and affixed thereto the seals of their arms.

Done at Washington, the 19th day of June, in the year of our Lord 1882.

[SEAL.]  
[SEAL.]

FRED'K T. FRELINGHUYSEN.  
FRAN<sup>co</sup> BARCA.

## SECTION 14.

## SWITZERLAND.

The object of a convention is accomplished by the exchange of diplomatic notes, as follows:

(1) *Mr. Frey to the Secretary of State.*

SWISS LEGATION,  
Washington, April 27, 1883.

MR. SECRETARY OF STATE:

The undersigned, minister of the Swiss Confederation, has this day had the honor to receive your note of the 24th instant \* \* \* relative to the mutual protection of trade-marks.



The undersigned sees by the aforesaid note that you would prefer to make such an arrangement between the United States and Switzerland in the form of an exchange of notes, inasmuch as that form appears to you to be the most simple and the best calculated to avoid the difficulties connected with the ratification of a declaration or convention.

The undersigned has the honor to reply that, \* \* \* by a communication of the 6th of March last, he laid before the Federal Council the text of your note of the 5th of that month, and at the same time he proposed to try an exchange of declarations which, as regards the form, would coincide with your views. The Federal Council having consented thereto by its communication of March 30, and having instructed the undersigned with full powers to make such an arrangement, the undersigned thinks that he represents the intentions of his Government by giving his adhesion to an exchange of notes.

As regards the question whether the principle of reciprocity is embodied in the federal law of December 19, 1879, the undersigned has the honor to invite your attention to the text of article 7, paragraph 2, of the federal law of December 19, 1879, and also to the contents of the message of the Federal Council relative thereto. In the aforesaid paragraph of the law of December 19, 1879, it is expressly provided that producers and merchants, whose business is carried on in a State which accords the right of reciprocity to Swiss citizens, may have their marks registered in the same manner as Swiss citizens. But one condition is added, viz: That foreigners shall be obliged to prove that these marks are already protected in the State to which they belong, the sole object of which reservation is to prevent foreigners from depositing with fraudulent intent, under the protection of reciprocity, marks for which they can not claim protection in their own country. The Federal Council, moreover, in its message of October 13, 1879, whereby it transmitted to the Federal Chambers a bill for the protection of trade-marks, made the following declaration touching trade-marks: "As regards foreign trade-marks we are of opinion that Switzerland should stand upon the ground of reciprocity, and that this is the only position that should be taken by us in the interest of our industry."

In view of this declaration the Federal Chambers, in accepting without material modification the aforesaid paragraph 2 of article 7 of the law in question, were without doubt actuated by a desire to embody the principle of full reciprocity in the law.

The undersigned takes the liberty in conclusion, to ask your attention to the fact that the Confederation has, since the promulgation of the aforesaid law, concluded a convention with various States for the protection of trade-marks upon the basis of reciprocity—for instance, with Great Britain, Belgium, and the Netherlands—and that the Confederation, previously to the promulgation of that law, guaranteed, in its commercial treaties with France, Germany, and Italy, protection in Switzerland for their trade-marks to the citizens or subjects of those States.

The undersigned thinks that he has by the foregoing furnished proof that the Confederation recognizes the principles of reciprocity as regards the international protection of trade-marks as an integral part

of its public law, and that the United States may, with the most perfect confidence, enter into such an arrangement with the Confederation.

The undersigned avails himself, etc.

E. FREY.

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(2) *Mr. Davis to Mr. Frey.*

DEPARTMENT OF STATE,  
*Washington, May 14, 1883.*

COLONEL: I have the honor to acknowledge the receipt of your note of the 27th ultimo, concerning the reciprocal privilege of trade-marks registration in the the United States and Switzerland.

It gives me much pleasure to accept your declaration as evidence that the law of Switzerland affords such a guaranty of reciprocity in the matter as will make the application of the privileges of the act of Congress of March 3, 1881, to owners of trade-marks in Switzerland proper and certain.

This exchange of notes accomplishes the end in view of securing complete reciprocity under the legislation of the respective countries, and I have therefore communicated your note to the Secretary of the Interior, with this reply, and requested him to make the necessary regulations for admitting Swiss trade-marks to all the privileges of registration which under that act pertain to the trade-marks of American origin.

Now that the immediate object of our late correspondence on the subject is attained, permit me to suggest that with a view to rendering the engagements of this Government with foreign nations as uniform as possible the Government should be pleased to conclude and sign with you a formal trade-marks convention, similar to that lately concluded with Spain, to which I have before referred and of which I inclose a printed copy herewith.

Our present diplomatic accord will, of course, hold good until such formal convention can be made effective by ratification and exchange.

Accept, Colonel, a renewed assurance of my highest consideration.

JOHN DAVIS, *Acting Secretary.*

## CHAPTER XIX.

### FOREIGN COUNTRIES WHICH PROVIDE BY LAW FOR THE REGISTRATION OF TRADEMARKS.

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The following list of countries which provide by law for the registration of trademarks and for the protection of registered marks against infringers, together with the note which follows the list, is taken by permission from Greeley's Foreign Patent and Trademark Laws (Washington, 1899):

- Argentine Republic: Laws of August 14, 1876; July 31, 1897.
- Austria: Laws of January 6, 1890; June 10, 1891.
- Belgium: Law of April 1, 1879.
- Bolivia: Law of November 25, 1893; amended March 24, 1897.
- Brazil: Law of October 14, 1887.
- British New Guinea: Law of 1894.
- British South Africa (Rhodesia, Mashonaland, and Matabeleland): Laws of 1893 and 1894.
- Bulgaria: Law of December 15-27, 1892; amended December 21, 1893-January 2, 1894.
- Canada: Law of May 15, 1879; amended March 26, 1890.
- Cape Colony: Law of 1877; amended July 5, 1895.
- Ceylon: Law of December, 1888; amended April 16, 1890.
- Chili: Law of November 12, 1874.
- Congo Free State: Law of April 26, 1888.
- Costa Rico: Law of May 22, 1896.
- Denmark: Law of April 11, 1890; amended December 19, 1898.
- Dutch East Indies: Law of September 30, 1893.
- Dutch West Indies: Law of September 30, 1893.
- Fiji Islands: Law of April 22, 1886.
- Finland: Law of February 11, 1889.
- France: Law of June 23, 1857; amended May 3, 1890.
- Germany: Law of May 12, 1894.
- Great Britain: Laws of August 25, 1883; August 23, 1887; December 24, 1888, and May 11, 1891.
- Greece: Law of February 10-22, 1893.
- Guatemala: Law of November 23, 1897.
- Hawaii: Law of June 23, 1888.
- Hongkong: Laws of December 9, 1873; August 7, 1890.
- Hungary: Law of February 4, 1890. (See law of 1890 of Austria.)
- Italy: Laws of August 30, 1868, and January 16, 1898.
- Jamaica: Laws of 1888 and 1889.
- Japan: Law of March 1, 1899.
- Labuan: Law of November 1, 1893.
- Leeward Islands: Law of 1887.
- Luxemburg: Law of March 28, 1883.
- Mauritius: Law of October 20, 1868.
- Mexico: Law of November 28, 1889, amended December 17, 1897.
- Natal: Laws of 1885 and October 24, 1888.
- Netherlands: Law of September 30, 1893.
- Newfoundland: Law of May 9, 1888.
- New South Wales: Law of May 26, 1865; amended 1893.



- New Zealand: Law of September 2, 1889.  
 Norway: Law of May 26, 1884.  
 Orange Free State: Law of 1891.  
 Paraguay: Law of August 5, 1892.  
 Peru: Law of December 19, 1892; amended December 31, 1895.  
 Portugal: Law of May 21, 1896.  
 Queensland: Laws of October 13, 1884, and November 5, 1890.  
 Roumania: Law of April 15-27, 1879.  
 Russia: Law of February 26-March 9, 1896.  
 Serbia: Law of May 30-June 11, 1884.  
 South African Republic: Law of May 31, 1892.  
 South Australia: Law of 1892.  
 Spain: Laws of November 20, 1850; July 11, 1851; September 1, 1888, and February 12, 1889.  
 Sweden: Laws of July 5, 1884; November 28, 1884; February 20, 1885; March 5, 1895; December 31, 1895; March 5, 1897, and June 25, 1897.  
 Switzerland: Law of September 26, 1890; amended July 30, 1895.  
 Tasmania: Law of September 29, 1893.  
 Trinidad and Tobago: Law of November 19, 1894; amended 1897.  
 Tunis: Law of June 3, 1889.  
 Turkey: Law of May 10, 1888.  
 Uruguay: Law of March 1, 1877.  
 Venezuela: Law of May 24, 1887.  
 Victoria: Law of July 10, 1890; amended December 19, 1890.  
 Western Australia: Law of October 10, 1894.

In practically all the British possessions, other than those above named, in which provision is made by law for registration of trademarks, the merchandise marks act of 1887 of Great Britain has, either in precise terms or in substance, been put in force. Under this act forging or falsely applying a trademark to goods is made a punishable offense. The British possessions in which such law has been adopted without requirement of or provision for registration are: Barbados, Bermuda, British Guiana, British Honduras, Falkland Islands, Gibraltar, Gold Coast, Grenada, India (British), Lagos, St. Lucia, St. Vincent, Sierra Leone, and Straits Settlements.

In Malta fraudulent use of a trademark is punishable under the criminal law. In Colombia fraudulent use of a trademark is punishable under the penal code, and though not specifically authorized by law, a register of trademarks is kept. In Egypt trademarks are protected against infringement by the courts. In China the trademarks of foreigners will, to some extent at least, be protected against infringement through diplomatic action.

In all of these countries in which no provision is made for registration it is generally found of importance for the owner of a trademark to give ample notice to the public of his claim to the exclusive right to the mark by publishing the mark in newspapers. The protection afforded in these countries is in the nature of protection against unfair competition rather than protection of the property right in the mark.

## CHAPTER XX.

EXTRACTS FROM THE REPORT, DATED MARCH 16TH, 1888, OF THE DEPARTMENTAL COMMITTEE APPOINTED BY THE (BRITISH) BOARD OF TRADE ON FEBRUARY 24TH, 1887, "TO INQUIRE INTO THE DUTIES, ORGANIZATION, AND ARRANGEMENTS OF THE PATENT OFFICE UNDER THE PATENTS, DESIGNS, AND TRADE-MARKS ACT, 1883 (46 AND 47 VICT., C. 57), SO FAR AS RELATES TO TRADE-MARKS."

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### REPORT.

The complaints which have been made to us of the working of the act of 1883 and the suggestions which have been submitted of amendments in the law and its administration have had reference both to the registration of trade-marks and designs. We propose to deal with these matters separately, directing attention first to the subject of trade-marks.

#### I.—TRADE-MARKS.

1. We propose first to consider the suggestions which have been made for improvements of procedure in relation to the registration of trade-marks.

\* \* \* \* \*

15. We have given very careful consideration to the evidence which has been laid before us by those interested in the trade of Lancashire. The number of marks registered in classes 23, 24, and 25, which are commonly described as the cotton classes, is very large, and the administration of the act in relation to these classes is of great importance to the trade. There can be no doubt that the working of the trade-marks act has not given satisfaction in Lancashire. Even if at times there may have been a disposition to expect too much, we think there have been substantial grounds for the dissatisfaction which has prevailed. The great bulk of the goods manufactured in Lancashire in respect of which trade-marks are used is exported to other countries, and there can be no doubt that these marks fulfill important functions in the trade between Lancashire and India and other countries. One chief complaint has been that the usages of the trade and the character of the markets where the marks are intended to serve their purpose have not been sufficiently kept in view by the patent office. By section 72, subsection 2, the comptroller is directed not to register, with respect to the same description of goods, a trade-mark so nearly resembling a trade-mark already on the register with respect to such description of goods as to be calculated to deceive. It is on the question whether marks do so nearly resemble one another as to be calculated to deceive, and what extent of resemblance to an old mark ought to cause the rejection of an application, that the chief difference has arisen between the trade and those to whom the administration of the act has been intrusted. The tendency of the office has been to construe the words of the enactment more favorably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the act.

The comptroller has felt unable to say that the two marks "so nearly" resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent that he otherwise might, the character of the market in which the mark is to serve its purpose. Two marks, when placed side by side, may exhibit many and various differences, yet the idea left upon the mind by both may be the same, so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show the players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon the marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

In order to avoid misapprehension in the future we recommend, even though it may not be absolutely necessary, a slight amendment of the act, substituting for the words "*so nearly resembling*" the words "*having such resemblance to,*" and, further, we would suggest that when the question arises whether a mark applied for bears such resemblance to one on the register as to be calculated to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only impression, left on the mind might be very different, whilst, on the other hand, a critical comparison of two marks might disclose numerous points of difference and yet the idea which would remain with any person seeing them apart at different times might be the same.

In this connection we may refer to a point which has been the subject of considerable controversy, namely, how far registered or common marks when combined together are to be regarded as a new mark. We think that the juxtaposition of two or more such marks is not, if there be nothing more than this, a combination constituting a new mark. An important test appears to be whether the existing marks are so combined as to suggest a new idea. For instance, assuming a cat and a fiddle to be each an old mark, we do not think the mere representation of a cat and a fiddle together would be a new mark, but the representation of a cat playing upon a fiddle, the idea conveyed by which would be neither the cat nor the fiddle, but a cat playing upon a fiddle, would be a good combination, and might properly be registered. We think this view differs somewhat from that which has been at times, at all events, entertained by the board of trade, but it appears to us to be the sound one.

Where several common or open marks are worked into a single new design by being grouped together within a border or otherwise, we think that such a combination may be entitled to registration, but that it would be well to require that all the common elements should be disclaimed.

\* \* \* \* \*

18. We have had under our serious consideration the question whether it would be expedient and possible to provide for the registration of what



are known in the cotton trade as line headings. It is clear that it could only be done by an alteration of the law, making, in that case, the colors used an essential part of the registered mark. There appears to be a somewhat general concurrence of view that if it were practicable to provide effectually for the registration of these headings it would be desirable to do so, but the most opposite opinions were expressed by persons of large experience in the Manchester trade on the point whether it would be practicable. We are disposed to concur with those who pronounce it impracticable, but whether this view be correct or not we clearly cannot recommend the adoption of a scheme the practicability of which is open to such serious doubt. At the same time we are fully conscious of the evils to which our attention has been directed. Woven line headings no doubt play an important part in many markets. They become associated in the minds of buyers with the make of a particular manufacturer or the merchandise of a particular merchant, and goods bearing particular marks obtain on account of their proved quality a high reputation in the market. Thereupon some other manufacturer or merchant sends to the very market where he knows this reputation has been acquired goods of an inferior quality bearing, not the identical heading, but one so resembling it as to leave on the mind of a person seeing it the same impression. He is thus enabled to undersell the merchant who originally introduced the mark to the market, whilst still securing a good profit for himself on account of the inferior quality of his goods, and this process often goes on until the very mark which gained the reputation is shunned by the buyers who at one time valued the goods to which it was attached.

Even those witnesses who have felt most strongly the impossibility of protecting line headings by registration have admitted the magnitude of the evil, and that these resemblances of headings, of which complaint is made, are not accidental but intentional. We are satisfied that not only do individual traders incur loss from this cause, but that the trade of Lancashire suffers from it.

The imitation of headings, however, is not the only mode by which this kind of false representation is successfully carried on. We have had before us pieces of cloth each of which bore different trade-marks, tickets, words, figures, and other marks, but on which those trade-marks, tickets, &c., were so colored and distributed as to convey the impression, in the absence of careful examination, that the goods bore the same marks. No one looking at those pieces of cloth could doubt that the resemblance was intentional, and was designed for the very purpose of deceiving. Although we arrived at the conclusion that it would not be possible to give to line headings the protection of registration, we felt that the fraudulent trading to which our attention had been called ought not to remain unchecked, and that something ought to be done to remedy a state of things so detrimental to sound and honest trading. We therefore procured the insertion in the merchandise-marks act of a clause having for its object to bring these frauds within the penalties of the law, and thus to check their practice. The clause has been the subject of a good deal of criticism, and some alarm has been expressed lest it should press hardly on persons acting with perfect honesty. We do not think this is likely to be the case. It is, of course, difficult so to frame a law as to make it effectual against wrongdoers, and at the same time to guard those who have no unlawful

intention from all possible risk of inconvenience. The operation of the act must, no doubt, be carefully watched, and it may well be capable of amendment, but we could not resign ourselves to the conclusion that mischievous frauds must be allowed to continue without even an attempt to put a stop to them.

\*            \*            \*            \*            \*            \*

24. We will next proceed to consider the objections which have been taken to the law which now governs what may be registered as trade-marks, and the important suggestions which have been made for its amendment.

25. By section 64 (1) (c) of the act a trade-mark may be registered which consists of or contains "a distinctive device, mark, brand, heading, label, ticket, or fancy word, or words not in common use." Some controversy has arisen with reference to the meaning of the word "brand" as distinguished from the other words employed. There can be no doubt that the term derives its origin from the practice of producing some mark by means of burning, but it appears now to be in use in certain trades for the purpose of describing trade-marks no longer produced in this way, and differing in no respect from the labels or tickets mentioned in the section; nevertheless, a distinction has been made in the practice of the office, and trade-marks have been allowed registration in certain trades as brands when they would not be accepted in other classes as labels or tickets. We see no reason for this distinction. It does not appear to us to receive support from the language of the act, and we think that in future brands should be dealt with in precisely the same way as labels or tickets.

26. The most difficult question which has arisen upon the enactment under consideration is to determine what may properly be regarded as "fancy words." Words are, undoubtedly, a most popular form of trade-mark, but some limit must obviously be put upon the words which an individual may be permitted to register and claim the exclusive use of. The expression "fancy word" is certainly not a happy one, and has naturally given rise to considerable differences of opinion as to its meaning.

It will be convenient to consider first what words ought to be allowed as trade-marks. There can be no objection to permitting the registration of an invented word not to be found in the vocabulary of our own or any other country. It seems to us, further, that existing words may with advantage be permitted as trade-marks, subject to limitations which at once suggest themselves. It is manifest that no one ought to be granted the exclusive use of a word descriptive of the quality or character of any goods. Such words of description are the property of all mankind, and it would not be right to allow any individual to monopolize them and exclude others from their use. Again, geographical words which can be regarded as descriptive of the place of manufacture of or sale of the goods are open to obvious objections. One manufacturer or merchant can not properly be allowed to prevent all his competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first who had manufactured or sold the goods in the place the name of which he seeks to appropriate as a trade-mark. But there are objections to giving a monopoly even in that case, and to attempt



to draw any such distinction would be likely to lead to difficulty and litigation. We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale. We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the register, though differently spelt and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark and that applied for was such as to be calculated to deceive; if it were, it ought, of course, to be rejected.

Our attention had been called to the rejection of words which it is said indicate the use to be made of the articles to which they are to be applied; as, for example, "Mariner's rum." We think that if the word sought to be registered would be understood as suggesting a special use of the goods, or their adaptability to a particular purpose, it would be objectionable as descriptive of their character.

Registration, it appears, is sometimes sought of devices which are descriptive of the goods to which they are to be adapted, e. g., a representation of a hinge to be applied to doors. We think these are not legitimate marks.

Complaints have also been made that where words have been refused as not being distinctive, they have afterwards been allowed where the applicant has applied for a mark consisting of the same word preceded by the applicant's name with an apostrophe. We think this course ought not to be pursued. Little or no mischief might result where the name of the applicant was an uncommon one, but where the name was a common one the result would be to deprive all persons bearing the same name of their right to use a common word in connection with their own name, and even if the name were an uncommon one it would be impossible to say that there were not other persons bearing it who might wish to use it in connection with the common word which it is sought to monopolize.

Evidence has been given that marks consisting of a combination of the applicant's name with the article he manufactures or sells are highly valued. There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation among the public he could, by process of law, quite apart from the trade-marks act, prevent goods that were not his from being offered to the public on the representation that they were so. But it would be quite a different thing to give, by virtue of registration under the trade-marks act, a right to prevent another manufacturer or merchant honestly describing his own goods by his own name.

It is said that there is often a desire to register short phrases, such as proverbs, etc., and that owing to the difficulty of finding new marks it is expedient that they should be allowed. We see no objection to this, provided that they are in no way descriptive of the character or quality of the goods, or of their place of origin, sale, or manufacture.

There is said to be a general, if not unanimous, desire among those interested in the cotton classes that words should not be permitted to be registered as trade-marks in classes 23 and 24. If the desire be so general as is represented, we see no reason in principle why it



should not be yielded to. But there appears to be a serious difficulty in the way of making such a change at present, owing to the international convention which has been entered into. We understood that word marks are registered in the cotton classes in some of the countries which are parties to the convention; and there would be an anomaly in permitting such marks to be registered here when first registered in those countries, while registration is denied them if first applied for in England.

27. By section 64, subsection 2, there may be added to any one or more of the essential particulars, "any letters, words, or figures, or combination of letters, words, or figures, or any of them." There is here, it will be seen, no limitation as to the letters, words, or figures which may be combined with the essential part of a trade-mark. By section 74, however, it is provided that nothing in the act shall be construed to prevent the Comptroller registering as an addition to any trade-mark "any distinctive word, or combination of words, though the same is common to the trade in the goods with respect to which the application is made." But this section enacts, subsection 2, that "the applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register." It has been said, and we think truly, that it is not easy to understand what is the exact status of the added matter provided for by section 64. Where the added words are not common to the trade in the goods with respect to which the application is desired, the right of exclusive use need not be disclaimed, yet it is presumed that the proprietor of the trade-mark could not object to their use by any other person except in connection with the essential particular of his trade-mark. What purpose, then, do they serve? Perhaps they may be useful in the case of a colorable imitation of the essential particular. If with such an imitation the same added words were used it would assist the proprietor in establishing that his trade-mark had been infringed. But the added matter may, it is assumed, be of so distinctive a character as to form an essential part of the trade-mark, so that its use might be an infringement. We think it would clearly be desirable that the added matter, which the proprietor does not claim the exclusive use of, should be disclaimed, so that the public may know exactly what is the trade-mark registered. We think, too, that all disclaimers should appear in connection with the mark in the official journal. Some misapprehension might perhaps arise if the person registering the mark were compelled to disclaim his own name or the foreign equivalent for it. We think, therefore, this might be excluded from the necessity of disclaimer, but it should be provided that the proprietor of the mark should not thereby acquire the right to prevent any other person bona fide using his own name in connection with his goods.

\* \* \* \* \*

41. It has been suggested that there is a necessity for some statutory definition of the trade-mark rights which are acquired in connection with words used as the names of patented articles. Where a patent has been obtained for some article of commerce, and the patentee gives it a name which he registers as his trade-mark, has he a right at the end of the term of his patent to prevent other people from selling it under that name? It is clear that he obtains the patent upon the

condition that at the expiration of the term of his monopoly the public should have the right to manufacture and use it, and if the only name by which it is known is that which the proprietor has registered as a trade-mark, it would certainly seem inconsistent with the right thus intended to be conferred on the public if everyone except the original patentee were prevented from calling it or from selling it by that name which alone it bears. The authorities appear, however, to show that such a claim could not be maintained.

\* \* \* \* \*

## II.—DESIGNS.

\* [ \* ] \* \* \* \*

HERSCHELL.  
CRAWFORD.  
MACNAGHTEN.

A. J. MUNDELLA.  
H. DE WORMS.  
JAMES F. HUTTON.

MARCH 16, 1888.

## CHAPTER XXI.

### LEGISLATION PROVIDING FOR THE REGISTRATION AND PROTECTION OF COLLECTIVE TRADEMARKS.

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*A.—Legislation of certain foreign countries in reference to collective trademarks.*

#### SECTION 1.

##### FRANCE.

(Law of November 26, 1873.)

ARTICLE 1. Any owner of a trademark registered in accordance with the law of June 23, 1857, shall be permitted, on written application, to have placed by the State, on the labels, bands, or wrappers of papers, or on the labels or impressions in metal in which the mark appears, a special stamp, printed or impressed, intended to affirm the authenticity of such mark.

The impressed stamp shall be placed on the mark which is applied directly to the goods, if in the opinion of the Government it can be so applied.

ART. 7. The printed or impressed stamp placed on a trademark becomes an integral part of the mark.

If the Government fails to prosecute, either in France or abroad, the counterfeiting or falsification of the said printed or impressed stamp, the prosecution may be carried on by the owner of the mark.

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#### SECTION 2.

##### GERMANY.

(Imperial decree of March 16, 1872.)

\* \* \* I authorize all German manufacturers to make use of a reproduction of the imperial eagle in the form prescribed by my decree of August 3 of last year, type No. 2, to distinguish their articles of merchandise or labels. \* \* \* (*Reichs-Gesetzblatt*, 1872, p. 90.)



## SECTION 3.

## GREAT BRITAIN.

(Patents, Designs, and Trademarks act, 1883.)

ART. 81. (11) A body of persons, corporate or not corporate, may (notwithstanding anything in any act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trademark or trademarks.

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## SECTION 4.

## JAPAN.

(Law of March 1, 1899.)

ART. XXI. Any mark of traders' associations sanctioned by proper authority, when desired for an exclusive use as a trademark, may be registered under this act.

The mark registered according to the last-preceding paragraph shall be deemed as a registered trademark.

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## SECTION 5.

## PORTUGAL.

(Law of May 21, 1896.)

ART. 66. Marks may be registered in favor of a person, a firm, a joint stock company, a corporation, or an individual.

ART. 81. The proprietor or proprietors of a mark who desires, for the better guaranty of his goods, the addition of the stamp of the State impressed, punched, or branded, must present with his application the labels, packages, or articles in question, paying for this service a sum which shall be fixed by regulation.

ART. 82. The stamp establishes a legal presumption of the genuineness of the marks to which it is applied.

ART. 83. The stamp shall be applied in the department of industry or other place which may be appointed.

ART. 84. The application for the affixing of the stamp must be signed by the person who effected the registration, or be accompanied by a power of attorney from the proprietor, or by a document proving the ownership of the mark to be stamped.

## SECTION 6.

## SWITZERLAND.

(Law of September 26, 1890.)

ART. 7. The following may register their marks:

\* \* \* \* \*

(3) Associations of manufacturers, producers, and traders who satisfy the condition above stated under (1) and (2),<sup>1</sup> and possess legal competency (*capacité civile*),<sup>2</sup> as well as public authorities.

B.—*Legislation of States of the United States in reference to the registration and protection of collective trademarks.*

[From Greeley's Foreign Patent and Trademark Laws, Washington, 1899, by permission.]

The following States provide by law for the registration of trademarks by any person, or association, or union of workingmen, and for the punishment, by fine or imprisonment, of infringers:

Delaware, act of March 29, 1893.  
 Georgia, act of December 20, 1893.  
 Idaho, act of March 12, 1897.  
 Illinois, act of June 13, 1895.  
 Indiana, acts of March 6, 1891, and March 8, 1897.  
 Iowa, act of March 26, 1892.  
 Louisiana, act of July 8, 1898.  
 Maine, act of March 28, 1893.  
 Maryland, act of April 4, 1892.  
 Massachusetts, act of June 4, 1895.  
 Michigan, act of May 24, 1895.  
 Minnesota, act of February 23, 1895.  
 Missouri, act of March 20, 1893.  
 Montana, Sander's Penal Code, 1895.  
 New Hampshire, act of March 13, 1895.  
 New Jersey, act of March 15, 1898.  
 Ohio, acts of March 30, 1892, and May 1, 1894, Revised Statutes, 1890.  
 Oklahoma, act of March 11, 1897.  
 Tennessee, act of February 3, 1897.  
 Utah, act of March 8, 1894.  
 Wisconsin, act of April 9, 1895.

The following States provide by law for the registration of trademarks only by associations or unions of workingmen and for the punishment of infringers by fine or imprisonment:

Kansas, act of March 11, 1891.  
 Kentucky, acts of April 16, 1892, and March 8, 1894.  
 Nebraska, Laws of 1891, chapter 15.  
 Pennsylvania, act of May 21, 1895.  
 South Dakota, act of March 7, 1890.

<sup>1</sup> With respect to location either in Switzerland or in a country which accords reciprocity to Swiss citizens.

<sup>2</sup> In order to be competent under the law such associations must be enrolled on the commercial register. This provision permits also the creation of municipal or regional marks, which may be made use of only by manufacturers or producers located in a locality noted for its manufactures or agricultural products (message of the federal council of January 28, 1890). (*Recueil Général*, p. 572, note.)

## CHAPTER XXII.

### TRADEMARK LAW OF GERMANY, WITH NOTES THEREON.

#### LAW FOR THE PROTECTION OF MERCHANDISE MARKS.<sup>1</sup>

(May 12, 1894.)

[Text of the law from the translation published in the Official Gazette of the United States Patent Office. Notes and rules translated for this report by Mr. Greeley from *Recueil Général de la législation*, etc., published by the International Bureau of Industrial Property.]

SECTION 1. Any person who desires to use in his business a merchandise mark to distinguish his goods from those of others may declare it for registration in the Roll of Marks.<sup>2</sup>

SEC. 2. The Roll shall be kept at the Patent Office.<sup>3</sup> The declaration of a mark shall be made in writing to the Patent Office. Every declaration must be accompanied by a statement of the enterprise for which the mark is to be employed<sup>4</sup> and a specification of the merchandise for which it is intended,<sup>5</sup> as well as a distinct representation of the mark and a description thereof so far as it may be necessary.<sup>6</sup>

The Patent Office shall prescribe rules concerning other requirements of the declaration.

A fee of 30 marks (about \$7.50) shall be paid with the declaration of each mark, and at each renewal of the declaration a fee of 10 marks.

<sup>1</sup> Although this law is to a large extent devoted to *marks of manufacture and commerce* properly so called, we use the term *merchandise mark* in order to give an equivalent for the German term *Warenzeichen*, which has been substituted for that of *Fabrik- und Handelsmarke*, employed in the old law.

<sup>2</sup> The old law applied only to establishments enrolled on the register of commerce. The new law applies to all persons carrying on any industry or trade whatever, including mining operations, agriculture, *d'élevage*, etc. Excluded from the protection of the law are those who are merely hand reapers, dealers in real estate and in matters relating thereto. (*Contra* Seligsohn, p. 25.)

The protection is extended to signs placed on the article or on the package, excluding the mere form of the article or the package (for example, toilet soap or a flask of a particular shape).

The external appearance of the article or the package is nevertheless not wholly deprived of all protection. (V, sec. 15.)

<sup>3</sup> Under the system of the old law marks were registered by the tribunals charged with keeping the commercial registers.

<sup>4</sup> A mark may be registered even before the business for which it is intended is established, but in such case the registrant is liable to have the cancellation of his mark asked for on the ground that it has not been used.

<sup>5</sup> The old law permitted registration of a mark for a list of goods.

It is left very largely by the spirit of the law to the Patent Office to rule upon this matter. (Report of the parliamentary commission.)

<sup>6</sup> The Patent Office may, if it is considered desirable, require that a description be filed with the application. As far as this is concerned, the applicant may on his own motion file a description and it is considered good practice to do so.



If registration does not result from the first declaration, 20 marks of the fee shall be refunded.

SEC. 3. The Roll of Marks shall contain, first, the date of receipt of the declaration; second, the facts required to accompany the declaration by the first paragraph of section 2 of this law; third, the name and domicile of the proprietor of the mark and of his representative,<sup>1</sup> if any, as well as changes in the person, the name or the domicile of the proprietor of the mark or his representative; fourth, the date of renewal of the declaration; fifth, the date of cancellation of the mark.

The Roll shall be free to public inspection.

Every registration and cancellation will be officially published.<sup>2</sup> The Patent Office will publish periodically abstracts of registrations and cancellations.

SEC. 4. Registry on the roll will be refused for free marks (*Freizeichen*<sup>3</sup>) as well as for those merchandise marks, first, which consist exclusively of letters or numerals<sup>4</sup> or of words containing indications of the mode, time or place of production; or of the quality, destination, price, quantity or weight of the merchandise;<sup>5</sup> second, which contain the arms of German or foreign States, or those of a locality, parish, or union of towns situated in the country;<sup>6</sup> third, which contain scandalous representations, or indications evidently at variance with the facts and liable to cause deception.<sup>7</sup>

Canceled marks cannot be registered anew in favor of another than the last proprietor for merchandise identical or analogous with that for which they were registered, until after two years from the date of cancellation.

SEC. 5. If the Patent Office shall regard that any declared mark is in conflict with one previously declared for similar merchandise under the law of November 30, 1874, or under the present law, it shall advise

<sup>1</sup>Foreigners not resident in the country must be represented by an attorney. The attorney should be appointed by a written power of attorney, which may be in a foreign language.

<sup>2</sup>The publication of the registration is made from time to time in the *Reichsanzeiger* and also by periodic lists in the *Waarenzeichenblatt*.

<sup>3</sup>The Patent Office has defined free marks as follows: "Considered as free marks in the sense of the law, according to the present judicial practice, should be all marks which, at the time at which they were filed, were already in use either generally or in particular commercial circles, to designate the kinds of merchandise for which the mark was intended or analogous kinds." The Patent Office indicates from time to time in its official journal marks to which it attributes this character and has in preparation a general list of them. The decisions of the Patent Office in this regard are binding on the courts.

<sup>4</sup>Letters and numerals are excluded even if they are in little known languages, as Chinese or Hebrew. But characters drawn from obsolete languages (hieroglyphics, expressions from savage tribes) would probably be registrable.

Letters and numerals presented in distinctive form are registrable.

<sup>5</sup>The new law admits marks consisting in invented names, which were excluded by the law of 1874, and protects not only combinations of them and their distinctive appearance, but even their sound.

<sup>6</sup>This text permits the use as marks of the arms of localities in foreign countries. It is for the Patent Office to decide whether a mark comprises forbidden coats of arms. As to foreign marks, see section 23, last paragraph.

Nevertheless, any one may use such arms as marks if duly authorized to do so by one who has the right.

<sup>7</sup>The Patent Office requires proof of the correctness of the statements included in the mark (date of establishment, medals, appointment as purveyor to a court, etc.). It is well to avoid the mention of facts of only temporary significance (patent, design patent). (See also sections 1, 2, and 23, which give other grounds for refusal of registration.)

the owner of the earlier mark. If within a month he shall make no opposition to the registry of the new declared mark, it may be registered. In the contrary case the office shall determine whether there is an actual conflict.

The omission of the notice contemplated in the preceding paragraph shall not constitute claim for indemnity.

SEC. 6. If the decision (sec. 5, par. 1) be that there is no conflict between the marks, the new declared one may be registered. If the decision be that conflict exists, registration shall be refused in case the declarant shall desire to establish his right to registry notwithstanding the conflict, he must do so by action against the opposing party. Registry effected by virtue of a decision in his favor shall be effective as of the date of his original declaration.<sup>1</sup>

SEC. 7. The rights resulting from the declaration or registry of a merchandise mark pass by inheritance, and can be transmitted to other persons by testamentary disposition. They cannot however pass to others but with the business to which the mark appertains.<sup>2</sup> The transfer shall be entered on the Roll of Marks at the instance of the successor, provided the assent of the original owner is satisfactorily established. If the original owner is deceased the successor must establish his title.

The new owner cannot benefit by the rights accruing from registration until the transfer has been recorded in the Roll of Marks.

Decisions and judgments of the Patent Office which require to be notified to the proprietor of a mark must be addressed to the proprietor of record. If he is deceased the Patent Office may, at its discretion, consider the notice as given, or cause search to be made for the heirs, in order to notify them.

SEC. 8. A mark can be canceled from the Roll at any time on the demand of the owner.

Cancellation will take place by Office action, first, when ten years shall have expired since the declaration or renewal of the mark; second, when the registration should have been refused.

When there is a question of cancellation without the request of the owner, the Office shall give him notice. If he does not reply within a month the mark shall be canceled.<sup>3</sup> If he replies the question shall be decided by the Office. If such cancellation is under consideration by reason of expiration of the term of ten years, it will not take place, if within one month from the notice, the owner of the mark shall renew it by the payment of 10 marks in addition to the renewal fee, when the renewal shall be regarded as having taken place at the expiration of the preceding term.

<sup>1</sup> The action brought in such cases can not be taken on the question of similarity of marks, there being no appeal from the decision of the patent office on this question. One ought then to base it on all the rights that the applicant can establish against his opponent.

<sup>2</sup> A change of proprietorship does not necessitate a transfer of the mark if the name of the establishment is unchanged.

A general agent does not have the power to bring an action for counterfeiting a mark. It is otherwise with one who has a concession of sale of an article within a certain territory.

The transfer of the mark takes effect from the date of the contract and not from the date of the registration.

<sup>3</sup> Even if, in the interval, the patent office becomes satisfied of the insufficiency of the reason alleged as the ground for cancellation.



SEC. 9. A third party may demand the canceling of a merchandise-mark, first, if by virtue of a prior declaration the mark has been registered in his name for similar merchandise in the Roll of Marks or in the registers of marks kept under the law of November 30, 1874; second, if the enterprise to which it appertains has not been maintained by the owner of record; third, if facts establish that the contents of the mark do not agree with actual conditions, and are liable to mislead.<sup>1</sup>

When a mark, excluded from registry under the law of November 30, 1874,<sup>2</sup> has been considered in commercial circles up to the enactment of this law as the distinctive sign of the merchandise of a particular concern, and this mark has been entered in the Roll of Marks in the name of another person under this law, the owner of said concern shall have until October 1, 1895, to demand its cancellation. If the demand is granted the mark may be registered in the Roll in the name of the applicant before the expiration of the period fixed by section 4.

The demand for cancellation is to be made in the form of an action at law<sup>3</sup> against the record owner, or against his heirs if he is deceased.

If, before or after the beginning of the action, the mark has been assigned the decision shall be effectually operative as regards the assignee. The provisions of sections 63-66 and 73 of the Code of Civil Procedure apply to the right of the assignee to intervene in the suit. In the second case contemplated in the first paragraph of this section, the demand for cancellation may be addressed in the first place to the Patent Office, which shall give notice thereof to the person registered as proprietor. If he makes no opposition in one month the mark shall be canceled. If he makes opposition, the applicant may prosecute his demand for cancellation by an action at law.

SEC. 10. Declarations, assignments for record, and objections to cancellation, will be dispatched by a summons and a decision, as in the procedure concerning patents. In the case contemplated in section 5 there will be no summons.

An appeal is open to the applicant from a rejection of his application, and also to the owner of a mark from a decree of cancellation in the face of his protest. These appeals are to be filed in the Patent Office within a month of notice.<sup>4</sup>

Notifications concerning registry, assignment or cancellation of marks shall be given by registered letter. If notification can not be given in Germany, it shall be sent by mail as provided in sections 161 and 175 of the Code of Civil Procedure.

SEC. 11. The Patent Office shall give opinions upon questions concerning registered merchandise marks on request of the courts, when the inquiry relates to a legal proceeding in which experts differ.

SEC. 12. The effect of registration of a mark shall be to confer on the registrant the exclusive right to affix the mark to merchandise of

<sup>1</sup> Action may be taken in such case even if the facts are not evident at first view. (See sec. 4 above.)

<sup>2</sup> Two classes of marks come under this head: First, those which were excluded on account of their nature (invented words, for example); second, those whose owners were not enrolled on the commercial register.

<sup>3</sup> This action is carried on before the *Amtsgericht* if the amount involved does not exceed 300 marks; if the amount involved is greater, before the commercial chamber of the *Landgericht*.

<sup>4</sup> The ground of the appeal need not be explained. It may be based on grounds other than those given in the application for cancellation. The period within which appeal may be taken begins with the day of the notice and terminates with the corresponding day of the following month. When this day falls on a holiday the period is extended to the following day.



the species named in the declaration, or to its wrappers or envelopes; to put on the market goods so marked; and to employ the mark on advertisements, price lists, business letters, press notices, invoices, and analogous matter.<sup>1</sup>

In case of cancellation no right shall be inferred from registration for the period during which the cause of cancellation existed.

SEC. 13. Registration of a mark shall not prevent any person from employing, even in an abridged form, on his goods or on their inclosure, his name, firm name, or residence, nor indications concerning the mode, time or place of manufacture, or the quality, destination, price, quantity or weight of the goods, nor from making use of similar indications in trade.

SEC. 14. If any person shall knowingly or by gross carelessness illegally apply to his goods or their inclosures, or to his advertisements, business letters, price lists, and the like, the name or firm name of another or a mark protected under the present law, or shall put in circulation or on sale merchandise thus illegally marked, he shall be bound to indemnify the injured party.<sup>2</sup> If he shall commit this act knowingly he shall be further punished by a fine of 50 to 5,000 marks, or imprisonment not exceeding six months. Penal action shall not proceed but on complaint, and it may be withdrawn.<sup>3</sup>

SEC. 15. If any one with the intent to cause deception in commerce, shall without authority use upon goods, or their inclosures, or on advertisements, price-lists, business letters, press notices, invoices, etc., a device considered in commercial circles as the distinctive sign of another person's similar merchandise; or if any one with the same intent, shall put in circulation or offer for sale goods so marked, he

<sup>1</sup> The law of 1874 assigned all these effects to the *deposit* of the mark; the new law attributes them to the *registration*. The date of the deposit is then of importance only as determining priority in case of interference.

<sup>2</sup> The different actions which may be taken by the owner of a mark are as follows:

First. To apply for its cancellation (sec. 9).

Second. To establish judicially that the adverse party has no right to the mark (sec. 12).

Third. Action to restrain acts contrary to his right (*actio negatoria*) (sec. 12). This should be directed against the person who is actually responsible. The extent of the trouble caused or the purpose of the person responsible are of little importance so far as this action is concerned.

Fourth. Action for damages (secs. 14 and 15).

Fifth. Criminal prosecution (secs. 14 and 15).

Sixth. Seizure and confiscation of foreign products imported or in transit (sec. 17).

Seventh. Application for indemnity (*Busse*) (sec. 18).

The protection of the law extends even to acts committed abroad with reference to a mark registered in Germany, provided the jurisdiction of a German court can be established. (Reichsg., October 10, 1886; crim., March 18, 1884.)

It is unlawful to affix a mark, without the authority of the person entitled thereto, in Germany, on goods intended exclusively for sale abroad, even if the consignee in the foreign country has the right to that mark there. (Reichsg. crim., March 18, 1884.)

As concerns the personal or commercial name, protection is given only to the form used in Germany; a transposition in another language (Loewenthal and Lovendal) is not considered illegal. (Reichsg., May 27, 1889.) A name is protected even if it has not been entered on the register of commerce, provided it can be justified on the ground of prolonged exclusive use. It makes little difference if the name usurped is used on goods of a class different from those of the proprietor of the name.

The fact of emptying receptacles (for example, bottles of cognac) into a common receptacle (in order to avoid a higher rate of duty) and afterwards refilling these receptacles with the same product constitutes a case of counterfeiting. (Reichsg. crim., December 17, 1892.)

<sup>3</sup> A simple attempt not successfully carried out is not punishable.

shall be bound to indemnify the injured party, and shall be liable to a fine of from 100 to 3,000 marks, or imprisonment not exceeding three months. Penal action shall only take place on a complaint, and it may be withdrawn by the plaintiff.<sup>1</sup>

SEC. 16. Any one who, with intent to cause deception as to the quality or value of goods, shall have falsely affixed thereto, or to their wrappers or envelopes, or used in his advertisements, price-lists, business letters, press-notices, invoices, etc., the arms of a State,<sup>2</sup> or the name or arms of a locality, community or more extended communal union, and any one who with the same object shall have put in circulation or offered for sale goods so marked, shall be liable to a fine of from 50 to 5,000 marks, or imprisonment not exceeding six months.

The employment of names, which by the usages of trade serve to designate certain goods without indicating their origin, does not come within the scope of this provision.

SEC. 17. Foreign goods unlawfully marked with the name of a German firm<sup>3</sup> or place<sup>4</sup> or with a merchandise mark registered in the Roll of Marks, shall be liable to seizure and confiscation upon entry into Germany for importation or transit, on the demand of the injured party, who shall give security. Seizure may be effected by the officers of custom and revenue.<sup>5</sup> Confiscation shall be adjudged by a penal decision of the executive authority, (sec. 459, Code of Penal Procedure).<sup>6</sup>

SEC. 18. In lieu of the damages contemplated in this law, on the demand of the injured party, there may be awarded in excess of the penalty an indemnity (*Busse*) to be paid to him not exceeding 10,000 marks. Persons condemned to pay this indemnity are held for it jointly. The allowance of this indemnity excludes all other claims for damages.<sup>7</sup>

SEC. 19. On a condemnation under sections 14, 15, 16, or 18, the judgment shall order the illegal mark effaced from all articles in possession of the condemned.<sup>8</sup> If it cannot be otherwise done, the destruction of the goods may be ordered.

In case of a penal condemnation there shall be accorded to the injured party in the cases contemplated in sections 14 and 15 the privilege of publishing the judgment at cost of the convicted party. The judgment shall determine the nature of the publication and the period within which it shall be made.

SEC. 20. The application of the provisions of this law shall not be prevented by any modifications that may be employed in the reproduc-

<sup>1</sup> This provision permits of protecting packages and other distinctive features which can not be registered as marks (bottles, baskets, boxes, envelopes, etc.). At the same time, in case of conflict between a registered mark and a special external appearance given to a product, the latter can not in any case be protected as against the mark.

<sup>2</sup> The name of a State is not forbidden to be used by the text of the law, because it indicates nearly always the kind and not the origin of the goods.

<sup>3</sup> Is the personal name of a manufacturer forbidden as well as his commercial name (firma)? The law does not state, although a statement of the grounds speaks of the personal name as well as of the commercial name.

<sup>4</sup> This expression should be taken in the sense of locality and not of country or region.

<sup>5</sup> These authorities are authorized to proceed officially to make provisional seizure in case of doubt.

<sup>6</sup> Subject to appeal to the local tribunal having jurisdiction (*Amtsgericht*).

<sup>7</sup> The demand for an indemnity (*Busse*) may be withdrawn, provided judgment has not been pronounced and a civil action for damages and interest substituted.

<sup>8</sup> It matters little whether he is the owner of these articles or not; but articles which have passed into the hands of third parties are not subject to this provision.



tion of foreign names, firms, marks, arms, and any other distinctive signs of merchandise, if, in spite of such modifications, the possibility of mistake is not avoided.<sup>1</sup>

SEC. 21. In civil suits in which by complaint or rejoinder a claim is made founded on the provisions of this law the hearing and final decision shall be referred to the Imperial Court under section 8 of the introductory act to the judicature law.<sup>2</sup>

SEC. 22. Whenever German goods introduced into a foreign country either as imported or in transit, shall be required to be marked to show their German origin, or shall be treated less favorably by officers of customs than the goods of any other country in respect to the marks they are required to bear, the Federal Council is empowered to impose a corresponding charge upon foreign goods on importation into Germany or introduced for transit, and it may ordain the seizure and confiscation of the goods in case of contravention. Seizure shall be made by the customs and revenue officers. Confiscation shall be adjudged by a penal decision of the executive authorities, (sec. 459, Code of Penal Procedure.)

SEC. 23. A person not having an establishment in Germany can have a claim to the protection of this law only when according to a publication in the *Reichs-Gesetz-Blatt*, the State in which his establishment is situated accords to German merchandise marks protection to the same extent as to domestic marks.

The protection of a merchandise mark and the rights resulting from registry can be claimed only through the medium of a proxy residing in the country. Such proxy shall have power to represent his principal in the procedure before the Patent Office under this law, as well as in civil actions concerning the mark; he shall also be empowered to institute penal actions. Either the court within whose protection the proxy is domiciled or that of the place where the Patent Office is situated is competent to try suits against the registered owner of a mark.

Any one who shall make declaration of a foreign mark, will have to show at the same time that he has applied for and obtained legal protection for it in the State where his establishment is situated. Unless otherwise provided in international conventions, registration cannot take place if the mark does not satisfy the requirements of this law.<sup>3</sup>

<sup>1</sup> The settled practice of the courts forbids all imitation capable of producing confusion in the mind of the consumer. A mark is protected ipso facto in all colors; on the other hand, color is an essential element when the imitation of the external appearance given to a product is in question.

<sup>2</sup> Up to 300 marks these matters are within the jurisdiction of the *Amtsgerichte*, otherwise they are considered by the chambers of commerce of the *Landgerichte*.

<sup>3</sup> Compare section 12 of the patent law of April 7, 1891. The former law protected only traders having their principal establishments in Germany; the new law does not refer to any obligation of an establishment, and from this it may be held that a person not a trader or a trader who has only an unimportant branch establishment in the country may have the benefit of the law. But there is difference of opinion on this point.

The application of this article possibly presents some difficulties as regards countries with which Germany had, prior to 1894, concluded treaties of reciprocity. Protection is assured by a publication of September 22, 1894, to the following countries: Austria-Hungary, Belgium, Brazil, Bulgaria, Denmark, France, Greece, Great Britain, Italy, Luxemburg, Netherlands, Roumania, Russia, Serbia, Sweden and Norway, Switzerland, United States, and Venezuela.

The new law protects marks during the period fixed by section 8 without regard to the protection in the country of origin. The foreign mark must fulfil the conditions fixed by the German law.



SEC. 24. The provisions of the law of November 30, 1874, for the protection of marks, shall up to October 1, 1898, continue applicable to merchandise marks registered in conformity with said law. At any time up to October 1, 1898, these marks may be declared for registry in the Roll of Marks as provided in this law, and shall be subject to all its provisions. Registry cannot be refused to marks inserted in the Registry of Marks under an ancient provincial law. The registration shall be made without expense and as of the date of the first declaration. With respect to the contents of the first registration a certificate must be produced from the authority formerly presiding over registration.

Protection hitherto assured to merchandise marks shall expire when registry has been effected on the Roll of Marks, or, in default of registry, on October 1, 1898.

SEC. 25. Necessary rules for the execution of this law in matters concerning the organization and conduct of business at the Patent Office, as well as the procedure to be followed therein, shall be established by an imperial ordinance with the assent of the Federal Council.

SEC. 26. This law shall go into force the 1st of October, 1894.

From that date declarations of merchandise marks will no longer be accepted under the law of November 30, 1874, for the protection of marks.

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#### REQUIREMENTS OF THE PATENT OFFICE RESPECTING THE DECLARATION OF MERCHANDISE MARKS.

[Translated for this report by Mr. Greeley from *La Propriété Industrielle*, June 30, 1899.]

(November 22, 1898.)

SEC. 1. The declaration of a merchandise mark must be made in the form of a written petition to which the necessary documents should be joined as annexes.

Each mark must be made the subject of a special petition.

SEC. 2. The petition must be presented in single copy and must contain:

(a) A statement of the name and domicile or the location of the principal establishment of the person declaring the mark;

(b) A statement of the kind of commerce in which the mark is to be used;

(c) A petition asking that the mark be registered in the roll of marks;

(d) A statement setting forth that the legal fee of 30 marks has been paid to the treasury of the Patent Office of the Empire or that it will be paid upon filing the declaration;

(e) A list of the annexes, with a statement of their numerals and their contents;

(f) If the person declaring the mark has appointed a representative, a statement of the name, business and domicile of such representative; a power of attorney must be filed as an annex;

(g) The signature of the person declaring the mark or of his representative.

SEC. 3. The petition must be accompanied by twelve specimens or fac-similes of the mark. Two of these must be pasted separately on half sheets of paper bearing a cancel.

The specimens should be executed neatly and so as to be durable and the essential features of the mark must be clearly recognizable. If the fac-simile of the mark is modified during the prosecution of the case, it will be necessary before registration to file new specimens or to state that the print obtained from the typographical block is to be taken as constituting the fac-simile of the mark.

The size of the fac-simile must not exceed 33 cm. in height and 25 cm. in width. Fac-similes of larger size, such as posters and other like objects are treated as samples. In such case, it is necessary either to file fac-similes reduced to a small scale, or to state that the print obtained from the typographical block is to be taken as constituting the fac-simile of the mark.

The fac-simile of the mark must be executed on paper printed on one side only.

In case of marks which consist of words only, for the fac-simile of the mark may be substituted a statement, in the petition, of the word in question, together with a statement that the print obtained from the typographical block is to be taken as constituting the fac-simile of the mark.

SEC. 4. The petition must be accompanied by a list in duplicate of the goods for which the mark is intended. If this list is not long, it may be included in the petition.

This list must include the names of only such goods as are usual in the commercial circles interested.

SEC. 5. If the person declaring the mark deems it necessary, or if the Patent Office requires it, a description of the mark in duplicate should be joined to the petition.

SEC. 6. In the case above provided for, it is necessary to show models and specimens of goods bearing the mark, or reproductions of the mark in the form in which it is used in commerce, and this in one example only. Objects of such nature as to be easily broken must be filed in substantial packings. Objects of small size must be placed on stiff paper.

SEC. 7. On the filing of the petition, or on notice given thereafter to the person who declares the mark, the latter must file a typographical block (cliché) intended for use in printing the mark typographically, which must reproduce neatly and distinctly all its essential features including written matter. It is necessary to file a typographical block even in case of marks composed entirely of words.

The typographical block (cliché) must consist of a wood cut, or a zinc plate or electrotype and have a thickness of 2.4 cm.

Its dimensions must not exceed 6.5 cm. in height or width. In exceptional cases if the Patent Office considers it necessary for clearness of reproduction, it may be permitted to be of larger dimensions.

The typographical block must in any case be in a single piece.

If a mark is to be registered several times, a special block must be furnished for each registration.

If it is expressly asked, the Patent Office will undertake to make the block or to reproduce an existing block, at the expense of the person who declares the mark.

The block filed should be accompanied by two specimens of the print of the mark obtained from it.

SEC. 8. The objects annexed to the petition and especially the models, specimens and reproductions and the typographical block should bear an indication showing to what petition they belong.

The written documents intended to be communicated to other persons should be furnished in sufficient number of copies.

For all written documents substantial white, opaque paper should be used; those which contain requests or relate to the declaration itself must be on sheets 33 cm. by 21 cm.

All documents must be perfectly legible. They must be written in ink of good color. Typewritten documents must be printed in clear characters with sufficient spaces between the letters, the words and the lines.

The documents relating to the declaration which are filed later must bear the name of the person who declares the mark and the number of the case to which they relate.

#### INFORMATION.

By a publication of this date the Patent Office of the Empire has prescribed, for carrying out the provisions of section 2, paragraph 2, of the law for the protection of merchandise marks of May 12, 1894, new requirements concerning the filing of merchandise marks. As supplementing these requirements, the Patent Office publishes the following statements which will give interested parties fuller information for effecting the filing of declarations of merchandise marks.

##### 1. FEES.

The filing fee should be paid directly to the treasury of the Patent Office of the Empire (Berlin, N. W., Luisenstrasse, 32-34,) or should be sent there by postal order with a precise statement of the declaration to which the payment relates.

It is not desirable that the money should be sent with the declaration as an annex. But if it is so sent, the petition should indicate this fact clearly in red ink. If a remittance includes the money for several declarations, there should be joined to it a special statement showing the purpose for which the money is sent.

##### 2. PETITION.

(a) If the petitioner intends to avail himself of rights flowing from a previous declaration effected in a country with which the German Empire has concluded a treaty on the subject, he should expressly so state in the petition.

(b) The personality of the person who declares the mark must be so stated that there can be no doubt as to whether the registration of the mark is asked by an individual or a company, by a man or a woman, in a personal name or in the name of a commercial firm. If the matter concerns individuals the given name should be stated and in addition for women their status and their maiden names.

The statement of domicile should include in cities; the name of the street and the house number; for smaller places, for those the name of which is often found, and as a rule for foreign localities; the name of the country and the district. This applies also to cases in which the person declaring the mark has appointed a representative.

(c) In case the person declaring the mark has appointed a representative, it should be noted that under the terms of section 8 of the Imperial ordinance of July 30, 1894, the power of attorney must be given to a person capable of entering an appearance and designated by personal name and not by a firm name,



The signature of the person declaring the mark to the power of attorney must be legalized if the Patent Office expressly requires it.

(d) When several persons jointly make a declaration without appointing a common representative, they must indicate to which one of them official communications should be sent.

### 3. MODELS AND SPECIMENS.

In filing models and specimens, it should be stated, in cases in which the administration may dispense with these objects, whether they should be returned or may be destroyed.

If the models or specimens are of special value, this should be stated in the letter accompanying them. If they are liable to be damaged by carelessness in unpacking, or injured by exposure to light, to dampness, &c., a clearly legible statement should be placed on the package "to be used in the case without opening."

### 4. IN GENERAL.

(a) In all written documents the unnecessary use of foreign words should be avoided.

(b) Documents of several pages should be paged. In all documents there should be at the left a margin of at least 5 cm. for official notes.

(c) In all correspondence which includes annexes the latter should be specially enumerated.

(d) Communications to the Patent Office should reach it without expense. In sending money or packages the postage should be prepaid by the sender.

(e) One can not, as a rule, obtain receipts except for the declarations of marks and only one copy of these is sent. The sending of receipts is conditional on the furnishing, by the sender, of a paper substantially as follows:

Your declaration of ————

Or,

The declaration of ———— of the date of ———— respecting the following merchandise mark:

[Fac-simile of the mark.]

was received by the undersigned office on the ———— and has been applied to the prosecution of case No. ————.

If the receipt is not placed on the back of a postal card, it should be accompanied by an addressed envelope.

(f) A receipt for the amount of the fees sent by mail will be given only in case the sender expressly requests it.

## CHAPTER XXIII.

### TRADEMARK LAW OF FRANCE, WITH NOTES THEREON.

#### LAW RESPECTING MARKS OF MANUFACTURE AND COMMERCE.

(June 23, 1857.)

[Text and notes translated for this report by Mr. Greeley from *Recueil Général de la législation, etc.*, published by the International Bureau of Industrial Property.]

#### TITLE I.—*Of the right of property in marks.*

ART. 1. The use of marks of manufacture or commerce is optional. Nevertheless, decrees, enacted in the form of regulations of public order, may in exceptional cases declare marks obligatory for products specified by them.

The following are considered marks of manufacture and commerce, names in a distinctive form, designating terms (*dénominations*,) symbols, impressions, stamps, seals, vignettes, reliefs, letters, figures, wrappers, and all other signs serving to distinguish the products of a factory or objects of commerce.<sup>1</sup>

ART. 2. No one may claim exclusive property in a mark, if he has not deposited for registration two specimens of the mark with the clerk of the tribunal of commerce of his domicile.<sup>2</sup>

<sup>1</sup>It has been judicially settled that the enumeration of Art. 1 is purely inclusive, and that while it mentions the signs most commonly used, it does not exclude others. Broadly stated, any sign, provided that it is distinctive, whatever may be its nature, may be a mark.

It has been decided, for example, that the form of the wrapper of a product, as well as its color, or any other special characteristic, may serve as a mark if the same sign has not already been made use of in the same kind of industry or commerce. (V. Cass. Cir. April 30, 1899, *Prop. Indust.* 89, p. 143.)

<sup>2</sup>To take this article literally, it would seem that the property resulted solely from depositing the mark for registration. This is not its meaning. It is well understood from the discussion of the law, and from a jurisprudence that has never hesitated to so hold, that the depositing for registration is simply declarative and not attributive of property in the mark. The depositing for registration has for its purpose to warn others of the right claimed in the mark and place them in the position of acting in bad faith if they usurp it, and of laying a foundation for the penalties provided by the law. The usurpation of a mark which has been regularly deposited for registration is a penal offense; the usurpation of a mark which has not been deposited for registration is only an act of unfair competition—that is to say, a civil offense or a quasi offense.

The filing for registration, in another sense, while it does not create the property in the mark, preserves it and is sufficient in and of itself to preserve it without any obligation on the part of its proprietor to actually make use of it or to place it on goods. The filing for registration gives him the right to use the mark when and as he may choose, it being left to the courts to decide from the circumstances of the case whether, as a question of fact, he has forfeited the benefit of such filing. (V. Cass. Cir., December 1, 1890, *Prop. Indust.*, 1891, p. 152.)

As to the formalities required in depositing for registration, these have been modified by the law of May 3, 1890 (v. *infra*, p. 368), which particularly requires that

ART. 3. The effect of depositing for registration continues in force for fifteen years only.

The property right in the mark may always be preserved for an additional term of fifteen years by means of a new depositing for registration.<sup>1</sup>

ART. 4. There is required a fee of one franc for drawing up the statement of registration of each mark and for the cost of the duplicate not including the cost of the stamp and of registration.

## TITLE II.—*Provisions relative to foreigners.*

ART. 5. Foreigners who have in France establishments of manufacture or commerce may enjoy, for the products of their establishments, the benefits of the present law, by complying with its requirements.<sup>2</sup>

ART. 6. Foreigners and French citizens whose establishments are located out of France shall have an equal right to the benefits of the present law, for the products of their establishments, if in the country in which they are located, reciprocity for French marks has been established by diplomatic conventions.<sup>3</sup>

In such case foreign marks must be deposited for registration with the clerk of the tribunal of commerce of the Department of the Seine.<sup>4</sup>

three specimens be filed instead of two and that a typographical block (cliché) of the mark be filed.

The Government may be a manufacturer (the monopolies of tobacco and matches establish this fact); it can therefore deposit a mark for registration as if it were a private individual, in the same form, and may claim in the same way an exclusive right therein.

<sup>1</sup>Acts of usurpation which take place between the expiration of a first registration and its renewal are, as we have stated in the preceding note, acts of unfair competition only. It is therefore important for the protection of the property in the mark that the proprietor take care to renew his registration before its expiration. It is clear that the law permits, as is reasonable, the perpetuity of the property in the mark.

<sup>2</sup>The law makes a distinction between foreigners who have an establishment on French territory and those who have not. The former, without any condition of reciprocity, are admitted to the privileges of French citizens; the latter can not claim these privileges unless in their country reciprocity is accorded to French citizens. French citizens, when their establishments are located in a foreign country, are treated as foreigners of the country in which their establishments are located. Thus the law makes no distinction between French citizens and foreigners.

Article 6 requires that reciprocity be established by a diplomatic convention; but this is modified by article 9 of the law of November 26, 1873 (v. *infra*, p. —), which declares that reciprocity may be established by law as well as by a treaty.

<sup>3</sup>See note 2 under article 5.

<sup>4</sup>By making use of the expression "foreign marks" (*les marques étrangères*) the law clearly points out that what it is intended to protect for the person whose establishment is located in a foreign country is the mark which he then has protection for and in the same form in which it is then protected. It must be understood that the foreigner or the French citizen who is in the same position with a foreigner as regards his mark is given even more right in France than in the country where he conducts his manufacture or his commerce. (V. Paris, May 18, 1892, *Prop. Indust.* 93, p. 48. V. also *rej. Cass.*, May 21, 1874, *Ann.* 74, 173; Paris, August 19, 1881, *Ann.* 81, 289; *rej. Cass.* January 17, 1885, *Ann.* 86, 53; *trib. cir. Nancy*, July 16, 1890, *Prop. Indust.* 93, p. 148.)

Unless he has deposited his mark for registration with the clerk of the tribunal of commerce of the Seine, the foreigner has no right to claim the benefit of the law of 1857 (V. Aix, February 7, 1889, *Prop. Indust.* 90, p. 28), but it is certain that he has always time to make this deposit for registration and to prosecute, by virtue of such deposit, acts of usurpation which take place thereafter, if he has not otherwise lost the property right in his mark.

A statistical statement prepared by the international bureau (V. *Prop. Indust.*, 93, p. 128) shows that in the year 1892 out of 6,255 marks deposited for registration in France 216 only belonged to manufacturers located out of France.



TITLE III.—*Penalties.*

ART. 7. The following persons shall be punished by a fine of 50 to 3000 francs and imprisonment from three months to three years or by one of these penalties only:

1st. Those who have counterfeited a mark or made use of a counterfeit mark.

2nd. Those who have with fraudulent intent affixed to their products or the articles in which they trade a mark which belongs to another.

3rd. Those who have knowingly sold or offered for sale one or more articles bearing a counterfeit mark or one affixed with fraudulent intent.<sup>1</sup>

ART. 8. The following shall be punished by a fine of 50 to 2,000 francs and imprisonment of from one month to one year, or by one of these penalties only:

1st. Those who without counterfeiting a mark have with fraudulent intent made an imitation of it of such nature as to deceive the purchaser, or have made use of a mark imitated with fraudulent intent.<sup>2</sup>

2nd. Those who have made use of a mark bearing indications calculated to deceive the purchaser as to the nature of the product.<sup>3</sup>

Third. Those who have knowingly sold or offered for sale one or more products bearing a mark imitated with fraudulent intent or bearing indications calculated to deceive the purchaser as to the nature of the product.

<sup>1</sup>Counterfeiting refers to direct and complete reproduction of the mark; when the mark is not servilely copied but is imitated only, it is still an offense and is punishable under the following article. It is also to be said that when a mark consists in a word, the fact that the person who usurps it adds other signs does not prevent this being considered counterfeiting in the sense of article 7. It is judicially settled, after comparison of the text of articles 7 and 8, that counterfeiting is punishable, even if the counterfeiter shows that he acted in good faith; the offense is an infraction of the law in any case. Whoever reproduces a mark, especially printers of labels, is bound to first make such investigation as may be necessary to determine whether it has been registered. (V. Cass. Civ., January 16, 1889, *Prop. Indust.*, 90, p. 9.)

<sup>2</sup>The author of the law thus explains article 8:

"Persons do not counterfeit a mark, they imitate it. If the marks consist of letters, they take other letters, but preserve the same general forms; if it consists of the appearance of the package, by the use of colors they simulate differences; or when they use the same word that is used by a manufacturer they add in a form more or less noticeable the words 'made by.' These frauds are innumerable and they are effected in a thousand ways; but the courts know how to recognize them and they have the power to effectually put a stop to them. Article 8 punishes, in a word, those who, without counterfeiting a mark, have made a fraudulent imitation of it of such a nature as to deceive the purchaser or have made use of a mark imitated with fraudulent intent." The imitation punished by article 8 includes every imitation which by its resemblance, by its general appearance, is of a nature to create confusion and to lead the purchaser into error. (V. Pouillet *Marq. de fab.*, Nos. 181 et seq.; V. also Donai, July 19, 1887, *Prop. Indust.*, 1888, p. 27; trib. cass., Seine, November 29, 1889, *Prop. Indust.*, 90, p. 91, comp. trib. cass., Lille, July 11, 1887, *Prop. Indust.*, 88, p. 16.)

<sup>3</sup>It is to be understood (V. Pouillet *Marq. de fab.*, No. 361, Mayer, *de la Concurrency déloyale*, No. 133) that in this paragraph the word mark is used in a general sense and that all indications, borne by products, when they are of a nature to deceive the purchaser as to the nature of the product constitute the offense provided for and punished by paragraph 2 of article 8. This does not refer to a technical trademark which has been registered. This article, according to the author of the law himself, has with it only a resemblance in words; it has for its purpose to complete article 423 of the penal code and to assure the repression of deceit or attempt to deceive, provided for by that article, when it is effected by the aid of a mark whether registered or not. (V. cass. crim., January 21, 1892, *Prop. Indust.*, 93, p. 10.)

ART. 9. The following shall be punished by a fine of 50 to 1,000 francs and imprisonment from fifteen days to six months, or by one of these penalties only:

First. Those who have failed to place on their products a mark which has been declared obligatory.

Second. Those who have sold or offered for sale one or more products not bearing the mark declared obligatory for this kind of products.

Third. Those who have contravened the provisions of decrees made in execution of article 1 of the present law.

ART. 10. The penalties provided by the present law shall not be cumulative.

The extreme penalty is inflicted only for all the facts anterior to the first prosecution.

ART. 11. The penalties provided for in articles 7, 8, and 9 may be doubled in case of a repeated offense.

The offense is a repeated one when within five years preceding sentence has been pronounced against the accused for an offense provided for by the present law.

ART. 12. Article 463 of the penal code may be applied to offenses provided for by the present law.

ART. 13. Offenders may, in addition, be deprived of the right to participate in elections of tribunals and chambers of commerce, advisory chambers of arts and manufactures, and councils of prud'hommes, for a period not to exceed ten years.

The tribunal may order the judgment to be posted in such places as it may determine and its insertion in whole or in extract in newspapers which it may designate, all at the expense of the offender.<sup>1</sup>

ART. 14. Confiscation of the products bearing marks which are decided to be contrary to the provisions of articles 7 and 8 may, even in case of acquittal, be ordered by the tribunal as well as of instruments and utensils specially intended to be used in committing such offense.

The tribunal may order that the products confiscated be turned over to the proprietor of the mark which has been contemplated or fraudulently affixed or imitated independently of other damages that may be awarded.

It shall order in all cases the destruction of marks decided to be contrary to the provisions of articles 7 and 8.<sup>2</sup>

ART. 15. In the case provided for by the first two paragraphs of article 9, the tribunal shall always order that the marks declared

<sup>1</sup> The posting of the judgment is considered not as a punishment, but as a civil reparation, and so considered the civil tribunals do not hesitate to order it. The code of civil procedure, as to this matter, contains an article (art. 1036) which gives the tribunals the right to order the printing and posting of their judgments.

<sup>2</sup> Confiscation is not obligatory on the court as in case of patents; it is, on the contrary, optional. But it is the duty of the judge, even if he does not believe it his duty to decree the confiscation of the products bearing the counterfeit mark, to order in all cases the destruction of the counterfeit mark. Notwithstanding the obligatory character of this provision, it has been held that the party who has not asked the application of this measure before the inferior court can not complain before the court of cassation if this destruction has not been ordered. (V. rej. cass., April 13, 1877, 78, 1, 439.)

In subjecting to confiscation the instruments and utensils specially intended to be used to commit the offense, the law does not intend to include printing material—the press, for instance—but the lithographic stone, the engraved plate, the stamps, seals, molds, etc., bearing the counterfeit mark and capable of reproducing it.

obligatory shall be placed on the products to which they are made applicable.

The tribunal may order the confiscation of the goods, if the offender has, within the five preceding years, been convicted of any offense provided for by the first two paragraphs of article 9.

#### TITLE IV.—*Jurisdiction.*

ART. 16. Civil actions respecting marks are prosecuted before the civil tribunals and are determined by the courts.<sup>1</sup>

In case of an action brought under criminal procedure, if the offender raises in his defense questions which concern the right of property in the mark, the tribunal of police for the trial of his misdemeanors decides upon this pleading.

ART. 17. The proprietor of a mark may cause to be made by any officer of the law (*huissier*), with or without seizure of the goods, an inventory of the goods which he claims are marked in contravention to the provisions of the present law, under an order of the president of the civil tribunal of first instance, or of a justice of the peace of the canton, if there is no tribunal in the place where he finds the goods which are to be inventoried or seized.

This order is issued upon request and on presentation of the written statement establishing the registration of the mark. In it should be named, if the case requires it, an expert to aid the officer in his inventory.

When seizure of the goods is asked, the judge may require of the applicant a bond to be recorded before making the seizure.

There must be furnished to the persons in possession of the goods inventoried or seized a copy of the order and of the record of the filing of the bond, in default of which the whole proceedings may be void and the officer may be liable for damages.

ART. 18. If the applicant fails to make such provision, either according to the civil or the criminal procedure, within a period of fifteen days, increased by one day for each 50 kilometers of distance between the place where the goods inventoried or seized are found and the domicile of the party against whom the proceeding must be brought, the inventory or seizure is wholly void, without prejudice to the damages which may be received, if the case calls for it.

#### TITLE V.—*General and temporary provisions.*

ART. 19. All foreign products bearing the mark or the name of a manufacturer located in France, or an indication of the name or location of a French manufacturing establishment, are forbidden to be imported and excluded from right of transit or of warehouse, and may

<sup>1</sup> A foreigner, admitted under article 6 to the benefit of the law, may bring a foreigner before the French courts for the purpose of securing an order canceling a mark which interferes with his; the law of June 23, 1857, must, in effect, be considered a law according to all those entitled to invoke it protection against infractions of its provisions committed in France; and, the registration of foreign marks being effected with the clerk of the tribunal of commerce of the Seine, it follows from article 16 not only that the French tribunals have the power to take cognizance of such action, but also that the action must be brought before the civil tribunal of the Seine. (Paris, August 2, 1893, *Prop. Indust.*, 93, p. 160.)



be seized either at the instance of the administration of customs or at the request of the public prosecutor or of the injured party.<sup>1</sup>

In case the seizure is made at the instance of the administration of customs, the papers relating to the seizure shall be sent at once to the public prosecutor.

The period within which the action provided for by article 18 must be brought under penalty of the seizure being null and void, whether brought by the injured party or by the public prosecutor, is limited to two months.

The provisions of article 14 are applicable to goods seized under the provisions of the present article.<sup>2</sup>

ART. 20. All the provisions of the present law are applicable to wines, brandies, and other beverages, to animals, grains, flour, and generally to all agricultural products.<sup>3</sup>

ART. 21. All registration of marks effected through the clerk of the tribunal of commerce prior to the present law shall continue in force for fifteen years, to date from the day on which the said law takes effect.

ART. 22. The present law shall not take effect until six months after its promulgation. The administration of public affairs shall determine by regulation the formalities to be complied with for the registration and publication of marks, and all other measures necessary for carrying the law into effect.

ART. 23. Provisions heretofore in force are not repealed except so far as they are contrary to the present law.

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**LAW OF MAY 3, 1890, MODIFYING ARTICLE 2 OF THE LAW OF JUNE 23, 1857,  
RESPECTING MARKS OF MANUFACTURE AND COMMERCE.**

Article 2 of the law of June 23, 1857, respecting marks of manufacture and commerce, is modified as follows:

No one shall claim exclusive property in a mark if he has not deposited for registration with the clerk of the tribunal of commerce of his domicile:

First. Three specimens of a representation of the mark.

Second. A typographical block (cliché) of the mark.

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<sup>1</sup>The question has arisen whether article 19 was applicable to the case where, by the order of a manufacturer located in French territory, his mark, his name, or the indication of his manufacturing establishment had been affixed to goods manufactured for him and by his order in a foreign country. The judicial decisions on the question have varied. After having held that in this case there was no contravention of the law (V. Paris, November 6, 1863, Ann. 63, 353; Rouen, January 29, 1864, Ann. 64, 71; rej. cass., April 9, 1864, Ann. 64, 256; *Circul. Minist.* of June 8, 1864), the courts have decided the question in precisely the opposite way. (V. rej. cass., February 28, 1884, Ann. 84, 208; Lyons, July 1, 1885, Ann. 88, 93; Besançon, April 2, 1887, Ann. 88, 95; *Circul. Minist.* of February 26, 1886, *Prop. Indust.*, 86, p. 37.)

<sup>2</sup>Article 19 does not seem to provide any remedy for the acts which it has in view other than that of confiscation. Nevertheless, Pouillet (v. *Marq. de fab.*, No. 325) expresses the opinion that to import into France goods bearing a false mark is in reality to make use of the mark and renders one liable to the penalties provided by articles 7 and 8.

<sup>3</sup>The law has in view here all natural products; it takes in wines, brandies, and other beverages which are in reality manufactured products, and does not speak of mineral waters, which, because they are not included under agricultural products, are none the less capable of being protected like all other articles of trade by a mark.

In case of the deposit for registration of a plurality of marks belonging to the same individual, but one statement need be made, but there must be filed as many representations in triplicate and as many typographical blocks as there are distinct marks.

One of the specimens filed will be returned to the applicant bearing the indorsement of the clerk, together with an indication of the day and hour of its filing.

The dimensions of the typographical blocks must not exceed 12 centimeters each way.

The typographical blocks will be returned to the interested parties after the official publication of the marks by the Department of Commerce, Manufacture, and Colonies.<sup>1</sup>

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**DECREE CONTAINING REGULATIONS OF THE ADMINISTRATION OF PUBLIC AFFAIRS FOR THE EXECUTION OF THE LAW OF JUNE 23, 1857, MODIFIED BY THAT OF MAY 3, 1890, RESPECTING MARKS OF MANUFACTURE AND COMMERCE.**

(February 28, 1891.)

ART. 1. The deposit for registration which manufacturers, traders, or agriculturists may make of their marks with the clerk of the tribunal of their domicile, or, if there is no tribunal of commerce there, with the clerk of the civil tribunal, in order to secure the rights resulting from the law of June 23, 1857, is subject to the following provisions:

ART. 2. The deposit for registration may be effected by the interested party, or by his attorney under a special power of attorney.

The power of attorney may be under private seal, but it must be entered on the register; it must be left with the clerk.

ARR. 3. The applicant must furnish in triplicate, on unstamped paper, a representation of the mark which it is desired to register.

This representation consists of a drawing, engraving, or print executed in such manner as to show the mark with clearness and without change.

The paper on which the representation is drawn or pasted must be in the form of a square 18 centimeters each way; the mark must be so placed in the center as to leave the spaces necessary to write in the statements hereinafter referred to.

ARR. 4. If the mark consists in a single symbol, or a combination of symbols used together, the representation of which is of a size too large to place on a sheet of paper of 18 centimeters each way, the representation may be either reduced to the necessary scale or divided into several parts which may be traced or pasted on several sheets of paper of 18 centimeters each way.

If the mark is of small dimensions, the representations may show it enlarged.

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<sup>1</sup> The law of May 3, 1890, was followed on February 28, 1891, by a decree setting forth the rules of the administration of public affairs for its execution. This decree sets forth all the details material to the deposit for registration as required by the law of May 3, 1890, modifying in this respect the organic law of June 23, 1857. This decree explains itself. The official publication of marks, to which the last paragraph of the law refers, is made in the *Bulletin Officiel de la Propriété Industrielle*, which was established in 1884, in compliance with a requirement of the Convention of the Union of March 20, 1883.

ART. 5. If the mark is sunken into or in relief on the goods, if it needs to be reduced in size so as not to exceed the prescribed dimensions, if it has been enlarged, or if it presents any other peculiarity in respect to its representation, or the manner in which it is used on the goods for which it is intended, the person who deposits it for registration must indicate such peculiarity on the three specimens, either by using one or more figures or by means of an explanatory statement.

Such indications are placed on the left of the paper on which the mark is drawn or pasted. The right is reserved for the statements required by articles 10 and 11.

The specimens filed should not contain any other indication.

ART. 6. The clerk will ascertain whether the three specimens conform to the provisions above set forth.

If the three specimens are not upon paper of the proper dimensions or contain indications forbidden by article 5, the clerk will return them to the applicant to be corrected or to be replaced, and will not prepare the statement of deposit for registration required on the deposit of three specimens in regular form.

The clerk will proceed in the same way:

If the three specimens are not alike.

If the representation of the mark is not firmly secured to the paper to which it is applied.

If the representation is drawn in pencil.

If the representation is in metal, in wax, or is in relief of such a nature as to damage the register on which the specimens are pasted.

If the typographical block (cliché) is not deposited with the three specimens of the mark.

ART. 7. The typographical block (cliché) which the applicant furnishes with the three specimens of the mark must not exceed 12 centimeters each way; it must be in metal and must conform to typographical blocks usually employed in printing from type.

If the mark consists of a band of a length greater than 12 centimeters or in a combination of symbols, the band may be divided into several parts, which shall be reproduced on the same typographical block, one under the other, or there may be furnished a single block showing the combination on a reduced scale.

The person depositing the mark for registration shall place on the side of the block his name and address.

ART. 8. The clerk must apply on the three specimens of the representation of the mark the stamp of the tribunal. When the representation of the mark is not drawn on the paper, but is only pasted thereon, the clerk must so apply the stamp that it shall be partly on the representation of the mark and partly on the paper.

ART. 9. The clerk will paste one of the three specimens on a leaf of the register which he keeps for this purpose; the representations of the marks are placed on the register one after the other in the order of their presentation. The register is furnished by the clerk; it must be of unstamped paper, 24 centimeters wide by 40 centimeters high. The register is numbered and initialed by the president of the tribunal of commerce or the civil tribunal, as the case may be.

ART. 10. The clerk then draws up on a stamped register, numbered and initialed as the register above mentioned, the statement of the deposit for registration in the order of presentation. It shows, first, the



day and the hour of the deposit for registration; second, the name of the proprietor of the mark, and, if the case requires, the name of his representative; third, the business of the proprietor, his domicile, and the kind of industry or commerce in which he intends to use the mark. The clerk also gives to each statement a number. He places the number on each of the three specimens as well as the name, the domicile, and the business of the proprietor of the mark and if the case requires it of his representative, the date, the hour, and the place of deposit and the kind of industry or commerce for which the mark is intended. The statement and the representations of the mark are signed by the clerk and the person depositing them or his representative.

ART. 11. When the deposit is made for the purpose of preserving the right, for a new period of fifteen years, to a mark already registered, this circumstance should be noted on the statement of the deposit for registration, as well as on the three specimens of the representation of the mark.

ART. 12. The clerk must be paid, besides the fee fixed at 1 franc for the statement of the deposit for registration, including the cost of forwarding, the cost of the stamp and the registration.

The same manufacturer or merchant may effect the deposit for registration of a number of marks by a single statement, but the clerk must be paid as many times the fee fixed at 1 franc as there are marks deposited.

ART. 13. In case a copy of the statement is asked for afterwards by any one it should be given on payment of a fee of 1 franc and the cost of the stamp.

ART. 14. One of the three specimens, together with the typographical block of each mark, should be forwarded within five days from the date of the statement to the Ministry of Commerce.

The specimens forwarded to the Ministry of Commerce remain there to be communicated to the public without expense.

ART. 15. Foreigners and French citizens, whose establishments are located out of France and who can register their trademarks in France under either article 6 of the law of June 23, 1857, or article 9 of the law of November 26, 1873, concerning the establishment of a special stamp or sign to be placed on trademarks, are permitted to deposit their marks for registration only with the office of the clerk of the tribunal of commerce of the department of the Seine.

ART. 16. When a registrant intends to abandon the use of his trademark, he should make a declaration of such intention in the clerk's office of the tribunal where the mark was deposited. The clerk will enter this declaration on the margin of the statement of deposit for registration and will give notice thereof at once to the Minister of Commerce who will publish it in the *Bulletin Officiel de la Propriété Industrielle et Commerciale*.

ART. 17. At the beginning of each year the clerk will prepare, on unstamped paper and in the form prescribed by the Minister of Commerce, a report of the marks deposited with him during the preceding year.

The clerk is authorized to furnish to the person depositing the mark certificates of identity of his mark on payment of the fee of 1 franc fixed by article 8 of the decree of June 18, 1880.

ART. 18. The registers, statements, and reports deposited in the clerk's offices are communicated without charge.

ART. 19. Trademarks deposited for registration are published, after they are received at the Ministry of Commerce, in the *Bulletin Officiel de la Propriété Industrielle et Commerciale*.

ART. 20. The decree of July 26, 1858, is, and remains, repealed.

ART. 21. The Minister of Commerce, of Industries, and of the Colonies is charged with the execution of the present decree, which shall be inserted in the *Bulletin des Lois* and published in the *Journal Officiel* of the French Republic.

## CHAPTER XXIV.

### LAWS OF CERTAIN FOREIGN COUNTRIES WHICH REQUIRE REGISTRATION AS A CONDITION PRECEDENT TO SECURING FULL PROTECTION FOR TRADEMARKS.

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#### SECTION 1.

##### ARGENTINE REPUBLIC.

(Law of August 14, 1876.)

ART. 12. Any one who desires to secure the ownership of manufacturing or commercial trademarks must make application therefor at the patent office.

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#### SECTION 2.

##### AUSTRIA.

(Law of January 6, 1890.)

ART. 2. Any person wishing to secure the exclusive right to use a mark must obtain the registration of the same conformably with the regulations of the following section.

The same provision is found in the law of February 4, 1890, of Hungary. (Art. 2.)

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#### SECTION 3.

##### BELGIUM.

(Law of April 1, 1879.)

ART. 2. No one shall lay claim to any right to use of a mark if he has not filed a specimen in triplicate, and a typographic block of the mark with the clerk of the tribunal of commerce in the district in which his establishment is located.

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#### SECTION 4.

##### BRAZIL.

(Law of October 14, 1887.)

ART. 3. In order to secure the exclusive use of said marks, their registry, deposit, and publication according to this law are indispensable.



SECTION 5.

**BULGARIA.**

(Law of December 15-27, 1892.)

ART. 6. Whoever shall desire to reserve to himself the exclusive use of a mark must make a formal application in conformity with the following rules \* \* \*

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SECTION 6.

**CANADA.**

(Trademark and Design Act, 42 V., c 22; Revised Statutes, 1886.)

19. No person shall institute any proceeding to prevent the infringement of any trademark, unless such trademark is registered in pursuance of this act.

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SECTION 7.

**CHILI.**

(Law of November 12, 1874.)

ART. 5. Whoever secures the registration of a mark of manufacture or of commerce secures an exclusive property therein.

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SECTION 8.

**CONGO FREE STATE.**

(Law of April 26, 1888.)

ART. 2. No one shall lay claim to the exclusive use of a mark if he has not filed specimens in triplicate, together with a typographical block of his mark in the department of foreign affairs.

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SECTION 9.

**DENMARK.**

(Law of April 11, 1890.)

ART. 1. Any person who carries on within the Kingdom manufactures, agriculture, mining, commerce, or industry, in addition to the right which he already has of using as a trademark his personal or commercial name or the name of any real property belonging to him, may acquire, by registration, in accordance with the formalities prescribed by the present law, an exclusive right to make use of a special mark in order to distinguish on the market his goods from those of others.

The same provision is found in the law of May 26, 1884, of Norway (art. 1), and the law of July 5, 1884, of Sweden. (Art. 1.)

## SECTION 10.

## FINLAND.

(Law of February 11, 1889.)

SEC. 1. Whoever manufactures or sells products in Finland has the right to acquire, by registration conformably to the following requirements, the exclusive right to make use of a special mark for the purpose of distinguishing, in general commerce, his products from those of others.

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## SECTION 11.

## FRANCE.

(Law of June 23, 1857.)

ART. 2. No one may claim exclusive property in a mark if he has not deposited for registration two specimens of the mark with the clerk of the tribunal of commerce of his domicile.

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## SECTION 12.

## GERMANY.

(Law of May 12, 1894.)

SEC. 12. The effect of registration of a mark shall be to confer on the registrant the exclusive right to affix the mark to merchandise of the kind named in the declaration, or to its wrappers or envelopes; to put on the market goods so marked, and to employ the mark in advertisements, price lists, business letters, press notices, invoices, and the like.

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## SECTION 13.

## GREAT BRITAIN.

(Patent, Designs, and Trademarks Act, 1883, as amended December 24, 1888.)

75. Application for registration of a trademark shall be deemed to be equivalent to public use of the trademark, and the date of the application shall for the purposes of this act be deemed to be, and as from the first day of January, one thousand eight hundred and seventy-six, to have been the date of the registration.

76. The registration of a person as proprietor of a trademark shall be prima facie evidence of his right to the exclusive use of the trademark, and shall after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trademark, subject to the provisions of this act.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trademark unless, in the case of a trademark capable of being registered under this act,

it has been registered in pursuance of this act, or of an act repealed by this act, or in the case of any other trademark in use before the thirteenth of August, one thousand eight hundred and seventy-five, registration thereof under this act or of an enactment repealed by this act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Substantially the same provisions are found in the law of May 22, 1888, of Jamaica (secs. 17-19); the law of September 2, 1889, of New Zealand (secs. 82-84); the law of October 13, 1884, of Queensland (secs. 74-76); the law of December 17, 1892, of South Australia (secs. 19-21); the law of September 29, 1893, of Tasmania (secs. 83-85); the law of December 19, 1890, of Victoria (secs. 19-21), and the law of August 27, 1884, of Western Australia (secs. 31-33).

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#### SECTION 14.

##### GREECE.

(Law of January 16, 1893.)

ART. II. \* \* \* No one shall have the legal right to protection in the exclusive use of a mark unless he shall have deposited three copies of it and one typographical cut at the office of the civil tribunal of first instance of the district where he has his principal establishment, or in default of that, an establishment and his domicile.

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#### SECTION 15.

##### ITALY.

(Law of August 30, 1868.)

ART. 1. Whoever adopts a mark or other sign to distinguish the products of his industry, the goods in which he trades or animals of a breed belonging to him, shall have the exclusive use thereof, provided he files it as prescribed by the present law.

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#### SECTION 16.

##### JAPAN.

(Law of March 1, 1899.)

ART. 1. Any person desiring to have the exclusive use of the trademark designating his goods shall obtain registration therefor under this act.



## SECTION 17.

**LUXEMBURG.**

(Law of March 28, 1883.)

ART. 2. No one can lay claim to the exclusive use of a mark if he has not deposited a specimen in duplicate and a typographical block in the hands of the officer designated by the Government.

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## SECTION 18.

**MEXICO.**

(Law of November 28, 1889.)

ART. V. In order to acquire the exclusive property in a trademark the party in interest must apply by himself or his representative to the Department of Public Works, stating that he reserves to himself all rights, accompanying the application with the following documents: etc.

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## SECTION 19.

**NEW SOUTH WALES.**

(Law of May 26, 1865.)

2. Marks in order to have any legal effect must be registered.

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## SECTION 20.

**ORANGE FREE STATE.**

(Law of June 9, 1891.)

ART. 1. The comptroller of public documents shall keep in the registration office a register of manufacturers' marks and their proprietors, conformably to the provisions of the present act; from and after the date at which it takes effect no one shall be authorized to prosecute judicially the infringement of a manufacturer's mark, such as is provided for by the present act, or to demand damages for such infringement, unless such mark has been registered conformably to the provisions of this act.

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## SECTION 21.

**PORTUGAL.**

(Law of May 21, 1896.)

ART. 6. In order that a mark may be considered an exclusive property it is essential that it shall have been registered.

## SECTION 22.

## ROUMANIA.

(Law of April 15-27, 1879.)

ART. 7. Persons desiring to claim the exclusive property in a trademark are required to deposit two copies of the form of said trademark with the Register of the Tribunal of Commerce in their domicile.

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## SECTION 23.

## RUSSIA.

(Law of February 26-March 9, 1896.)

ART. 4. The manufacturer or merchant who desires to secure the right to the exclusive use of a merchandise mark (art. 1) must file it in the Department of Commerce and Manufactures, and receive a certificate (art. 10) on paying the prescribed fee.

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## SECTION 24.

## SERBIA.

(Law of May 30-June 11, 1884.)

ART. 2. Anyone who wishes to secure the right to the exclusive use of a mark must register it in conformity with provisions of Title II of this law.

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## SECTION 25.

## SWITZERLAND.

(Law of September 26, 1890.)

ART. 4. The right to the use of a mark can not be claimed before the courts except after the fulfillment of the formalities of filing and registration prescribed by articles 12 to 15 hereinafter.

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## SECTION 26.

## TURKEY.

(Law of May 10, 1888.)

ART. 3. Before having the right to bring an action for counterfeiting a mark, the lawful owner of it must file two specimens of it in accordance with the requirements of chapter 2 hereinafter, with the ministry

of commerce or the ministry of justice at Constantinople and with the counsel bureau of the government or with the clerk of the court of appeal in the provinces.

NOTE.—The above extracts are taken from the trademark laws of Argentine Republic, Austria, Brazil, Bulgaria, Germany, Great Britain, Greece, Mexico, Roumania, and Serbia, as published in the Official Gazette of the United States Patent Office; from an official copy of the trademark law of Canada; from the trademark law of Portugal, as published in a supplement to Carpmael's Patent Laws of the World; from the French translation of the trademark laws of Belgium, Chile, Congo Free State, Denmark, Finland, Italy, Luxemburg, New South Wales, Orange Free State, Russia, Switzerland, and Turkey, as published by the International Bureau of Industrial Property at Berne in *Recueil Général de la législation, etc.* (translations), and from a translation of the Trademark Law of Japan.



## CHAPTER XXV.

### LEGISLATION AND PROPOSED LEGISLATION IN THE UNITED STATES CONCERNING TRADEMARKS, AS SHOWN BY THE CONGRESSIONAL GLOBE AND CONGRESSIONAL RECORD FROM THE THIRTY-SIXTH CONGRESS TO THE FIFTY-FIFTH CONGRESS.

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#### THIRTY-SIXTH CONGRESS.

A single trademark bill was introduced in the House in this Congress. It is the first trademark bill of which we find any mention in the Congressional Globe.

H. R. 330.—A bill to prevent and punish fraud in the use of false stamps, brands, labels, or trademarks. Introduced by Hon. James K. Moorhead, of Pennsylvania, March 13, 1860. Referred to Committee on Commerce. Reported favorably. Referred to the Committee of the Whole on the state of the Union. Not reported.

[House of Representatives, first session, March 13, 1860, Cong. Globe, vol. 51, p. 1131.]

#### FALSE TRADEMARKS, ETC.

Mr. MOORHEAD. I ask the unanimous consent of the House to introduce a bill to prevent and punish fraud in the use of false stamps, brands, labels, or trademarks; of which notice was given yesterday.

Mr. GROW. I object and call for the regular order of business, which is the call of committee for reports.

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[House of Representatives, first session, March 14, 1860, Cong. Globe, vol. 51, p. 1147.]

#### FALSE TRADEMARKS, ETC.

Mr. Moorhead, by unanimous consent and in pursuance of previous notice, introduced a bill to prevent and punish fraud in the use of false stamps, brands, labels, or trademarks; which was read a first and second time and referred to the Committee on Commerce.

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[House of Representatives, first session, May 18, 1860, Cong. Globe, vol. 52, p. 2186.]

#### FALSE STAMPS, ETC.

Mr. Moorhead, from the same committee [Commerce] reported back, with a recommendation that it do pass, a bill (H. R. 330) to prevent and punish frauds in the use of false stamps, brands, labels, and trademarks; which was referred to the Committee of the Whole on the state of the Union, and ordered to be printed.

[House of Representatives, second session, January 25, 1861, Cong. Globe, vol. 54, p. 561.]

## FRAUDS ON TRADEMARKS.

Mr. MOORHEAD. I ask the unanimous consent of the House that the Committee of the Whole on the state of the Union be discharged from the further consideration of House bill No. 330, and that it be put upon its passage. It is a bill to punish frauds on trademarks.

Mr. PHELPS. That is not a private bill. It is a public one.

Mr. BRANCH. I would ask the gentleman from Pennsylvania if he has been instructed by the Committee on Commerce to make that motion.

Mr. MOORHEAD. No, sir.

Mr. BRANCH. Then it is not in order on the call of committees for reports, and I object to it.

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[House of Representatives, second session, January 31, 1861, Cong. Globe, vol. 54, p. 670.]

## FALSE STAMPS, ETC.

Mr. MOORHEAD. I ask the unanimous consent of the House to have House bill No. 330 taken up and acted on. It is a public bill in which the constituents of every gentleman are interested; and I hope there will be no objection.

The bill, being a bill to prevent and punish fraud in the use of false stamps, molds, dies, brands, labels, or trademarks, was read for information.

Mr. NOELL. The General Government has nothing to do with the punishment of that crime; and I shall object to taking up the bill.

Mr. MOORHEAD. The gentleman's constituents have petitioned very largely for that bill.

Mr. NOELL. I would have no objection to it if the General Government had any power over the subject.

Mr. MOORHEAD. It is necessary for the security of commerce.

Mr. McKNIGHT. I appeal to the gentleman to withdraw his objection.

Mr. NOELL. I insist upon my objection.

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[House of Representatives, second session, February 7, 1861, Cong. Globe, vol. 54, p. 798.]

## FALSE STAMPS, ETC.

Mr. MOORHEAD. I ask the unanimous consent of the House that the Committee of the Whole on the state of the Union be discharged from the further consideration of House bill No. 330 to prevent and punish frauds in the use of false stamps, brands, labels, or trademarks, in order that it may be put on its passage.

Mr. BURNETT. Congress has no power to legislate for the States on that subject. I object.

Mr. MOORHEAD. Other gentlemen who thought so have, after examination, withdrawn their opposition.

Mr. BURNETT. I can not withdraw my objection until the form of our Government is changed.

## THIRTY-SEVENTH CONGRESS.

H. R.—A bill to prevent and punish fraud in the use of false stamps, molds, dies, brands, labels, and trademarks. Introduced by Hon. James K. Moorhead, of Pennsylvania, January 20, 1862. Referred to the Committee on the Judiciary. Not reported.

[House of Representatives, second session, January 20, 1862, Cong. Globe, vol. 57, p. 399.]

## FRAUDS IN TRADEMARKS, ETC.

Mr. Moorhead introduced a bill to prevent and punish fraud in the use of false stamps, molds, dies, brands, labels, or trademarks; which was read a first and second time, and referred to the Committee on the Judiciary.

## THIRTY-NINTH CONGRESS.

H. R.—A bill to prevent and punish fraud in the use of false stamps, brands, labels, and trademarks. Introduced by Hon. James K. Moorhead, of Pennsylvania, January 19, 1867. Referred to the Committee on Patents. Not reported.

[House of Representatives, second session, January 19, 1867, Cong. Globe, vol. 74, p. 593.]

## TRADEMARKS.

Mr. Moorhead, by unanimous consent, introduced a bill relating to trademarks; which was read a first and second time, and referred to the Committee on Patents.

## FORTY-FIRST CONGRESS.

Four trademark bills were introduced in the Senate and two in the House of Representatives in this Congress.

S. 264.—A bill to execute the provisions of a certain treaty between the United States and His Majesty the Emperor of all the Russias. Introduced by Hon. Lyman Trumbull, of Illinois, of the Committee on the Judiciary, April 7, 1869. Indefinitely postponed.

[Senate, first session, April 7, 1869, Cong. Globe, vol. 87, p. 573.]

Mr. Trumbull, from the Committee on Judiciary, reported a bill (S. 264) to execute the provisions of a certain treaty between the United States and His Majesty the Emperor of all the Russias, concluded on the 27th day of January, A. D. 1868; which was read and passed to a second reading.

S. 265.—A bill to prevent the counterfeiting of foreign trademarks protected by treaty stipulations. Introduced by Hon. Charles Sumner, of Massachusetts, of the Committee on Foreign Relations, April 7, 1869. Passed by the Senate. Referred to the House Committee on Commerce. Not reported.

[Senate, first session, April 7, 1869, Cong. Globe, vol. 87, p. 573.]

Mr. Sumner, from the Committee on Foreign Relations, reported a bill (S. 265) to prevent the counterfeiting of foreign trademarks protected by treaty stipulations; which was read, and passed to a second reading.



[Senate, second session, April 22, 1870, Cong. Globe, vol. 91, p. 2894.]

FOREIGN TRADEMARKS.

The next bill on the Calendar was stated to be the bill (S. 264) to execute the provisions of a certain treaty between the United States and His Majesty the Emperor of all the Russias, concluded on January 27, A. D. 1868.

Mr. TRUMBULL. Let the bill be read. I do not remember it.

The Secretary read the bill.

Mr. TRUMBULL. By some mistake or misapprehension it seems that subject has been before the Committee on Foreign Relations and the Committee on the Judiciary both, and both committees have reported bills. The next bill, No. 265, is reported by the Committee on Foreign Relations on the same subject, and the Senator from Massachusetts thinks that is a better bill. I ask that that be read. We had better pass one of them.

The PRESIDING OFFICER. This bill will be regarded as objected to.

Mr. TRUMBULL. No; let the next bill be read. These two bills are on the same subject.

The Secretary read the bill (S. 265) to prevent the counterfeiting of foreign trademarks protected by treaty stipulations. It has a preamble reciting that treaties have been concluded between the United States and certain foreign powers, by which the contracting parties have mutually bound themselves to prevent their citizens or subjects from counterfeiting trademarks used by citizens or subjects of the other, and that other similar treaties are proposed. In order to carry into effect the stipulations which have been or may hereafter be made by the Government of the United States, it is proposed to enact that whenever any citizen or subject of a foreign power uses any trademark on merchandise to show its origin and quality, and has taken the steps prescribed by treaty to secure the right of property in such trademark, no person anywhere within the United States shall counterfeit the same. Whoever violates this provision, or knowingly sells or exposes for sale any article having such counterfeited trademark, is to be liable to the injured party in an action at law or equity, to be prosecuted in any court of the United States having jurisdiction thereof.

Mr. TRUMBULL. I am satisfied with the bill No. 265. It is a general bill and covers all treaties of this kind, whereas bill No. 264 is confined to the treaty with Russia. If this bill reported by the Committee on Foreign Relations will answer the purpose by giving an action of damages, I shall prefer it. I move, therefore, to postpone indefinitely Senate bill No. 264, with a view of passing bill No. 265.

Mr. CARPENTER. I wish to call the attention of the chairman of the Committee on the Judiciary and also the chairman of the Committee on Foreign Relations to the fact that the bill reported by the Committee on Foreign Relations seems to me to add nothing to the existing law. It simply says that whoever shall violate a trademark shall be liable to an action of damages. He is so without any statute. If any action whatever is needed on the part of Congress, it is to make the law more stringent than is the common law. If any man should use a trademark fraudulently that is a misdemeanor; that is obtaining money under false pretenses. It is not like the case of an infringement of a patent, which a man may do without knowledge that a

patent exists; but if a man violates the trademark of another man and puts it on goods to sell for the purpose of defrauding, that is a misdemeanor and should be so punished. The bill reported by the Committee on the Judiciary adds to the existing law, and I think the other bill does not.

Mr. WILLIAMS. I will inquire of the Senator if he is altogether certain whether a citizen of a foreign country can maintain his action at common law for damages for counterfeiting a foreign trademark in the United States?

Mr. CARPENTER. Counterfeiting a trademark of the United States? No.

Mr. WILLIAMS. A foreign trademark in the United States?

Mr. CARPENTER. Yes, undoubtedly.

Mr. SUMNER. Could he maintain it in the courts of the United States?

Mr. FOWLER. I object to this bill.

The PRESIDING OFFICER. The Senator from Tennessee objects to the further consideration of the bill, and it therefore lies over under the objection.

Mr. SUMNER. We had better pass one of these bills.

The VICE-PRESIDENT. The Senator from Tennessee objected to both bills.

Mr. FOWLER. I do not object if they can be passed without debate.

Mr. TRUMBULL. There will be no considerable debate. This is merely an explanation.

Mr. FOWLER. I withdraw the objection.

Mr. TRUMBULL. Some bill on this subject ought certainly to pass.

Mr. SUMNER. There are already three treaties, I will say, on this subject. We have ratified one with Russia, one with Belgium, and another with France; and the object of this statute is simply to carry into execution those treaties by providing remedies for the parties under them. The bill reported from the Committee on Foreign Relations simply gave the right of action on the idea that some statute power of that kind was needed to give the parties a remedy in the courts of the United States.

Mr. CARPENTER. Let me call the attention of the chairman of the committee to this fact: There are two classes of cases which may be brought in the Federal courts. One is brought there because it involves some right granted by Congress, and another is brought there on the citizenship or alienage of the party. A suit brought by the subject of any foreign nation is always capable of being brought in the Federal courts. At the common law, of course, every man can maintain his action for a violation of his trademark. He may go into chancery and enjoin the party upon it. That has been settled law for a great many years. If he be the subject of a foreign power, he comes, in virtue of that fact, into the Federal courts and there enforces all his common-law rights.

Mr. SUMNER. But will the national court—I choose to call it national rather than Federal, with the Senator's permission—

Mr. CARPENTER. You have my permission. [Laughter.]

Mr. SUMNER. Thank you for that. [Laughter.] Will the national courts recognize the common law?

Mr. TRUMBULL. Oh, yes.

Mr. CARPENTER. They can not help themselves.

Mr. SUMNER. The Senator from Illinois says, "Oh, yes." That is

a question which has been discussed greatly from the beginning of our Government. Now, a simple statute conferring this power on the courts supersedes that question.

Mr. EDMUNDS. I wish to say a word—

Mr. FERRY. It can not do any harm. Let us pass it.

Mr. EDMUNDS. My friend from Massachusetts is mistaken in supposing that there has ever been any difficulty in the national courts, as he properly characterizes them, about the power of the courts to enforce common-law rights, which are rights of property everywhere. The difficulty has been in punishing misdemeanors, because there could be no common-law misdemeanor against the United States, as the courts have held. Therefore I assure my friend that there is not the slightest difficulty in the United States courts in enforcing all common-law rights of property.

Mr. CARPENTER. They do it every day in repeated suits.

The bill (S. 265) was considered as in Committee of the Whole, and reported to the Senate without amendment.

Mr. TRUMBULL. Let me inquire of the Senator from Massachusetts whether he wants the preamble to the bill retained.

Mr. SUMNER. No; I do not.

Mr. TRUMBULL. I move to strike it out.

The motion was agreed to.

The bill was ordered to be engrossed for a third reading, was read the third time, and passed.

Mr. EDMUNDS. Have we disposed of the other bill of the same nature?

The VICE-PRESIDENT. Senate bill No. 264 will be regarded as indefinitely postponed if there be no objection.

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[House of Representatives, second session, April 23, 1870, Cong. Globe, vol. 91, p. 2931.]

A message from the Senate, by Mr. Gorham, its Secretary, \* \* \* announced that the Senate had passed \* \* \* bills of the following titles, in which the concurrence of the House was requested:

\* \* \* \* \*

An act (S. 265) to prevent the counterfeiting of foreign trademarks protected by treaty stipulations.

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[House of Representatives, second session, June 29, 1870, Cong. Globe, vol. 93, p. 4953.]

#### FOREIGN TRADEMARKS.

The next business on the Speaker's table was a bill (S. 265) to prevent the counterfeiting of foreign trademarks protected by treaty stipulations.

Mr. PAINE. I object.

The bill was passed over.

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[House of Representatives, second session, July 14, 1870, Cong. Globe, vol. 93, p. 5594.]

#### COUNTERFEITING FOREIGN TRADEMARKS.

The next business on the Speaker's table was a bill (S. 265) to prevent the counterfeiting of foreign trademarks protected by treaty stipulations.

Mr. ALLISON. I object.



Mr. JENCKES. Let it be referred to the Committee on Patents.

Mr. VAN AUKEN. I object.

Mr. MAYNARD. I ask that it be referred to the Committee on Ways and Means.

Mr. VAN AUKEN. I object.

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[House of Representatives, third session, December 13, 1870, Cong. Globe, vol. 95, p. 89.]

#### COUNTERFEITING OF FOREIGN TRADEMARKS.

The next business on the Speaker's table was the bill (S. 265) to prevent the counterfeiting of foreign trademarks protected by treaty stipulations; which was read a first and second time, and on motion of Mr. Kelsey referred to the Committee on Commerce.

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S. 501.—A bill more effectually to provide for the execution of treaties for the protection of the owners of trademarks. Introduced by Hon. Lyman Trumbull, of Illinois, February 7, 1870. Referred to the Committee on the Judiciary. Indefinitely postponed.

[Senate, second session, February 7, 1870, Cong. Globe, vol. 89, p. 1076.]

Mr. Trumbull asked and by unanimous consent obtained, leave to introduce a bill (S. 501) more effectually to provide for the execution of treaties for the protection of the owners of trademarks; which was read twice by its title, referred to the Committee on the Judiciary, and ordered to be printed.

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[Senate, second session, April 18, 1870, Cong. Globe, vol. 90, p. 2738.]

Mr. Trumbull, from the same committee [Committee on the Judiciary], to whom was referred the bill (S. 501) more effectually to provide for the execution of treaties for the protection of the owners of trademarks, moved its indefinite postponement, there being a bill on the Calendar reported from the Committee on Foreign Relations upon the same subject.

The bill was indefinitely postponed.

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H. R. 1824.—A bill to prevent the importation from foreign countries of articles fabricated in imitation of and bearing the trademarks of articles of American manufacture. Introduced by Hon. Nathaniel P. Banks, of Massachusetts, April 19, 1870. Referred to the Committee on Ways and Means. Not reported.

[House of Representatives, second session, April 19, 1870, Cong. Globe, vol. 90, p. 2779.]

#### FOREIGN IMITATIONS OF TRADEMARKS.

Mr. Banks, by unanimous consent, introduced a bill (H. R. 1824) to prevent the importation from foreign countries of articles fabricated in imitation of and bearing the trademarks of articles of American manufacture; which was read a first and second time, referred to the Committee on Ways and Means, and ordered to be printed.

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S. 829.—A bill in relation to fraudulent trademarks upon foreign watches. Introduced by Hon. Justin S. Morrill of Vermont, April 21, 1870. Passed in Senate and House. Approved by President March 3, 1871. (16 U. S. Stat. L., p. 580, ch. 125.)

[Senate, second session, April 21, 1870, Cong. Globe, vol. 91, p. 2862.]

Mr. Morrill, of Vermont, asked and by unanimous consent obtained, leave to introduce a bill (S. 829) in relation to fraudulent trademarks upon foreign watches; which was read twice by its title, referred to the Committee on Finance, and ordered to be printed.

[Senate, second session, April 28, 1870, Cong. Globe, vol. 91, p. 3051.]

Mr. Morrill, of Vermont, from the Committee on Finance, to whom was referred a bill (S. 829) in relation to fraudulent trademarks upon foreign watches, reported it without amendment.

[Senate, second session, May 3, 1870, Cong. Globe, vol. 91, p. 3176.]

TRADEMARKS ON FOREIGN WATCHES.

The next bill on the calendar was the bill (S. 829) in relation to fraudulent trademarks upon foreign watches; which was considered as in Committee of the Whole. The bill provides that from and after the 1st of August next no foreign watches of gold, silver, or other metal, or watch movements, shall be admitted to entry at the custom-houses in the United States unless there shall be legibly and distinctly engraved or stamped upon the works or movements the maker's name or distinguishing trademark, and in connection therewith and as a part thereof the name of the place and country where manufactured; but existing trademarks of foreign manufacturers of watches need not be changed if they distinctly show that the watch movements are of foreign production. If any watches or watch movements of foreign manufacture shall be offered for entry at any custom-house in the United States which shall copy or simulate the name or trademark of any domestic manufacturer they are to be forfeited to the United States.

The Committee on Finance reported the bill with amendments. The first amendment was in section one, line four, after the word "watches" to strike out the words "of gold, silver, or other metal."

The amendment was agreed to.

The next amendment was in section one, line seven, after the words "stamped upon the," to insert the words "exposed surfaces of the plates or bridges of the."

The amendment was agreed to.

Mr. MORRILL, of Vermont. In section two, line two, after the words "watch movements," I move to add the words "or parts of watch movements."

The amendment was agreed to.

The bill was reported to the Senate as amended, and the amendments were concurred in. The bill was ordered to be engrossed for a third reading, was read the third time, and passed.

[House of Representatives, second session, May 4, 1870, Cong. Globe, vol. 91, p. 3227.]

A message from the Senate by Mr. Gorham, its secretary, announced that the Senate had passed bills of the following titles, in which the concurrence of the House was requested:

An act (S. 829) in relation to fraudulent trademarks upon foreign watches.

[House of Representatives, second session, June 24, 1870, Cong. Globe, vol. 93, p. 4803.]

FRAUDULENT TRADEMARKS.

On motion of Mr. Maynard, by unanimous consent, a bill (S. 829) in relation to fraudulent trademarks of foreign watches was taken from the Speaker's table, read a first and second time, and referred to the Committee of Ways and Means.

[House of Representatives, third session, March 3, 1871, Cong. Globe, vol. 97, p. 1926.]

## FRAUDULENT TRADEMARKS.

The SPEAKER. The Chair is informed that the chairman of the Committee of Ways and Means has some public business to report to the House; and if there be no objection, he will have leave to report.

Mr. BROOKS, of New York. I do not know of any business from the Committee of Ways and Means which it is necessary for us to consider at this time of the night. I reserve objection until I hear what the business is.

The SPEAKER. Of course the right to object is reserved until the business has been reported.

Mr. HOOPER, of Massachusetts. I am directed by the Committee of Ways and Means to report back Senate bill No. 829 in relation to fraudulent trademarks upon foreign watches, with a substitute.

Mr. RANDALL. I hope that we shall have both the bill and substitute read, so that we may understand them.

Mr. PETERS. What becomes of my resolution?

Mr. BROOKS, of Massachusetts. And the motion in reference to taking a recess?

The SPEAKER. They are both in abeyance for the present.

Mr. DAWES. I withdraw my motion to take a recess.

The Clerk read the bill. The first section provides that from and after the first day of August next no foreign watches or watch movements shall be admitted to entry at the custom-houses of the United States unless there shall be legibly and distinctly engraved or stamped upon the exposed surfaces of the plates or bridges of the works or movements the maker's name or distinguished trademark, and in connection therewith as a part thereof the name of the place and country where manufactured, provided that existing trademarks of foreign manufacturers of watches need not be changed if they distinctly show that the watch movements are of foreign production. The second section provides that if any watches or watch movements of foreign manufacture shall be offered for entry at any custom-house in the United States, which shall copy or simulate the name or trademark of any domestic manufacturer, the same shall be forfeited to the United States.

The SPEAKER. The gentleman from Massachusetts [Mr. Hooper] offers an amendment in the nature of a substitute, which will now be reported.

The substitute was read. It provides that from and after the first day of January, 1871, no watches, watch cases, or watch movements, or part of watch movements of foreign manufacture, which shall copy or simulate the trademark of any domestic manufacturer, shall be admitted to entry at the custom-houses of the United States, unless such domestic manufacturer is the importer of the same. In its second section it provides that domestic manufacturers of watches who have adopted trademarks may cause to be recorded in the Treasury of the United States, in a book to be kept for that purpose under such rules and regulations as may be prescribed by the Secretary of the Treasury, their names and residences and descriptions of trademarks, and furnish to the Secretary *facsimiles* of such trademarks; and it shall be the duty of the Secretary to transmit one or more copies of the same to each collector or other proper officer of the customs of



the United States, to be used by such officers in the execution of the first section of this act.

Mr. HOAR. I desire to ask if there is anything in the substitute which prevents the importation of foreign articles without any trademark or maker's name and putting on the fraudulent trademark in this country.

Mr. FARNSWORTH. You can not prevent that at the custom-house.

Mr. HOAR. The bill as it is drawn prohibits the importation of any foreign watch unless there is upon it, legibly, the name or trademark of the manufacturer. That protects the American manufacturer perfectly against fraud; the substitute does not.

Mr. FOX. Mr. Speaker, I rise to a point of order. Is this debatable?

The SPEAKER. It is not.

Mr. FOX. Then I object to debate.

Mr. FARNSWORTH. Will the gentleman from Massachusetts [Mr. Hooper] allow me to answer the interrogatory of his colleague [Mr. Hoar]?

Mr. FOX. I object to debate, and I ask that the bill be read. I believe that is my right.

The SPEAKER. It is not the gentleman's right, the bill having already been read. Is there objection to its being read again?

Several members objected.

The question was on suspending the rules and passing the bill as amended by the amendment in the nature of a substitute; and being taken, there were—ayes 86, noes 40.

So (two-thirds having voted in favor thereof) the rules were suspended and the bill, as amended, was passed.

[Senate, third session, March 3, 1871, Cong. Globe, vol. 97, p. 1994.]

#### TRADEMARKS ON FOREIGN WATCHES.

A message from the House of Representatives, by Mr. Clinton Lloyd, its chief clerk, announced that the House had passed the bill (S. 829) in relation to fraudulent trademarks upon foreign watches, with an amendment in which it requested the concurrence of the Senate.

Mr. MORRILL, of Vermont. I ask the Senate to consider now the amendment which has just come over from the House to a Senate bill.

By unanimous consent, the Senate proceeded to consider the amendment of the House of Representatives to the bill (S. 829) in relation to fraudulent trademarks upon foreign watches. The amendment was to strike out all of the original bill after the enacting clause, and to insert in lieu thereof the following:

That from and after the 1st day of April, 1871, no watches, watch cases, watch movements, or parts of watch movements of foreign manufacture which shall copy or simulate the name or trade mark of any domestic manufacturer shall be admitted to entry into the custom-houses of the United States, unless such domestic manufacturer is the importer of the same.

SEC. 2. That domestic manufacturers of watches who have adopted trade marks may cause to be recorded in the Treasury of the United States, in a book to be kept for that purpose, and under such rules and regulations as may be prescribed by the Secretary of the Treasury, their names, residences, and descriptions of trade marks, and furnish to the Secretary *facsimiles* of such trade marks; and it shall be the duty of the Secretary to transmit one or more copies of the same to each collector or other proper officer of the customs of the United States, to be used by such officers in the execution of the first section of this act.

Mr. MORRILL, of Vermont. I will merely say that this is a slight modification of the bill passed by the Senate, is not so sweeping in its provisions, and confines the confiscation to such watches as really imitate American trademarks.

The amendment was concurred in.

[House of Representatives, third session, March 3, 1871, Cong. Globe, vol. 97, p. 1934.]

#### MESSAGE FROM THE SENATE.

A message from the Senate, by Mr. Sympson, one of its clerks, informed the House that the Senate had agreed to the amendment of the House of Representatives to the bill (S. 829) in relation to fraudulent trademarks upon foreign watches.

[House of Representatives, third session, March 3, 1871, Cong. Globe, vol. 97, p. 1935.]

#### ENROLLED BILLS, ETC., SIGNED.

Mr. Beatty, from the Committee on Enrolled Bills, reported that the committee had examined and found truly enrolled bills of the following titles, when the Speaker signed the same:

\* \* \* \* \*

A bill (S. 829) in relation to fraudulent trademarks upon foreign watches.

[Senate, third session, March 3, 1871, Cong. Globe, vol. 97, p. 2002.]

#### MESSAGE FROM THE HOUSE.

A message from the House of Representatives, by Mr. Clinton Lloyd, its chief clerk, announced that the Speaker of the House had signed the following enrolled bills and joint resolutions; and they were thereupon signed by the Vice-President:

\* \* \* \* \*

A bill (S. 829) in relation to fraudulent trademarks upon foreign watches.

[Senate, third session, March 3, 1871, Cong. Globe, vol. 97, p. 2009.]

#### PRESIDENTIAL APPROVALS.

A message from the President of the United States, by Mr. Horace Porter, his secretary, announced that the President had this day approved and signed the following acts and joint resolutions:

\* \* \* \* \*

An act (S. 829) in relation to fraudulent trademarks upon foreign watches.

The act is as follows:

[Laws of the U. S., Forty-first Congress, chap. 125, approved March 3, 1871; 16 U. S. Stat. L., p. 580; Cong. Globe, vol. 97, Appendix, p. 394.]

AN ACT in relation to fraudulent trade marks upon foreign watches.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That from and after the 1st day of April, 1871, no watches, watch cases, watch movements, or parts of watch movements, of foreign manufacture, which shall copy or simulate the name or trade mark of any domestic manufacturer shall be admitted to entry at the custom-houses of the United States unless such domestic manufacturer is the importer of the same.*

SEC. 2. That domestic manufacturers of watches who have adopted trade marks may cause to be recorded in the Treasury of the United States, in a book to be kept for that purpose, under such rules and regulations as may be prescribed by the Secretary of the Treasury, their names, residences, and descriptions of trade marks, and furnish to the Secretary facsimiles of such trade marks; and it shall be the duty of the Secretary to transmit one or more copies of the same to each collector or other proper officer of the customs of the United States, to be used by such officers in the execution of the first section of this act.

H. R. 1714.—A bill to revise, consolidate, and amend the statutes relating to patents and copyrights. Sections 77–84 relate to trade marks. Introduced by Hon. Thomas A. Jenckes, of Rhode Island, from the Committee on Patents, April 7, 1870. Passed in House and Senate and approved by the President July 8, 1870. (16 U. S. Stat. L., p. 210, chap. 230.)

[House of Representatives, second session, April 7, 1870, Cong. Globe, vol. 90, p. 2502.]

Mr. Jenckes, by unanimous consent, from the Committee on Patents, reported a bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights; which was read a first and second time, ordered to be printed, and recommitted.

[House of Representatives, second session, April 13, 1870, Cong. Globe, vol. 90, p. 2650.]

Mr. Jenckes, by unanimous consent, from the Committee on Patents, reported back with amendments the bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights, and moved that the bill be recommitted, and, with the amendments, printed.

The motion was agreed to.

[House of Representatives, second session, April 14, 1870, Cong. Globe, vol. 90, p. 2679.]

#### PATENT AND COPYRIGHT LAWS.

Mr. Jenckes, from the Committee on Patents, reported back with amendments, and with the recommendation that it do pass, the bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights.

The following extract contains the introductory remarks of Mr. Jenckes upon the scope of the bill and the manner of its preparation.

[House of Representatives, second session, April 14, 1870, Cong. Globe, vol. 90, p. 2679.]

MR. JENCKES. Mr. Speaker, if the House will indulge me I think they will obtain a sufficient idea of what is proposed by this bill, from a statement in explanation of its provisions, without reading it in full.

The bill now reported from the Committee on Patents is based upon the revision of the laws relating to patents and copyrights made by the commissioners of revision appointed under the statute authorizing a revision of the laws of the United States. That revisal of these particular statutes was reported to this House early in this Congress and referred by the House to the Committee on the Revision of the Laws of the United States. It was examined by that committee and was found to embody all the provisions of existing law, in brief, clear, and precise language. They subsequently reported it to the House and recommended that it be referred to the Committee on Patents.

In prospect of this proposed revision the Committee on Patents had already received numerous communications from those interested in



the subject, and also numerous bills and petitions that had been filed in the House and referred to that committee, proposing various amendments to the existing laws. They had taken all these into consideration and invited the presence of persons interested in the different subjects to which the amendments were intended to apply, and encouraged discussion from those interested and from those learned in this branch of the laws upon those proposed amendments. They were heard at great length and the committee were very careful to give a hearing, either orally or by written communication, to any and every person who supposed that there were defects in the existing laws which ought to be remedied, or who could make plain and clear the practice under the laws so as to secure more perfectly the rights which these laws were intended to protect. The result of all these hearings and discussions has been the adoption by the committee of certain propositions of amendment to these laws, which they have embodied in the bill now before the House. \* \* \*

The remarks of Mr. Jenckes upon the provisions of the bill relating to trademarks were as follows:

[House of Representatives, second session, April 14, 1870, Cong. Globe, vol. 90, p. 2683.]

The committee have recommended also certain provisions which are entirely new concerning trademarks. These have not heretofore been the subject of any national law. It is a subject embraced within the common-law jurisdiction of all the courts of the country, and also within the general equity jurisdiction of all the State courts. This bill does not propose to interfere at all with the local and State jurisdictions. A person, standing upon his common-law rights, may still go into the State courts and defend a trademark exactly as he may do now; but if he chooses to register his claim at the Patent Office, pay his fee, and take his certificate of registration, it will protect him throughout the United States in the same way as a patent for a design or a copyright is protected.

Concerning trademarks, we are at present in an anomalous condition, which perhaps is not understood by the House generally. By certain treaties or conventions with Belgium, France, and Russia, we have agreed to recognize the validity of the trademarks of those countries upon their being registered in the Patent Office of the United States, and to give them the same effect throughout the United States that they have in the country where they originated; and trademarks recognized by the law of this country have the same effect throughout those European countries as the trademarks secured by the citizens or subjects of those countries. Thus by treaties, which are a part of the supreme law of the land, we have secured to subjects of those three nations rights which are not by national law secured to citizens of the United States. The rights which it is proposed to protect by registration of trademarks are not greater in any sense than those which are secured to citizens of foreign countries. In fact, these provisions are substantially those of the continental nations, and also those of the trademarks statute of Great Britain, with which country I believe we are also engaged in negotiations for a similar treaty. The desirableness of these provisions I have not heard questioned by anyone. I will state their effect.

A facsimile of the trademark is to be sent to the Patent Office. The kind of business, as well as the kind of goods, to be protected is to be

described briefly and correctly. A fee of \$25 is to be paid into the Treasury of the United States. A certificate of such registration, with a facsimile of what is filed in the office, is to be delivered, under the seal of the Patent Office, to the person causing such registration. It is to be in effect for thirty years from the date of registration, and if it be copied by a person not having a right to it, or if it be copied by a person in such manner that the imitation is calculated to deceive the public, then the party may have his remedy in any court of the United States for the injury done him.

It does not allow any person to register a trademark in the Patent Office who is not entitled to it at common law. It does not allow any man to take up any other man's trademark and by paying \$25 claim it for himself or his assigns. Nor does it allow him to imitate a trademark so nearly as to deceive the public. That is expressly prohibited. Nor does it allow any person to register a trademark for any substance or article injurious in itself, or to use a trademark on any article or in any kind of business calculated to deceive the public. All those things are specially prohibited, and thus guarded it seems to be a safe legislative provision.

[House of Representatives, second session, April 20, 1870, Cong. Globe, vol. 91, p. 2855.]

Mr. CLEVELAND. I have certain amendments which I desire to offer.

Mr. CLEVELAND. In section 79, line 3, I move to strike out the word "unless" and insert "except in cases where such trademark is claimed for and applied to articles not manufactured in this country, and in which;" so that the section will then read:

SEC. 79. Such trade-mark shall remain in force for thirty years from the date of such registration, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country and in which it received protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act, at the same time that it becomes of no effect elsewhere; and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods, etc.

Mr. STEVENS. I am willing to consider that amendment as pending.

Mr. CLEVELAND. I have another amendment to offer to the same section. Add the following proviso:

*Provided*, That six months prior to the expiration of said term of thirty years application may be made for a renewal of such registration, under regulations to be prescribed by the Commissioner of Patents; and the fee for such renewal shall be the same as for the original registration, and such trade-mark shall remain in force for a further term of thirty years: *Provided further*, That nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which said trade-mark was registered.

Mr. STEVENS. I do not object to the gentleman moving that amendment and having it pending before the House.

Mr. JENCKES. I hope the gentleman's amendment will be accepted.

Mr. CLEVELAND. Section 79 of this bill is in relation to trademarks. The Committee on Patents have very wisely, it seems to me, introduced new matter under the head of "trademarks."

Trademarks are very little understood in this or in any other country by other than the particular persons interested in the establishment of trademarks. Their value is really not generally appreciated by the community at large. It is only of late years that the courts have been inclined to construe liberally the common law under which the right is now claimed to establish trademarks upon manufactured articles. It is not very many years back—

Mr. STEVENS. How long time does the gentleman desire upon this subject?

Mr. CLEVELAND. Not many minutes more.

\* \* \* \* \*

Mr. CLEVELAND. I will have to leave the line of argument I had begun and confine myself to the amendment I have offered.

\* \* \* \* \*

Mr. CLEVELAND. I will ask for ten minutes more.

Mr. STEVENS. Very well.

Mr. CLEVELAND. It is only within a few years that the courts of any country have been inclined to construe liberally the common law in regard to trademarks. Only a few years since the highest court in England decided that the practice of establishing trademarks was a practice promotive of monopolies in trade; but of late years a more liberal view has obtained in the courts, both of England and of this country, and the courts are now inclined to construe the common law so as to protect trademarks for the good of the public itself, as well as in behalf of manufacturers and those persons who are engaged in trade.

It is claimed, and justly claimed, that in the protection of trademarks the courts are protecting the common people—people who are not expert in the purchase of the articles they need. A trademark is not necessarily a particular mark placed upon the article manufactured. It may be merely the maker's name put upon the article, or a distinctive label, so that those who want to purchase an article of a particular manufacture may be able to identify it and get the genuine article. Without such protection, the purchaser is constantly liable to be misled, unless he is able to examine as an expert every article that he may desire for personal or household use or for manufacturing purposes. But under the common law of trademarks, as now construed by the courts, the public is protected. When you purchase an article under a given name or with a particular mark, you may be certain that the article is what it purports to be, unless some one has ventured to put upon the market an imitation the sale of which the courts will stop when the matter is brought to their attention.

Within the last few years the courts of England and of this country have gone still further, and have so construed the law as to protect manufacturers as well as the public. This is a great advance upon the position occupied by the courts only a few years ago. Following the direction indicated by these liberal constructions of the courts, this bill proposes to extend and enlarge the protection afforded to manufacturers. It provides a method by which a manufacturer may register his trademark for a given term. In section 79 the committee have provided for the registration of trademarks, which registration is to continue in force for thirty years. I presume the committee would have fixed a much longer term but for the provision of the Constitu-



tion that protection of this kind shall be granted only for a limited period. My amendment provides that at the expiration of the first term of thirty years the registration may be renewed so as to extend over a second term of thirty years; and it is further provided that the manufacturer shall not lose his protection under the common law in consequence of the expiration of those two terms of thirty years each.

This bill contains other important provisions which I have not time to discuss at length. In section 80 there are some important provisions which I hope the House will examine carefully before they are voted upon. It is well known that laws of this character, while intended to be liberal and to extend privileges, may be in fact restrictive, and may defeat by injudicious phraseology the very objects they seek to promote. I am afraid some of the provisions of this bill are not broad enough; and as to some, I think the bill would have been better if they had not been introduced; but as the committee, after thorough examination of the subject, have deemed them necessary, I am willing to acquiesce in the judgment of the committee.

I shall move to insert after the word "obtain," in line 9 of section 78, the word "special," so that the phrase will read, "for exclusive use within the United States may obtain special protection for such lawful trade-marks." This bill makes the Commissioner of Patents a judge. He is to determine very important questions. He is to decide what are and what are not trademarks. After he has decided that a mark embraced in a particular application "is not and can not become a lawful trade-mark" according to the language of this bill, a shade may thereby be cast over it in the courts when the manufacturer afterwards seeks to sustain his claim under the common law. This difficulty is perhaps unavoidable. I have submitted to the committee a suggestion designed to obviate it; but the committee sees no way out of the difficulty. The bill provides:

The Commissioner of Patents shall not receive and record any proposed trademark which is not and can not become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public.

Now, the names of persons and corporations are trademarks, and the Commissioner of Patents can not by any decision of his prevent them from becoming trademarks. They are acknowledged as trademarks everywhere, so far as I can ascertain. They have been recently acknowledged as trademarks in France. They have also been acknowledged as trademarks in England. But by this provision the Commissioner of Patents may cast a shade upon trademarks to which these people are legally entitled and to which their claims have always been recognized. I do not think, however, that this provision will accomplish the purpose of the Committee on Patents.

Mr. STEVENS. I now yield to the gentleman from Rhode Island.

Mr. JENCKES. The gentleman from New Jersey [Mr. Cleveland] expresses his approval of the provisions reported by the Committee on Patents in favor of the recognition of trademarks, and I am glad to have his support. To the amendments which he has proposed to the seventy-ninth section I see no objection, and if there be no objection from any other quarter, I trust by unanimous consent they may be considered as adopted.

The SPEAKER. If there be no objection, the two amendments proposed by the gentleman from New Jersey to the seventy-ninth section will be considered as adopted.

There was no objection, and the amendments were accordingly agreed to.

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[House of Representatives, second session, April 21, 1870, Cong. Globe, vol. 91, p. 2880.]

#### PATENT AND COPYRIGHT LAWS.

The bill was then ordered to be engrossed and read a third time; and being engrossed, it was accordingly read the third time, and passed.

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[Senate, second session, April 25, 1870, Cong. Globe, vol. 91, p. 2941.]

#### MESSAGE FROM THE HOUSE.

A message from the House of Representatives, by Mr. McPherson, its Clerk, announced that the House had passed a bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights, in which the concurrence of the Senate was requested.

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[Senate, second session, April 25, 1870, Cong. Globe, vol. 91, p. 2943.]

#### HOUSE BILL REFERRED.

The bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights was read twice by its title, and referred to the Committee on Patents.

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[Senate, second session, May 31, 1870, Cong. Globe, vol. 92, p. 3941.]

#### REPORTS OF COMMITTEES.

Mr. Willey, from the Committee on Patents, to whom was referred the bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights, reported it with amendments.

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[Senate, second session, June 24, 1870, Cong. Globe, vol. 93, p. 4819.]

#### PATENTS AND COPYRIGHT LAWS.

The Senate, as in Committee of the Whole, proceeded to consider the bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights. \* \* \*

The debate upon the bill is given below.

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[Senate, second session, June 24, 1870, Cong. Globe, vol. 93, p. 4821.]

Mr. WILLEY. The several sections next succeeding the one just read introduce a new feature into our patent laws connected with trademarks. The committee instructed me to report an amendment to strike out those sections. Subsequent reflection has suggested to me whether the action of the committee in that respect was altogether best, and I am disposed to think that some of the members of the committee perhaps have come to the same conclusion.

Mr. SUMNER. I should hesitate very much about striking them out.

Mr. WILLEY. That is just what I am going to say, if the Senator pleases. The committee did not understand the subject very well

when they made this report, and did not at that time examine it. They thought that under the common law every man had a right to his own trademark and could protect himself, but subsequent reflection and examination have convinced me, at least, that these sections ought to be retained. I have examined them and I see that they have been drawn by a careful hand, and so far as I can understand the matter, they meet the case very fairly. They nationalize our trademarks and put us on an equality with other nations in that respect. It strikes me, on reflection, that they ought to be retained.

That is the result to which my own mind, as a member of the committee, has come, and I am very willing that the Senate should disagree with the recommendation of the committee.

Mr. SUMNER. I would remark that they seem to me of practical value to our own citizens, especially abroad. How can they have their trademarks protected in other countries if a protection is not provided for trademarks here? There must be reciprocity in that respect, and it seems to me that single consideration is decisive of the case.

But, independent of our fellow-citizens who now have interests abroad, I think that these sections are of value to all here at home, having put into the text of a statute rules and principles which have been matured at the common law and recognized by our courts, but which have new character and value and explicitness from being set forth in the statute. I hope, therefore, that the chairman of the committee will allow these sections to stay in the bill.

Mr. CARPENTER. As a member of the committee, I desire to join with our chairman in saying that, on reflection, I think these sections ought to be retained. They are wholly unnecessary at the common law, and so far as the rights of our citizens are concerned in England they are mere surplusage, the common law granting all that would be covered by these sections; but on the the continent of Europe it is different, and for that reason, if none other, they should be retained. I hope, therefore, the Senate will not concur in the recommendation of the committee to strike them out.

Mr. WILLEY. I hope the Senate will disagree with the recommendation of the committee.

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[House of Representatives, second session, June 25, 1870, Cong. Globe, vol. 93, p. 4849.]

MESSAGE FROM THE SENATE.

\* \* \* The message further announced that the Senate had passed a bill of the House (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights, with amendments, in which the concurrence of the House was requested.

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[Senate, second session, July 6, 1870, Cong. Globe, vol. 93, p. 5241.]

ENROLLED BILLS, ETC., SIGNED.

Mr. Beatty, from the Committee on Enrolled Bills, reported that the committee had examined and found truly enrolled bills \* \* \* of the following titles; when the Speaker signed the same:

\* \* \* \* \*

A bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights.



[Senate, second session, July 6, 1870, Cong. Globe, vol. 93, p. 5269.]

#### MESSAGE FROM THE HOUSE.

A message from the House of Representatives by Mr. Lloyd, its Chief Clerk, announced \* \* \* that the Speaker of the House had signed enrolled bills \* \* \* ; and they were thereupon signed by the Vice-President: \* \* \*

A bill (H. R. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights.

[House of Representatives, second session, July 8, 1870, Cong. Globe, vol. 93, p. 5355.]

#### MESSAGE FROM THE PRESIDENT.

A message from the President of the United States by Mr. Horace Porter, his private secretary, informed the House that the President had approved and signed bills of the following titles:

\* \* \* \* \*

An act (H. R. 1714) to revise and consolidate and amend the statutes relating to patents and copyrights.

The portion of the statute relating to trademarks is as follows:

[Laws of United States, Forty-first Congress, chap. 230, 16 U. S. Stat. L., p. 210; Cong. Globe, vol. 94, appendix, pp. 681, 685.]

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, \* \* \**

SEC. 77. *And be it further enacted*, That any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any State or Territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark (or who intend to adopt and use any trade-mark) for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements, to wit:

First. By causing to be recorded in the Patent Office the names of the parties, and their residences and place of business, who desire the protection of the trade-mark.

Second. The class of merchandise and the particular description of goods comprised in such class, by which the trade-mark has been or is intended to be appropriated.

Third. A description of the trade-mark itself, with facsimiles thereof, and the mode in which it has been or is intended to be applied and used.

Fourth. The length of time, if any, during which the trade-mark has been used.

Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.

Sixth. The compliance with such regulations as may be prescribed by the Commissioner of Patents.

Seventh. The filing of a declaration, under the oath of the person, or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trade-mark has a right to the use of the same, and that no other person, firm, or corporation has the right to such use, either in the identical form or having such near resemblance thereto as might be calculated to deceive, and that the description and facsimiles presented for record are true copies of the trade-mark sought to be protected.

SEC. 78. *And be it further enacted*, That such trade-mark shall remain in force for thirty years from the date of such registration, except in cases where such trade-mark is claimed for and applied to articles not manufactured in this country and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the same time that it becomes of no effect elsewhere; and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trade-mark, or substantially the same, or so nearly resembling it as

to be calculated to deceive, upon substantially the same description of goods: *Provided*, That six months prior to the expiration of said term of thirty years, application may be made for a renewal of such registration, under regulations, to be prescribed by the Commissioner of Patents, and the fee for such renewal shall be the same as for the original registration; certificate of such renewal shall be issued in the same manner as for the original registration, and such trade-mark shall remain in force for a further term of thirty years: *And provided further*, That nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trade-mark after the expiration of the term for which such trade-mark was registered.

SEC. 79. *And be it further enacted*, That any person or corporation who shall reproduce, counterfeit, copy, or imitate any such recorded trade-mark, and affix the same to goods of substantially the same descriptive properties and qualities as those referred to in the registration, shall be liable to an action in the case for damages for such wrongful use of said trade-mark, at the suit of the owner thereof, in any court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use. The Commissioner of Patents shall not receive and record any proposed trade-mark which is not and cannot become a lawful trade-mark, or which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trade-mark appropriate to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trade-mark as to be likely to deceive the public: *Provided*, That this section shall not prevent the registry of any lawful trade-mark rightfully used at the time of the passage of this act.

SEC. 80. *And be it further enacted*, That the time of the receipt of any trade-mark at the patent office for registration shall be noted and recorded, and copies of the trade-mark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the patent office, certified by the commissioner, shall be evidence in any suit in which such trade-mark shall be brought in controversy.

SEC. 81. *And be it further enacted*, That the commissioner of patents is authorized to make rules, regulations, and prescribe forms for the transfer of the right to the use of such trade-marks, conforming as nearly as practicable to the requirements of law respecting the transfer and transmission of copyrights.

SEC. 82. *And be it further enacted*, That any person who shall procure the registry of any trade-mark, or of himself as the owner thereof, or an entry respecting a trade-mark in the patent office under this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case before any court of competent jurisdiction within the United States.

SEC. 83. *And be it further enacted*, That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if this act had not been passed.

SEC. 84. *And be it further enacted*, That no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trade-mark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trade-mark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

#### FORTY-SECOND CONGRESS.

H. R. 2597.—A bill to protect domestic trademarks. Introduced by Hon. John Rogers, of New York, April 29, 1872. Referred to the Committee on Commerce. Not reported.

[House of Representatives, second session, April 29, 1872, Cong. Globe, vol. 103, p. 2885.]

#### DOMESTIC TRADEMARKS.

Mr. Rogers introduced a bill (H. R. 2597) to protect domestic trademarks; which was read a first and second time, referred to the Committee on Commerce, and ordered to be printed.

## FORTY-THIRD CONGRESS.

H. R. 4065.—A bill to amend the statutes relating to trademarks and labels. Introduced by Hon. Stevenson Archer, of Maryland, December 21, 1874. Referred to the Committee on Patents. Not reported.

[House of Representatives, second session, December 21, 1874, Cong. Record, vol. 3, part 1, p. 169.]

## TRADEMARKS AND LABELS.

Mr. Archer introduced a bill (H. R. 4065) to amend the statutes relating to trademarks and labels; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

## FORTY-FOURTH CONGRESS.

Two bills were introduced in the House and one in the Senate in this Congress.

H. R. 2547.—A bill to revise and amend section 5416 of the Revised Statutes making it a misdemeanor to counterfeit registered trademarks. Introduced by Hon. Abram S. Hewitt, of New York, March 6, 1876. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, March 6, 1876, Cong. Record, vol. 4, part 2, p. 1487.]

## TRADEMARKS.

Mr. Hewitt, of New York, introduced a bill (H. R. 2547) to revise and amend section 5416 of the Revised Statutes, making it a misdemeanor to counterfeit registered trademarks; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

H. R. 2548.—A bill to revise and amend the Revised Statutes in relation to registration of trademarks. Introduced by Hon. Abram S. Hewitt, of New York, March 6, 1876. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, March 6, 1876, Cong. Record, vol. 4, part 2, p. 1487.]

Mr. Hewitt, of New York, also introduced a bill (H. R. 2548) to revise and amend the Revised Statutes in relation to registration of trademarks; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

S. 846.—A bill to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods. Introduced by Hon. Roscoe Conkling, of New York, May 18, 1876. Passed in Senate and House. Approved by the President August 16, 1876. (19 U. S. Stat. L., p. 141, chap. 274.)

[Senate, first session, May 18, 1876, Cong. Record, vol. 4, part 4, p. 3146.]

## BILLS INTRODUCED.

\* \* \* \* \*

Mr. Conkling asked, and by unanimous consent obtained, leave to introduce a bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods; which was read twice by its title, and, with the accompanying papers, referred to the Committee on the Judiciary.



[Senate, first session, June 24, 1876, Cong. Record, vol. 4, part 5, p. 4133.]

REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Conkling, from the same committee [Judiciary] to whom was referred the bill (S. 846) to punish the counterfeiting of trademark goods and the sale of or dealing in counterfeit trademark goods, reported it with amendments.

[Senate, first session, June 29, 1876, Cong. Record, vol. 4, part 5, p. 4234.]

TRADEMARK GOODS.

Mr. CONKLING. I move that the Senate proceed to the consideration of the trademark bill, so called.

The motion was agreed to, and the bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods was considered as in Committee of the Whole.

The Committee on the Judiciary proposed to amend section 1, line 12, by striking out, after the words "imprisoned for," the words "not less than six months and;" so as to make the section read:

That every person who shall have in his possession, or deal in, or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade-mark, pursuant to the statutes of the United States, to which, or to the package in which the same are put up, is fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit or not the genuine goods referred to in said registration, shall, on conviction thereof, be imprisoned for not more than two years, and shall also be liable to the aggrieved owner of said trade-mark in the penal sum of \$1,000, to be recovered in a civil action.

The amendment was agreed to.

The committee proposed to amend the seventh section so as to make it read:

SEC. 7. That any person who shall, with intent to injure or defraud or to aid in defrauding or injuring the owner of any trade-mark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trade-mark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

The amendment was agreed to.

The next amendment reported by the committee was in section 10, line 4, after the words "imprisoned for," to strike out "not less than three months and."

The amendment was agreed to.

The PRESIDENT *pro tempore*. The word "hereof," in the second and third sections, seems to be in conflict with other words.

Mr. CONKLING. Let the word "hereof" be stricken out in both sections and the words "of this act" inserted.

The amendment was agreed to.

Mr. DAWES. I desire to make an inquiry of the Senator from New York. If I understand the bill, I am very heartily in support of it. The first section provides a penalty for the sale of "any goods of substantially the same descriptive properties as those referred to in the registration of any trademark," but they must have that trademark

upon them, as I understand. I ask whether it is intended by the bill to at all interfere with the manufacture of "goods of substantially the same descriptive properties as those referred to in the registration of any trademark," unless they have that trademark upon them.

Mr. CONKLING. It is intended to do, as I understand it, what is plainly expressed, as the Senator will see, in line 8 of section 1. I call his attention to these words: "To which"—that is, to the commodities that he has referred to—"or to the package in which the same are put up, is fraudulently affixed said trademark."

Mr. DAWES. So far as this section is concerned I can see it very plainly; but rather than study the bill through I preferred to ask the Senator whether it is intended to make a monopoly in the manufacture of goods substantially of the same description unless there has been a fraudulent use of the trademark?

Mr. CONKLING. Not at all, as I understand. It is intended to provide penalties against those who knowingly and fraudulently pirate the trademarks.

Mr. DAWES. That is what I supposed the bill to be, but the Senator will see the object of my inquiry. There are goods, cloths for instance, manufactured for different and rival establishments, very much alike, that would come under this substantial description, and some one gets the advantage, as he has a right to, by having a trademark. I did not know whether it were possible by any construction of any part of the bill to give the exclusive right of manufacture of goods substantially like those covered by this trademark.

Mr. CONKLING. The committee understood, I am sure, as I understand, that this bill makes throughout the criterion of liability turn upon an element which is this, or equivalent to this:

To which, or to the package in which the same are put up, is fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit or not the genuine goods referred to in said registration.

Mr. DAWES. This section is perfectly correct.

Mr. CONKLING. I think the Senator will find the same thing runs all through.

Mr. DAWES. If I put it in another form the Senator will see what I am trying to take care of. Suppose that two men manufacture an article of cloth substantially alike, not absolutely alike, and one of them has a trademark. Does this bill give him exclusive right of making all articles substantially of that character?

Mr. CONKLING. If that were in the bill, owing to the frame of the bill, the honorable Senator will see it would be found in one of the first three sections, because he will observe that after the third section the provisions of the bill relate to matters not falling within the scope of his inquiry. Speaking then of three sections I think the remarks I am about to make will be apparent on their face, and they are very brief. The intention is to make the *scienter*, the guilty knowledge or the guilty motive the hinge on which the whole thing turns. Accordingly the Senator will see in the second section:

That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade-mark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties.

In the third section:

That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public.

And so on.

Mr. DAWES. They all apply to the use of the mark.

Mr. CONKLING. Entirely, as I understand, and not only so but to its fraudulent use.

Mr. DAWES. I am very desirous in cooperating in the passage of a bill with that intent.

Mr. CONKLING. If we have succeeded in doing what we tried to do, we have done that.

The bill was reported to the Senate as amended, and the amendments were concurred in.

The bill was ordered to be engrossed for a third reading, read the third time, and passed.

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[House of Representatives, first session, July 10, 1876, Cong. Record, vol. 4, part 5, p. 4493.]

#### COUNTERFEITING OF TRADEMARK GOODS, ETC.

Mr. COX. I ask unanimous consent to take from the Speaker's table the bill to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods; and I shall ask to put it upon its passage. I will say to the House that this bill was very thoroughly considered in the Senate by the Committee on the Judiciary of that body, and that our Committee on the Judiciary will hardly have time to report upon it at this session. Such Senators as Mr. Conkling and Mr. Thurman have thoroughly considered it. Its object is to protect honest merchants and manufacturers. I hope, therefore, there will be no objection to its consideration.

The Clerk began the reading of the bill, but before concluding,

Mr. COX said: I will not ask that the time of the House be taken up by the reading of this bill at length, but will ask that it be referred to the Committee on Patents, with leave to report it back at any time.

No objection being made, the bill (S. 846) was accordingly taken from the Speaker's table, read a first and second time, and referred to the Committee on Patents, with leave to report at any time.

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[House of Representatives, first session, July 20, 1876, Cong. Record, vol. 4, part 5, p. 4775.]

#### COUNTERFEITING TRADEMARKS.

Mr. Sampson, from the Committee on Patents, reported back, with amendments, the bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods.

The amendments reported by the committee were read, as follows:

In line 3, section 1, strike out the words "have in his possession or," and insert after the word "shall," in the same line, the words "with intent to defraud."

Strike out all after the word "be" in line 11, section 1, and insert "punished by fine not exceeding \$1,000, or imprisonment not more than two years, or both such fine and imprisonment."

Strike out all of section 6.

In line 2, section 7, strike out "or to aid in defrauding or injuring."

Strike out all of section 8.

Strike out all after the word "be" in line 4, section 10, and insert the words "punished by fine not exceeding \$500, or imprisonment not more than one year, or both such fine and imprisonment."

Strike out all of section 11.



Mr. SAMPSON. Mr. Speaker, it will only be necessary to detain the House for a moment or two in explanation of this bill.

It is generally conceded that there is not at present sufficient protection to trademarks. The public generally, the honest manufacturers and honest dealers throughout the country, are being constantly swindled by counterfeit trademarks. The law of 1870, providing a general system for the registration of trademarks, and designed to afford better protection by giving right of action in United States courts to recover damages for counterfeiting and providing the remedy by enjoining counterfeiters, has not proved sufficient. Worthless parties engaged in such dishonest practices are not prevented by civil actions. A judgment for damages has no terrors for them. If enjoined, some relative soon owns the goods, and the business goes on. The plaintiff in such action (the measure of damages being the profit) has to depend mainly on the testimony and books of the defendant; and it is found generally that he who will counterfeit will testify falsely to avoid the consequences. Thus the action for damages amounts to but little.

Nearly 400 of the leading manufacturers, merchants, and dealers of New York, Boston, and Philadelphia have petitioned Congress very earnestly at this session to enact such a law as that contained in this Senate bill; and they state their reasons in this forcible language:

The use of trade-marks on every species of merchandise and manufactures, both foreign and domestic, has greatly increased with the expansion of modern trade and commerce, and has become a powerful interest throughout the United States of America.

The nefarious but lucrative business of pirating or counterfeiting genuine trade-mark goods has too long flourished unchecked, to the incalculable injury of every consumer, of every honest merchant, manufacturer, and trader, and has extensively multiplied costly and tedious litigation.

No United States statute yet exists providing penal remedies to punish the counterfeiting of trade-mark goods or the sale or dealing in of the same. The evils and injuries to long-suffering commercial and manufacturing interests consequent upon this omission imperatively demand prompt relief and a speedy application of searching remedies.

We therefore respectfully petition for relief, and request that Senate bill No. 846, introduced into the Senate on the 18th of May, 1876, entitled "A bill to punish the counterfeiting of trade-mark goods and the sale or dealing in of counterfeit trade-mark goods," may be made law at this session of Congress.

A word in relation to the amendments proposed by the committee. They are seven in number, but are solely for the purpose of accomplishing the following objects:

First. To render it certain that no one shall be convicted of crime or punished under this proposed statute for having any connection with fraudulent trademarks unless such connection was willful and with intent to defraud, and to throw the burden of proof of this fact on the State.

Second. To so shape the law that all money paid by defendants by way of penalty should go into the Treasury as fines in other cases, and not go to the informer or the owner of the trademark. The owner is provided for now by the civil action for damages.

Third. To limit the punishment to fine and imprisonment, and not allow it to extend to forfeitures of goods also.

These are the only amendments made by the committee. I will yield to the gentleman from Michigan to offer one or two additional amendments in the same line to perfect the bill, and will then demand the previous question.

Mr. CONGER. I offer three amendments to different places in the bill, which I will ask the Clerk to read. They are in the same line as those reported from the Committee on Patents:

1. Insert in line 7, section 9, after the word "person," the words "with intent to use the same for the purpose of deception and fraud."
2. In line 15, same section, after the word "person," insert the words "with intent to use the same for the purpose of deception and fraud."
3. In line 34, in the same section, after the word "use," insert the words "by the holder or owner."

Mr. SAMPSON. I am willing to agree to those amendments. I demand the previous question.

The previous question was seconded and the main question ordered.

Mr. Conger's amendments to the amendment were agreed to; and then the amendments of the committee as amended were concurred in.

The bill as amended was ordered to a third reading; and it was accordingly read the third time, and passed.

Mr. Sampson moved to reconsider the vote by which the bill as amended was passed, and also moved that the motion to reconsider be laid on the table.

The latter motion was agreed to.

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[Senate, first session, July 21, 1876, Cong. Record, vol. 4, part 5, p. 4781.]

#### MESSAGE FROM THE HOUSE.

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The message also announced that the House had passed the bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods, with amendments; in which the concurrence of the Senate was requested.

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[Senate, first session, July 21, 1876, Cong. Record, vol. 4, part 5, p. 4781.]

#### TRADEMARK GOODS.

The President *pro tempore* laid before the Senate the amendments of the House of Representatives to the bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods; which on motion of Mr. Conkling were referred to the Committee on the Judiciary, and ordered to be printed.

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[Senate, first session, July 31, 1876, Cong. Record, vol. 4, part 6, p. 5014.]

#### COUNTERFEITING OF TRADEMARKS.

Mr. CONKLING. The Committee on the Judiciary have directed me to report back the bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods, which after having been passed by the Senate was passed by the House of Representatives with amendments, and to recommend that the Senate nonconcur in the amendments and ask for a conference with the House.

The Senate proceeded to consider the amendments of the House of Representatives to the bill.

On motion of Mr. Conkling, it was

*Resolved*, That the Senate disagree to the amendments of the House of Representatives to the said bill, and ask a conference on the disagreeing votes of the two Houses thereon.

By unanimous consent, it was

*Ordered*, That the conferees on the part of the Senate be appointed by the President *pro tempore*.

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[Senate, first session, August 4, 1876, Cong. Record, vol. 4, part 6, p. 5140.]

#### COUNTERFEITING OF TRADEMARKS.

The President *pro tempore* appointed as conferees on the part of the Senate on the bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods, Mr. Conkling, Mr. Frelinghuysen, and Mr. Stevenson.

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[House of Representatives, first session, August 4, 1876, Cong. Record, vol. 4, part 6, p. 5192.]

#### COUNTERFEIT TRADEMARKS.

Mr. SAMPSON. I desire to call up from the Speaker's table the bill (S. 846) to punish counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods. This bill has been returned from the Senate, where the amendments of the House have been disagreed to. The Senate requests a conference with the House and has appointed managers for that purpose. I move that the House insist upon its amendments and agree to the conference asked by the Senate.

There being no objection, the motion was agreed to.

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The Speaker *pro tempore* subsequently announced the appointment of Mr. J. H. Bagley, Mr. Hartzell, Mr. Sampson as the conferees on the part of the House.

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[House of Representatives, first session, August 11, 1876, Cong. Record, vol. 4, part 6, p. 5478.]

#### TRADEMARKS.

Mr. J. H. BAGLEY. I submit a report from a committee of conference, which I ask the Clerk to read.

The Clerk read the report, as follows:

The Committee of conference on the disagreeing votes of the two Houses on the amendments of the House to the bill (S. 846) "To punish the counterfeiting of trade mark goods and the sale or dealing in of counterfeit trade mark goods" having met, after full and free conference have agreed to recommend, and do recommend, to their respective Houses as follows:

That the Senate recede from its disagreement to the amendments of the House numbered 2, 5 and 10.

That the House recede from its amendments numbered 4 and 8.

That the Senate recede from its disagreement to the amendments of the Senate numbered 1, and agree to the same, with an amendment as follows: After the word "keep" in line 4 page 1 of the bill, insert the words "for sale or keep that others may sell;" and the House agree to the same.

That the House recede from its amendment numbered 3, and agree to the clause proposed to be stricken out, with an amendment as follows: At the end of the section insert: "In all cases in which it appears that the person or party claiming said goods had, when he received the same, knowledge or notice that the same were such goods as this section describes;" and the Senate agree to the same.

That the Senate recede from its disagreement to the amendment of the House numbered 6, and agree to the same, with an amendment, so that the clause will read as follows: "With intent that the same be used for the purpose of deception and fraud;" and the House agree to the same.



That the Senate recede from its disagreement to the amendment of the House numbered 7, and agree to the same, with an amendment, so that the clause will read as follows: "With intent that the same be used for the purpose of deception and fraud;" and the House agree to the same.

That the House recede from its amendment numbered 9, and agree to the section wherein said amendment occurs, amending said section so as to stand as follows: "That any person who shall, with intent to defraud any person or persons, knowingly and willfully aid or abet in the violation of any of the provisions of this act, shall upon conviction thereof be punished as prescribed in the first section of this act; and any person who shall commit any of the offenses specified in this act shall be deemed to have committed a crime, and may be proceeded against by arrest, indictment, and trial, as in other criminal cases, and the district courts of the United States shall have cognizance and jurisdiction to enforce this act;" and the Senate agree to the same.

J. H. BAGLEY, Jr.,

W. HARTZELL,

E. S. SAMPSON,

*Managers on the part of the House.*

ROSCOE CONKLING,

FREDERICK T. FRELINGHUYSEN,

J. W. STEVENSON,

*Managers on the part of the Senate.*

The question was upon agreeing to the report of the committee of conference.

Mr. HEWITT of New York. I would like to inquire of the Chair whether it is in order to move to postpone the consideration of this conference report until the next session of Congress?

Mr. RANDALL. The conference report can be voted down, in which case the bill would be lost; but it might be revived again.

Mr. GARFIELD. To vote down the conference report would kill the bill. To postpone the report until the next session does not necessarily kill the bill.

Mr. HEWITT of New York. I desire to say a very few words in relation to this bill.

The SPEAKER *pro tempore*. The gentleman from New York submitting the report [Mr. J. H. Bagley] is entitled to the floor.

Mr. J. H. BAGLEY. I desire to say in reference to this report that we have had a full and free conference; and although there may be some features of this report which are objectionable to some gentlemen, yet we have done, after mature consideration, the best we could, and I think we have put the bill in a very acceptable shape. I do not know that I have any explanations to make in regard to this report. My colleague on the committee, the gentleman from Iowa [Mr. Sampson], can perhaps give a better explanation of it than I can.

Mr. HEWITT of New York. Will the gentleman yield to me for a moment?

Mr. J. H. BAGLEY. I will first yield to my colleague on the committee.

Mr. SAMPSON. I do not desire to take up any of the time of the House in discussing this report, unless it may appear that there are some sound reasons why it should not be adopted. If the gentleman from New York [Mr. Hewitt] has any objection to this report, I am perfectly willing to hear his objection, and then I may desire to reply to him.

Mr. HEWITT of New York. My attention was called to this bill early in the session by a very large association in the city of New

York, known as the Junk Dealers' Association. I was surprised to learn that in the city of New York there were 2,000 dealers in cast-off articles. I was asked to give some attention to this matter, and I tried to do so.

Now, I confess before this House, to my humiliation, that this bill actually passed both Houses and went to this conference committee while I was sitting in my seat, and I was utterly ignorant of the fact. I immediately called the attention of members of the House and of the Senate to the character of the bill. I had it examined by competent legal authority, and I have been assured that the bill can not be executed without subjecting a large class of humble and respectable people to the very greatest hardships.

I have no doubt this bill contains many meritorious features in regard to trademarks, and that some legislation is required for the better protection of trademarks. But it seems to me it will be a mistake to carry into operation any such legislation without giving proper attention to the rights and interests of other portions of the community who have not been represented before the committee, as the owners of trademarks have, by competent counsel.

The association of which I have spoken complained that they had had no opportunity to be heard before the committee of this House. They seem to have addressed a communication to the committee of the Senate, and that communication, I understand, was acknowledged, although I was informed by the president of the association that it had not been acknowledged.

I do not desire to defeat this bill; I desire to see it perfected. But it seems to me that to pass it under this report of the committee of conference would be doing very great injustice. Hence my inquiry of the Chair if it was in order to move to postpone the further consideration of this report until the next session of Congress, so that all parties interested might be heard and an opportunity given to secure proper legislation.

Let me explain to this House very briefly the nature of one provision of this bill. A poor man is passing along the street with a bottle under his arm; the bottle is marked "Piper Heidsieck," or some other respectable name. Now, if there be a deputy marshal who is prepared to swear that this man has this bottle with intent to defraud, the man can be arrested and carried before a United States commissioner. In many portions of the country the United States commissioner can not be found within 50 or 100 miles. The man can be put under arrest and required to give bail, and perhaps all the property he has in the world is the bottle under his arm. Then comes the bill of fees for the marshal, for the commissioner, and for everybody else. I am assured by gentlemen here, and no doubt lawyers on this floor understand it much better than I do, that in different parts of this country there are deputy marshals and commissioners who are engaged in hunting up violations of the revenue laws for the express purpose of securing the fees.

The operations of this bill extend to almost every known class of cast-off articles—bottles, boxes, cigar boxes, medicine vials, anything that any man may happen to cast aside and a poor fellow may pick up. If somebody will make the necessary affidavit against him, he may be arrested and put in any jail and kept there.

It is true that a provision requiring the showing of an intent to defraud (which was not in the original draft of this bill) has been

inserted upon careful examination by the committee; and I thank them for it. But it seems to me that the whole measure is too full of danger to be passed at this late hour of the session without more thorough investigation. I appeal to my legal friends here—for they are the ones who ought to guard the interests of these poorer members of society, who are unable to protect themselves—I ask from them a careful examination of the provisions of this bill in order that they may say whether it is such legislation as an enlightened Congress ought to adopt. If, therefore, it be in order, I shall move to postpone the further consideration of this subject until the next session of Congress, in the hope that then a proper measure may be perfected which will satisfy all classes of the community.

Mr. SAMPSON. Mr. Speaker, the first objection which the gentleman from New York [Mr. Hewitt] seems to make to this bill is that it has not been carefully considered; that it is hasty legislation. As I understand the history of this measure, it was introduced into the Senate perhaps some three months ago, was referred to the Committee on the Judiciary of that body, and after careful consideration by some of the ablest lawyers upon that committee was reported back to the Senate, and after discussion sent to this House. The gentleman from New York [Mr. Cox] called up the bill here and asked unanimous consent that it might be considered and passed immediately. I called his attention to the fact that the bill embraced some objectionable features under which innocent men might be punished. I was anxious to have inserted in the bill a provision requiring proof of intent to defraud—requiring the Government to prove affirmatively in every case that this cast-off property to which the gentleman from New York [Mr. Hewitt] has referred was held with intent to defraud. Upon that suggestion of mine the gentleman consented to the reference of the bill to the Committee on Patents. It was carefully considered by that committee, upon which there are a number of legal gentlemen, and the provision requiring proof of intent to defraud was inserted in every case where it appeared necessary for the protection of innocent parties. After full consideration by that committee the bill came back to the House with amendments, and was here discussed. Gentlemen will remember that there was quite a struggle to obtain the floor for the purpose of having those amendments considered. The bill was discussed, the reasons for the amendments given, and the bill was passed as amended without a dissenting voice. Upon its return to the Senate that body refused to concur in the amendments of the House and a conference committee was appointed.

The gentleman from New York [Mr. Hewitt] has complained that a friend or constituent of his has been denied the opportunity to make a proper showing before the committee. I believe he has reference to the president of the Junk Association of New York City, an association numbering some 2,000 or 3,000 members. Now, the fact is that that gentleman has been in communication with a member of the Judiciary Committee of the Senate ever since the early part of June. He then opened a correspondence, and letters have passed back and forth between those gentlemen. His case as made out by letter was submitted to the Judiciary Committee of the Senate, and was fully considered. His opposition to the measure had relation to this very provision relating to empty bottles. Now, in order to show the House



that this is not an objectionable feature, I desire to read the section relating to that subject:

That any person, who shall, with intent to injure or defraud the owner of any trade mark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trade mark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as described in the first section of this act.

Now, if the trademark is a part of the bottle—if it is blown into the bottle so that it can not be erased—there is no offense; but if the trademark is a paper label stuck upon the bottle, so that it must be rubbed off unless the person having it in his possession takes pains to keep it there, then it will be some evidence, perhaps, that he intends to violate the law. If he can not wash the bottle without washing off the label, unless he takes especial pains to keep it on, this may be evidence of intent to defraud. But this intent must appear by some affirmative evidence. The burden of proof rests upon the Government. If a man has in his possession bottles with trademark labels upon them, all he has to do to avoid the very appearance of evil is to wash off the labels. It seems to me it can not be claimed in reason that there is any hardship in the provisions of this bill as now amended.

The gentleman from New York (Mr. Hewitt) says that an innocent man may be arrested for having in his possession a bottle with a counterfeit trademark. So a man may be walking through the streets with a half dollar in his pocket which some man may claim is counterfeit, and he may be arrested upon the charge of having counterfeit money in his possession. There is the same possibility of hardship in every case where a man may be alleged to have any counterfeit property in his possession. We have, however, been very careful to guard all these sections so as to throw upon the Government the burden of proving the intent to defraud. In fact, it seemed to be the opinion of some gentlemen interested in this bill that in this manner it had been so diluted as to be of little value for the punishment of those who may deal in counterfeit trademarks. I think that certainly if we are going to pass any bill on this subject this is in as mild a form as any gentleman could wish. We have sought to render it impossible that any innocent man shall be punished.

Mr. HEWITT, of New York. Will the gentleman state the penalty?

Mr. SAMPSON. The maximum punishment is a fine of \$2,000 and imprisonment for two years, but the penalty may be as light as imprisonment for one minute and a fine of 1 cent, as the whole matter rests within the discretion of the court. A large latitude in respect to the penalty is intentionally given. If a man is found having in his possession but a single package or bottle bearing a counterfeit trademark, and if this is his only offense, the court may make the penalty extremely light.

Although the gentleman from New York seems now so apprehensive in regard to punishments, he introduced in this House and had referred to the Committee on Patents a bill in which the punishment for the use of counterfeit trademarks was fixed at imprisonment for ten years and a fine not exceeding \$5,000. Under this bill the punishment can not exceed imprisonment for two years and a fine of

\$2,000, while it may be as much less as the court within its discretion may deem proper.

Mr. HEWITT, of New York. The gentleman from Iowa [Mr. Sampson] states that I introduced bills for the protection of trademarks containing severer penalties than those in the bill under discussion. That is true; but he ought to remember that gentlemen often introduce bills at the request of other parties, for the provisions of which they do not hold themselves responsible. The bills referred to were handed to me by respectable members of the bar, and I introduced them without giving any sanction to the provisions of the bills myself.

Mr. J. H. BAGLEY. I now yield the floor to the gentleman from Michigan.

Mr. CONGER. Mr. Speaker, when this bill, which was passed in the Senate, was referred to the Committee on Patents it seemed to me to be a bill solely in the interest of those to whom by law privileges had been given in connection with trademarks; that its provisions were so severe and the penalty so high, the imprisonment so long necessarily, with no requirement that fraudulent intent should be alleged and proved, that I was very much opposed to it, as were other members of the Committee on Patents. It was considered for a long time by that committee very carefully. I think if the bill has been agreed upon substantially by the conference committee as it finally passed the House the interests of the people are fairly protected, and the interests of those who have rights under the trademark law are equally well protected. I am not certain, as I have not looked into it, whether this contains the section which makes it purely a criminal offense and which was struck out by the House.

Mr. SAMPSON. That was not restored in the Senate.

Mr. CONGER. If that were restored by this conference committee, I should myself oppose the passage of this bill now or at any time, and I should ask gentlemen of the House to oppose it upon what I believe to be abundantly sufficient ground. But the gentleman who has charge of the bill informs me that the section stricken out by the committee of conference has not been restored. If it has not, and sufficient guard against abuse of prosecutions is inserted by the Committee on Patents in the Senate bill—if those are retained—I can see no real objection to its passage. \* \* \*

The report was rejected.

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[Senate, first session, August 11, 1876, Cong. Record, vol. 4, part 6, p. 5453.]

#### TRADEMARK GOODS.

Mr. CONKLING. Mr. President, being compelled to be absent from the Senate in the morning, I ask unanimous consent to take up a message from the House which lies on the table.

The PRESIDENT *pro tempore*. The Chair hears no objection.

Mr. EDMUNDS. Subject to a call for the regular order.

The President *pro tempore* laid before the Senate the action of the House of Representatives disagreeing to the report of the committee of conference on the disagreeing votes of the two Houses on the bill (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in counterfeit trademark goods.

Mr. CONKLING. It is so late in the session that I think it hardly worth while to ask another conference with the House, although it



differs radically with the Senate and the Judiciary Committee of the Senate touching this bill; but as the House has left it somewhat better than no bill at all, after consulting with the members of the Judiciary Committee, I move that the Senate recede from its vote disagreeing to the House amendments and let the House have its way on the bill.

The PRESIDENT *pro tempore*. The Senator from New York moves that the Senate recede from its disagreement to the amendments of the House.

The motion was agreed to.

[Senate, first session, August 15, 1876, Cong. Record, vol. 4, part 6, p. 5657.]

#### PRESIDENTIAL APPROVALS.

A message from the President of the United States, by Mr. U. S. Grant, jr., his secretary, announced that the President had yesterday approved and signed the following acts:

An act (S. 846) to punish the counterfeiting of trademark goods and the sale or dealing in of counterfeit trademark goods. \* \* \*

The bill as passed is as follows:

CHAP. 274.—An act to punish the counterfeiting of trade-mark goods and the sale or dealing in of counterfeit trade-mark goods.

*Be it enacted, etc.* [Section 1], That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade-mark, pursuant to the statutes of the United States, to which, or to the package in which the same are put up, is fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

SEC. 2. That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade-mark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods, of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SEC. 3. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SEC. 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving, or mould of any private label, brand, stamp, wrapper, engraving on paper or other substance, or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SEC. 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully make, forge, or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mould, or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SEC. 6. That any person who shall, with intent to injure or defraud the owner of any trade-mark, or any other person lawfully entitled to use or protect the same, buy,



sell, offer for sale, deal in or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trade-mark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SEC. 7. That if the owner of any trade-mark, registered pursuant to the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, or moulds of his said registered trade-mark, are in the possession of any person, with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colorable imitations of his said trade-mark, label, brand, stamp, wrapper, engravings on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trade-mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person, with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States and the commissioners of the circuit courts may, within their respective jurisdictions, proceed under the law relating to search warrants, and may issue a search warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, and said counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substance, and said empty boxes, envelopes, wrappers, cases, bottles, or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles or other packages, are to be used by the holder or owner for the purposes of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

SEC. 8. That any person who shall, with intent to defraud any person or persons, knowingly and willfully aid or abet in the violation of any of the provisions of this act shall, upon conviction thereof, be punished by a fine not exceeding five hundred dollars, or imprisonment not more than one year, or both such fine and imprisonment.

The act of August 14, 1876, was declared unconstitutional by the Supreme Court of the United States, the court writing the following opinion:

(100 U. S., 82.)

MR. JUSTICE MILLER delivered the opinion of the court.

The three cases whose titles stand at the head of this opinion are criminal prosecutions for violations of what is known as the trade-mark legislation of Congress. The first two are indictments in the southern district of New York, and the last is an information in the southern district of Ohio. In all of them the judges of the circuit courts in which they are pending have certified to a difference of opinion on what is substantially the same question, namely: Are the acts of Congress on the subject of trade-marks founded on any rightful authority in the Constitution of the United States?

The entire legislation of Congress in regard to trade-marks is of very recent origin. It is first seen in sections 77 to 84, inclusive, of the act of July 8, 1870, entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights" (16 Stat., 198). The part of this act relating to trade-marks is embodied in chapter 2, title 60, sections 4937 to 4947, of the Revised Statutes.

It is sufficient at present to say that they provide for the registration in the Patent Office of any device in the nature of a trade-mark to which any person has by usage established an exclusive right, or which the person so registering intends to appropriate by that act to his exclusive use; and they make the wrongful use of a trade-mark, so registered, by any other person, without the owner's permission, a cause of action in a civil suit for damages. Six years later we have the act of August 14, 1876

(19 Stat., 141), punishing by fine and imprisonment the fraudulent use, sale, and counterfeiting of trade-marks registered in pursuance of the statutes of the United States, on which the informations and indictments are founded in the cases before us.

The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has been long recognized by the common law and the chancery courts of England and of this country, and by the statutes of some of the States. It is a property right for the violation of which damages may be recovered in an action at law, and the continued violation of it will be enjoined by a court of equity, with compensation for past infringement. This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to that act, and have remained in full force since its passage.

These propositions are so well understood as to require neither the citation of authorities nor an elaborate argument to prove them.

As the property in trade-marks and the right to their exclusive use rest on the laws of the States, and, like the great body of the rights of person and of property, depend on them for security and protection, the power of Congress to legislate on the subject, to establish the conditions on which these rights shall be enjoyed and exercised, the period of their duration, and the legal remedies for their enforcement, if such power exist at all, must be found in the Constitution of the United States, which is the source of all the powers that Congress can lawfully exercise.

In the argument of these cases this seems to be conceded, and the advocates for the validity of the acts of Congress on this subject point to two clauses of the Constitution, in one or in both of which, as they assert, sufficient warrant may be found for this legislation.

The first of these is the eighth clause of section 8 of the first article. That section, manifestly intended to be an enumeration of the powers expressly granted to Congress, and closing with the declaration of a rule for the ascertainment of such powers as are necessary by way of implication to carry into efficient operation those expressly given, authorizes Congress, by the clause referred to, "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

As the first and only attempt by Congress to regulate the *right of trade-marks* is to be found in the act of July 8, 1870, to which we have referred, entitled "An act to revise, consolidate, and amend the statutes relating to *patents and copyrights*," terms which have long since become technical, as referring, the one to inventions and the other to the writings of authors, it is a reasonable inference that this part of the statute also was, in the opinion of Congress, an exercise of the power found in that clause of the Constitution. It may also be safely assumed that until a critical examination of the subject in the courts became necessary, it was mainly if not wholly to this clause that the advocates of the law looked for its support.

Any attempt, however, to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with the writings of authors, will show that the effort is surrounded with insurmountable difficulties.

The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science, nor art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like. The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it grows out of its *use*, and not its mere adoption. By the act of Congress this exclusive right attaches upon registration. But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. It is simply founded on priority of appropriation. We look in vain in the statute for any other qualification or condition. If the symbol, however plain, simple, old, or well known, has been first appropriated by the claimant as his distinctive trade-mark, he may, by registration, secure the right to its exclusive use. While such legislation may be a judicious aid to the common law on the subject of trade-marks, and may be within the competency of legislatures whose general powers embrace that class of subjects, we are unable to see any



such power in the constitutional provision concerning authors and inventors and their writings and discoveries.

The other clause of the Constitution supposed to confer the requisite authority on Congress is the third of the same section, which, read in connection with the granting clause, is as follows:

"The Congress shall have power to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes."

The argument is that the use of a trade-mark—that which alone gives it any value—is to identify a particular class or quality of goods as the manufacture, produce, or property of the person who puts them in the general market for sale; that the sale of the article so distinguished is commerce; that the trade-mark is, therefore, a useful and valuable aid or instrument of commerce, and its regulation by virtue of the clause belongs to Congress, and that the act in question is a lawful exercise of this power.

Every species of property which is the subject of commerce, or which is used or even essential in commerce, is not brought by this clause within the control of Congress. The barrels and casks, the bottles and boxes, in which alone certain articles of commerce are kept for safety and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of Congressional legislation more than other property. (*Nathan v. Louisiana*, 8 How., 73.) In *Paul v. Virginia* (8 Wall., 168) this court held that a policy of insurance made by a corporation of one State on property situated in another was not an article of commerce, and did not come within the purview of the clause we are considering. "They are not," says the court, "commodities to be shipped or forwarded from one State to another, and then put up for sale." On the other hand, in *Almy v. State of California* (24 How., 169) it was held that a stamp duty imposed by the legislature of California on bills of lading for gold and silver transported from any place in that State to another out of the State, was forbidden by the Constitution of the United States, because such instruments being a necessity to the transaction of commerce, the duty was a tax upon exports.

The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, we propose to leave undecided. We adopt this course because when this court is called on in the course of the administration of the law to consider whether an act of Congress or of any other department of the Government is within the constitutional authority of that department, a due respect for a coordinate branch of the Government requires that we shall decide that it has transcended its powers only when that is so plain that we can not avoid the duty.

In such cases it is manifestly the dictate of wisdom and judicial propriety to decide no more than is necessary to the case in hand. That such has been the uniform course of this court in regard to statutes passed by Congress will readily appear to anyone who will consider the vast amount of argument presented to us assailing them as unconstitutional, and he will count, as he may do on his fingers, the instances in which this court has declared an act of Congress void for want of constitutional power.

Governed by this view of our duty, we proceed to remark that a glance at the commerce clause of the Constitution discloses at once what has been often the subject of comment in this court and out of it, that the power of regulation there conferred on Congress is limited to commerce with foreign nations, commerce among the States, and commerce with the Indian tribes. While bearing in mind the liberal construction that commerce with foreign nations means commerce between citizens of the United States and citizens and subjects of foreign nations, and commerce among the States means commerce between the individual citizens of different States, there still remains a very large amount of commerce, perhaps the largest, which, being traffic between citizens of the same State, is beyond the control of Congress.

When, therefore, Congress undertakes to enact a law which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes. If not so limited, it is in excess of the power of Congress. If its main purpose be to establish a regulation applicable to all trade, to commerce at all points, especially if it be apparent that it is designed to govern the commerce wholly between citizens of the same State, it is obviously the exercise of a power not confided to Congress.

We find no recognition of this principle in the chapter on trade-marks in the Revised Statutes. We would naturally look for this in the description of the class of persons who are entitled to register a trade-mark, or in reference to the goods to which it should be applied. If, for instance, the statute described persons engaged in a commerce between the different States and related to the use of trade-marks in



such commerce, it would be evident that Congress believed it was acting under the clause of the Constitution which authorizes it to regulate commerce among the States. So if, when the trade-mark has been registered, Congress had protected its use on goods sold by a citizen of one State to another, or by a citizen of a foreign State to a citizen of the United States, it would be seen that Congress was at least intending to exercise the power of regulation conferred by that clause of the Constitution. But no such idea is found or suggested in this statute. Its language is: "Any person or firm domiciled in the United States, and any corporation created by the United States or of any State or Territory thereof," or any person residing in a foreign country which by treaty or convention affords similar privileges to our citizens, may by registration obtain protection for his trade-mark. Here is no requirement that such person shall be engaged in the kind of commerce which Congress is authorized to regulate. It is a general declaration that anybody in the United States, and anybody in any other country which permits us to do the like, may, by registering a trade-mark, have it fully protected. So, while the person, registering is required to furnish "a statement of the class of merchandise, and the particular description of the goods comprised in such class, by which the trade-mark has been or is intended to be appropriated," there is no hint that the goods are to be transported from one State to another, or between the United States and foreign countries. Section 4939 is intended to impose some restriction upon the Commissioner of Patents in the matter of registration, but no limitation is suggested in regard to persons or property engaged in the different classes of commerce mentioned in the Constitution. The remedies provided by the act when the right of the owner of the registered trade-mark is infringed, are not confined to the case of a trade-mark used in foreign or interstate commerce.

It is therefore manifest that no such distinction is found in the act, but that its broad purpose was to establish a universal system of trade-mark registration for the benefit of all who had already used a trade-mark, or who wished to adopt one in the future, without regard to the character of the trade to which it was to be applied or the residence of the owner, with the solitary exception that those who resided in foreign countries which extended no such privileges to us were excluded from them here.

It has been suggested that if Congress has power to regulate trade-marks used in commerce with foreign nations and among the several States these statutes shall be held valid in that class of cases, if no further. To this there are two objections: First, the indictments in these cases do not show that the trade-marks which are wrongfully used were trade-marks used in that kind of commerce. Secondly, while it may be true that when one part of a statute is valid and constitutional and another part is unconstitutional and void the court may enforce the valid part where they are distinctly separable so that each can stand alone, it is not within the judicial province to give to the words used by Congress a narrower meaning than they are manifestly intended to bear in order that crimes may be punished which are not described in language that brings them within the constitutional power of that body. This precise point was decided in *United States v. Reese* (92 U. S., 214). In that case Congress had passed a statute punishing election officers who should refuse to any person lawfully entitled to do so the right to cast his vote at an election. This court was of the opinion that, as regarded the section of the statute then under consideration, Congress could only punish such denial when it was on account of race, color, or previous condition of servitude.

It was urged, however, that the general description of the offense included the more limited one, and that the section was valid where such was in fact the cause of denial. But the court said, through the Chief Justice:

"We are not able to reject a part which is unconstitutional and retain the remainder, because it is not possible to separate that which is constitutional, if there be any such, from that which is not. The proposed effect is not to be attained by striking out or disregarding words that are in the section, but by inserting those that are not there now. Each of the sections must stand as a whole or fall together. The language is plain. There is no room for construction, unless it be as to the effect of the Constitution. The question, then, to be determined is whether we can introduce words of limitation into a penal statute so as to make it specific, when, as expressed, it is general only. \* \* \* To limit this statute in the manner now asked for would be to make a new law, not to enforce an old one. This is no part of our duty."

If we should, in the case before us, undertake to make by judicial construction a law which Congress did not make, it is quite probable we should do what, if the matter were now before that body, it would be unwilling to do, namely, make a trade-mark law which is only partial in its operation, and which would complicate the rights which parties would hold—in some instances under the act of Congress, and in others under State law. (*Cooley, Const. Lim.* 178, 179; *Commonwealth v. Hitchings*, 5 Gray (Mass.), 482.)

In what we have here said we wish to be understood as leaving untouched the whole question of the treaty-making power over trade-marks and of the duty of Congress to pass any laws necessary to carry treaties into effect.

While we have, in our references in this opinion to the trade-mark legislation of Congress, had mainly in view the act of 1870 and the civil remedy which that act provides, it was because the criminal offenses described in the act of 1876 are, by their express terms, solely referable to frauds, counterfeits, and unlawful use of trade-marks which were registered under the provisions of the former act. If that act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it.

The questions in each of these cases being an inquiry whether these statutes can be upheld in whole or in part as valid and constitutional must be answered in the negative; and it will be

*So certified to the proper circuit courts.*

#### FORTY-FIFTH CONGRESS.

H. R. 2524.—A bill to amend section 4937 of the Revised Statutes, in relation to trademarks. Introduced by Hon. James F. Briggs, of New Hampshire, January 21, 1878. Referred to the Committee on Patents. Not reported.

[House of Representatives, second session, January 21, 1878, Cong. Record, vol. 7, part 1, p. 441.]

#### TRADEMARKS.

Mr. Briggs introduced a bill (H. R. 2524) to amend section 4937 of the Revised Statutes, in relation to trademarks; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

#### FORTY-SIXTH CONGRESS.

Four bills and two resolutions were introduced in the House of Representatives in this Congress, and one bill in the Senate.

H. Res. 125.—A joint resolution proposing an amendment to the Constitution of the United States giving Congress power to grant and protect trademarks. Introduced by Hon. Moses A. McCoid, of Iowa, December 2, 1879. Referred to the Committee on Manufactures. H. R. 5088 reported as a substitute.

[House of Representatives, second session, December 2, 1879, Cong. Record, vol. 10, part 1, p. 17.]

#### AMENDMENT TO CONSTITUTION.

Mr. McCoid, by unanimous consent, introduced a joint resolution (H. Res. 125) proposing an amendment to the Constitution of the United States, giving Congress power to grant and protect trademarks; which was read a first and second time, referred to the Committee on Manufactures, and ordered to be printed.

[House of Representatives, second session, December 11, 1879, Cong. Record, vol. 10, part 1, p. 78.]

#### REGULATION OF TRADEMARKS.

Mr. McCoid. I ask, by unanimous consent, to report back from the Committee on Manufactures a joint resolution (H. Res. 125) proposing an amendment to the Constitution of the United States; and I move that the accompanying report be printed and recommitted with the joint resolution.

The SPEAKER. The gentleman from Iowa gives notice, so the House may be apprised of the fact, that he proposes to bring back the joint resolution by a motion to reconsider. That requires unanimous consent.



Mr. McCoid. The committee wish to have leave to report at any time.

Mr. FERNANDO WOOD. What is the subject-matter?

The SPEAKER. The joint resolution will be read.

The Clerk read as follows:

*Resolved, &c., That the following amendment to the Constitution of the United States be proposed to the Legislatures of the several States:*

#### ARTICLE —.

SECTION 1. Congress, for promotion of trade and manufactures, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks.

That this amendment shall be valid when ratified by the Legislatures of three-fourths of the States.

Mr. FERNANDO WOOD. I object.

The SPEAKER. Does the gentleman object to receiving the report and ordering its printing and recommitment?

Mr. FERNANDO WOOD. No; but I do object to this question being brought back under a motion to reconsider.

The SPEAKER. Then the gentleman from Iowa can report when his committee is called.

The report was ordered to be printed and, with the joint resolution, recommitment, not to be brought back by a motion to reconsider.

The report of the committee is as follows:

The Committee on Manufactures, to whom was referred House resolution No. 125, having had the same under consideration, do make the following report thereon:

The joint resolution proposes an amendment to the Constitution of the United States of great and immediate importance. The amendatory article proposed is as follows:

#### "ARTICLE —.

"SECTION 1. Congress, for promotion of trade and manufacture, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks."

The occasion for the proposal of such an amendment, as is probably well known to every member of the House, is peculiar. Under the eighth section of article 1 of the Constitution Congress assumed the power granted by this amendment by the act of July 8, 1870, entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights." That portion of said act material to this subject is as follows:

"Any person or firm domiciled in the United States, and any corporation created by the authority of the United States, or of any State or Territory thereof, and any person, firm, or corporation resident of or located in any foreign country which, by treaty or convention, affords similar privileges to citizens of the United States, and who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following requirements:

"First. By causing to be recorded in the Patent Office a statement specifying the names of the parties, and their residences and place of business, who desire the protection of the trade-mark; the class of merchandise and the particular description of goods comprised in such class by which the trade-mark has been or is intended to be appropriated; a description of the trade-mark itself, with fac-similes thereof showing the mode in which it has been or is intended to be applied and used, and the length of time, if any, during which the trade-mark has been in use.

"Second. By making payment of a fee of \$25 in the same manner and for the same purpose as the fee required for patents.

"Third. By complying with such regulations as may be prescribed by the Commissioner of Patents."

Under these statutes it was further provided that such trade-marks should remain in force for thirty years, subject to indefinite renewals. The common-law remedies for infringement were also enacted.

In August, 1876, further protection was given to the grantees of trade-marks by providing for the punishment of the fraudulent use, sale, and counterfeiting of such commercial symbols by fine and imprisonment.



Under these statutes the United States has registered trade-marks as follows:

*Trade-marks registered and fees received by Patent Office in trade-mark cases.*

	Cases.
In 1871 .....	509
In 1872 .....	531
In 1873 .....	534
In 1874 .....	648
In 1875 .....	1,035
In 1876 .....	1,081
In 1877 .....	1,416
In 1878, (to October) .....	1,336
	7,090, at \$25, \$177, 250
Remainder of 1878 .....	\$4,600
To December 9, 1879 .....	26,875
	31,475
	208,725
Registered in 1870, 121 cases, at \$25 .....	3,025
	211,750
Total registered, 7,785; total receipts .....	

And has received in fees the sum of \$211,750. Has entered into treaty obligations for the mutual protection of trade-marks with Great Britain, June 1, 1879; the Austria-Hungarian Empire, June 1, 1872; Belgium, July 30, 1869; France, April 16, 1869; the German Empire, June 1, 1872; Russia, January 27, 1868; Brazil, June 17, 1879.

The business men of the world have awakened to the fact that manufacture and trade require national and international control and protection of genuine commercial signatures to identify and distinguish property made and marketed by cosmopolitan tradesmen. At this juncture the commercial world is astonished to find that alone among the nations the United States has no power to grant, protect, or regulate trade-marks. This has been finally determined by the recent decision of the Supreme Court of the United States at the October term, 1879, in the cases of *The United States v. Emil Stiffins*; *Same v. Adolph Witteman*; *Same v. W. W. Johnson*, *F. E. McNamara*, and *N. S. Reeder*.

As but a limited number of copies of that decision has been published, and it is so able and comprehensive as to be incapable of a satisfactory synopsis, your committee has deemed it best to set out the entire opinion. [See opinion attached.]

This, then, is the occasion which has arisen for the proposed change in the fundamental charter of the Government.

There arises two questions as to the propriety and necessity of the amendment:

First. Is the subject of sufficient importance to demand of the States this additional grant of constitutional power to the General Government?

Second. Is it a matter of such character as to require the legislative control of the National Government, instead of being left to the local legislation of the several States?

In answer to the first question, your committee deem it necessary to add but little to the facts already stated in the history of congressional and international action upon the subject.

The following considerations may be added:

The paramount interest of the Government to protect the innocent purchasers of manufactured goods from deception, frauds, and countless impositions. The beneficial effects of encouraging the establishment and maintenance of good commercial character on part of manufacturers protected by law. The stimulating and energizing the trade and commerce of our own people; giving them equal chances with citizens of other nations.

Trade-marks are now universally regarded as necessary to business. They have grown into use with the growth of civilization and progressive trade. All manufactures, all kinds of business adopt and use them. They are the ensigns of honor and popularity under which business men ship their goods from State to State and nation to nation. And now our commerce challenges the competition of the most prosperous countries. We are fast becoming the merchants; and our ingenious, industrious, and enterprising people, above all others, need this commercial proprietary protection.

As to the second question, your committee regard this as peculiarly the subject of national legislative control.

Nothing could be more detrimental to the interests of manufacture, trade, and commerce than the unharmonious local and conflicting legislation which would necessarily arise if this subject should be left to the States. The interest and safety of all demand that it, along with the power of making war, peace, and treaties, of taxation, regulating commerce and coining money, of granting patents and copyrights, should be vested in the General Government.

No one State could adequately protect her own citizens, much less the citizens of other States. The mere civil rights existing at common law are insufficient and impractical. No criminal law of a State can be framed comprehensive enough to cover violations of the rights of persons injured.

The treaty-making power, of which this becomes an incident, belongs solely to the General Government.

The various countries of the world have assumed national control of this subject. Austria passed a law granting and protecting trade-marks December 7, 1858, with general provisions and penalties such as our present laws of Congress. Bavaria has had such a law since 1840. In Belgium trade-marks are governed by the decree of 1801, the law of 1803, and decree of 1810. Great Britain has the "merchandise marks act" of 1862. France passed such a law June 23, 1857. Prussia, Sardinia, Spain, Würtemberg, each have protective laws.

The subject is not local. A trade-mark is ubiquitous. It knows no State line. It is of the essential nature of a patent and a copyright, in the method of its grants, regulations, and protection.

In the interest of revenue and economy of government it is also an important national subject. It is a source of considerable revenue.

The Government has already received at the hands of grantees of trade-marks under the laws now declared unconstitutional \$———. This sum must be refunded in justice to such parties unless the consideration for its receipt is made good by the adoption of this amendment and legislation under it.

All these rights are now suspended and await action. Many of the State Legislatures meet this winter, and may ratify the proposed amendment at once.

Your committee therefore, in view of these facts, regard this resolution of immediate importance and recommend its passage before adjournment for vacation.

[House of Representatives, second session, December 17, 1879, Cong. Record, vol. 10, part 1, pp. 145-148.]

#### TRADEMARKS.

Mr. McCoid, from the Committee on Manufactures, reported back with a favorable recommendation the joint resolution (H. Res. 125) proposing an amendment to the Constitution of the United States.

The joint resolution was read, as follows:

*Resolved, &c.,* That the following amendment to the Constitution of the United States be proposed to the Legislatures of the several States:

#### ARTICLE —.

SECTION 1. Congress, for promotion of trade and manufactures, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks.

That this amendment shall be valid when ratified by the Legislatures of three-fourths of the States.

Mr. McCoid. I ask the Clerk to read the report of the committee.  
The Clerk read as above.

\* \* \* \* \*

Mr. McCoid. Mr. Speaker, I had hoped that there would be no opposition to this resolution, having been induced so to believe from general consultation with members. The objection made this morning is not to the substance of the resolution; and I have heard no substantial objection from any member either on this floor or out of the House. I believe there is no objection to the substance of the resolution. But it is said that it ought to have come from the Judiciary Committee. I think that is a mistake. The subject of trade-marks is peculiarly a subject within the province of the Committee on Manufactures; and has been so considered by the House, as indicated

by the reference of the resolution to that committee. The committee met and considered the resolution; referred it to a subcommittee. That subcommittee gave it careful consideration, both as to the necessity and propriety of the measure and as to the form in which it is presented, and they unanimously made a favorable report to the committee. The full committee, after careful consideration, reported unanimously in favor of the resolution. This measure, then, comes before the House upon a unanimous report of a committee to whom it was referred in regular order by direction of the House. It seems to me that the committee deserves the courtesy and consideration of this House, and that this report ought to be considered sufficient. The only province of the Judiciary Committee would be to consider the form of this resolution—whether it is in proper form for incorporation in the Constitution; whether it complies with the constitutional provisions with reference to amendments.

Now, that matter is easily settled; and it really has been settled. I will state to members of the House that this resolution was submitted to the chairman of the Committee on the Judiciary [Mr. Knott], and I believe it meets his hearty approval, both as to substance and form. It has met with no objection.

A few words as to the importance of considering at present this unanimous report coming from the committee to whom the subject properly belongs. This winter the legislatures of twenty-one States meet. Almost all of them will not meet again until two years from this winter; hence the importance of submitting the amendment to the State legislatures this winter. These bodies meet generally on the 1st of January next. One State legislature is now in session—perhaps two or three; but one has been in session since November, and will probably soon adjourn. To give this amendment the proper ratification two-thirds of the States must concur. Now, as gentlemen will see, it is no captious, unfair, or precipitate spirit that induces the committee to ask action upon it at this time.

Upon the merits of the question allow me to say a single word. Congress has acted upon the supposition that it had power to legislate upon trademarks—to grant, regulate, and protect them. Since 1870 our legislation has proceeded upon the supposition that this power was included in the power of Congress to grant patents and copyrights. But the Supreme Court of the United States at its last term has decided that no such power is vested in Congress under the Constitution, either under the clause to which I have just referred or under the clause with reference to commerce or any other clause; so that all the legislation of Congress on this subject has fallen to the ground for want of constitutional power to enact it. In the exercise of this supposed power the Government has issued about 8,000 trademarks and has received \$211,000 in fees. All these trademarks are now worthless so far as Congressional action is concerned, and the money received by the Government as fees is without consideration, and in justice and equity will have to be refunded to the parties by whom it has been paid. Assuming Congress to possess this power, we have entered into treaties with the German Empire, with France, with Belgium, with Austria, and other nations. I have some extracts from these treaties. These countries have national laws on the subject of trademarks. They protect our trademarks in their countries; and in these treaties we have agreed to protect their trademarks. But I ask gentlemen to observe that the power to enforce these treaties would not give us the power to protect



these trademarks. I read the language of the treaty with the German Empire with reference to trademarks.

We agree to give the same protection to the citizens of that Empire that we do to citizens of this country. Under this decision of the Supreme Court we have no power to give protection to citizens of this country; and, therefore, we have no power to enforce that treaty in protecting the trademarks of that nation with whom we have entered into a solemn treaty obligation to meet its concurrent action in that respect.

With France, the terms of the treaty are, "just as if the plaintiff were a subject or citizen of that country." We are to give them that protection. We have no power to give protection to citizens of this country, and therefore no power to give protection to citizens of France any more than to our own citizens.

In the treaty with Austria, the language is this: "Shall give to the injured party ground for such action or proceeding to prevent such reproduction, and to recover damages for the same, as may be authorized by the laws of the country in which the counterfeit is proven, just as if the plaintiff was a citizen of that country." We can give their citizens no protection because we can give our own none. We can give theirs only what we can give our own. So gentlemen will see this grant of power is important in reference to treaties with foreign nations.

It comes home to every man's district, to every man's constituents. I have no doubt there is not a single citizen represented upon the floor of this House who would not urge the immediate passage of this joint resolution. I have letters from various parts of the country urging this action. There is not a member of the House who has made a single objection to it. The form of the resolution is as it should be. I ask gentlemen who have opposed ordering the main question to be put not to carry that opposition to voting against the passage of the joint resolution.

Mr. ARMPFIELD. Mr. Speaker, I am opposed to this joint resolution, not because it does not come from the Judiciary Committee, but because I believe it to be totally unnecessary to amend the Constitution of the United States in order to attain the object which the gentleman from Iowa seeks.

It is true the Supreme Court of the United States has decided that the present trademark law is unconstitutional. They place that decision upon the ground that Congress undertook to legislate on the subject of trademarks under the wrong clause of the Constitution; that Congress undertook to assume jurisdiction over this subject under the clause which allows Congress to grant patents, to grant copyrights to the authors of books, etc. The Supreme Court have decided that a trademark has no affinity to patent-rights or to copyrights; and they indicate in that decision what I believe to be perfectly clear, that trademarks come under the commerce clause of the Constitution, that clause which gives Congress power to regulate commerce between the States and foreign nations.

I have had the honor to present a bill to this House, which has been referred to the Committee on Commerce, which, I think, will avoid the constitutional difficulty and fully attain the end the gentleman desires.

Under that clause which allows Congress to regulate commerce between the States and foreign nations Congress has full power to

protect trademarks so far as they are used in interstate commerce and commerce with foreign nations. And this is all that is necessary. It is no more necessary for the Congress of the United States to protect trademarks within the boundaries of a State than it is for them to protect the cattle trade of a State or the corn or cotton trade of a State. The law of the States and the common law fully protect a man's right to a trademark, and all that is necessary is for Congress to pass a law to protect trademarks when used in commerce between different States and with foreign nations. My bill, I think, fully covers the ground and attains the end. I do not think it is best, whenever we find Congress lacks some power under the Constitution, to rush in with hot haste to give that power to Congress without first inquiring whether it is necessary.

Mr. McCoid. I should like to ask the gentleman a question.

Mr. Armfield. Certainly.

Mr. McCoid. Does not the reasoning of the decision of the Supreme Court cover the whole point that trademarks can not be regulated under the power to control commerce?

Mr. Armfield. Not at all, as I understand it. I have read the decision, and understand they decided it is only unconstitutional because Congress attempted to regulate commerce within the boundaries of a State. The bill I have prepared, I will state to the gentleman, has been examined by some of the best lawyers of the United States of both political parties, and every lawyer to whom it has been submitted is of the opinion that it will completely avoid the constitutional objection found in the decision of the Supreme Court of the United States, and that it will insure all necessary protection to trademarks.

Mr. Samford. Where is it?

Mr. Armfield. In the hands of the Committee on Commerce.

Mr. Cox. It is very evident, Mr. Speaker, from the statement made by my friend from North Carolina and the statement of the gentleman from Iowa that this measure needs the revision of the Judiciary Committee. I think the bill of my friend ought also to be referred to that committee, which has its special function to look after these matters connected with constitutional interpretation.

I had something to do with the passage of this bill about trademarks. It passed without much discussion. Whether it came under that clause in the eighth section about copyright, about authors and inventors, or whether it came under the clause as to commerce, it is no matter now, for the Supreme Court have decided these trademarks, as we at present legalize them, are not constitutional.

Then comes the further question that we have made treaties with foreign powers as to these trademarks, guaranteeing them under certain conditions. The question arises, is a treaty the paramount law of the land? The Constitution says so. How far has that been interpreted so as to reach trademarks? These questions need very careful judicial interpretation. This is a fresh decision of the Supreme Court which comes in collision with a long line of decisions. We have received over \$200,000 in payment of fees on this business. Our trade is being disorganized because of this decision. Let us, therefore, without passing on the merits of either of the bills, refer them to the Judiciary Committee, in order that we may have a judicial and judicious report. I will make that motion, if it be in order, directly.

The Speaker. It is not in order.

Mr. Horr. Mr. Speaker, the only objection in private conversation  
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that I have heard to this bill is that it comes from the wrong committee. Now, being a member of the Committee on Manufactures, I desire in the first place to speak for a moment on that point. When I came here I had an exceeding desire that I might get on a committee that should sound big and have little to do; and if our Speaker had the powers of a modern clairvoyant he could not have hit my case better than he did. [Laughter.] Why, sir, every paper in my district has announced that I am on the important Committee on Manufactures. [Laughter.]

I wish to say, Mr. Speaker, that I feel a little sensitive about this bill. It is the only child that committee has got [laughter], and, as near as I can learn, it is the only one they ever have had. [Renewed laughter.] In searching back through the records of that committee we have as yet been unable to find that for the last eighteen years there has ever been anything which was proposed by our committee that did not immediately take its flight to the Judiciary Committee. You can see, therefore, why I am naturally sensitive about this. We considered this an important bill, and if it is to be jeopardized by the fact that it is not in the hands of the right committee, I say we should transfer it in any way to get it in shape, because, if it is to do the country immediate good it should be passed before the holidays, because the legislatures are so soon coming together. I suppose every member of this House knows that the decision of the Supreme Court injured largely our great manufacturing interests all over the land. It is not sectional.

Mr. COX. My friend will allow me to make a practical suggestion. I think, from the vote already taken in the House, it is perfectly sure two-thirds will not vote for this measure without some more mature consideration. If my friend from North Carolina wants to kill this bill—

Mr. HERR. From where?

A MEMBER. He said from North Carolina. [Laughter.]

Mr. HERR. No, from Michigan; but I can stand almost anything, Mr. Speaker. [Laughter.]

Mr. COX. My friend, I know his name—

Mr. WRIGHT. What is it?

Mr. COX. I do not want to say, sir. [Laughter.] I was about to suggest to my friend from Michigan that if he wants the bill really passed so as to submit it in time to the State legislatures—if he wants to relieve the great industry bound up with these trademarks—he had better allow it to go to the Committee on the Judiciary, for the last vote we have had indicates his bill may be throttled—that this little bantling may be considered illegitimate. [Laughter.]

Mr. HERR. The gentleman should not forget that the vote was taken before I made this explanation. [Laughter.] There is hardly anything I would not yield to my genial little friend from New York. [Laughter.]

Mr. COX. I waive size. [Laughter.]

Mr. HERR. But I am not sure, Mr. Speaker, but his suggestion is a wise one. While we on the Committee on Manufactures, so far as I know, have for this bantling the affection of a parent, we still are willing to yield anything for the sake of its passage. As my friend from Iowa stated, there have already been collected over \$200,000 of fees which are now declared, perhaps, illegally collected. Our Government may be asked to refund money paid for something which it could not



grant. I do not believe there is a gentleman on either side of this House who does not believe it best that our General Government should have some control over this business of trademarks. I am not captious about it. What I want is that that course shall be taken which shall result in the passage of this bill, but I yield to older and wiser men in this House who have had more experience than I have had, to determine what that course shall be.

I do not wish to embarrass the bill by seeking to drive it to a vote at an improper time. All I wish to say is that I believe the manufacturing interests of the country demand that a measure of this kind shall be passed now. I think the decision of the Supreme Court prevents any one absolutely from getting any protection on this question except what can be got by an action at common law. In most cases that remedy is worthless, because the damages in each case of violation are so slight.

The trespasses upon the law are so numerous that it is utterly impossible in that way to get your remedy and have it of any value to the interests that are affected by this law having been declared unconstitutional. I do hope the members of the House will see to it that the measure is not entirely killed here and now, for I believe we all want the same thing.

Mr. McCORD. I wish to say a word in reply to the gentleman on my left [Mr. Armfield], who supposes that his bill will bring this within the constitutional power of Congress by making it a regulation of commerce. The Supreme Court has expressly distinguished the difference between articles of commerce and trademarks. A trademark is not an article of commerce. The question of transit from State to State or from nation to nation has no reference to trademarks. The office of the trademark is to distinguish the goods of a certain manufacturer. Because the articles upon which a trademark is stamped are shipped in commerce, that does not give Congress the power to regulate a trademark; and the Supreme Court has made that express distinction. They refer to the very argument which has been used by the gentleman from North Carolina:

The argument is that the use of a trademark—that which alone gives it any value—is to identify a particular class or quality of goods as the manufacture, produce, or property of the person who puts them in the general market for sale; that the sale of the article so distinguished is commerce. The trademark is, therefore, a useful and valuable aid or instrument of commerce, and its regulation by virtue of the above provision of the Constitution belongs to Congress, and that the act in question is a lawful exercise of this power.

Now they take that argument, and expressly say the trademark is not included:

It is not every species of property which is the subject of commerce, or which is used or even essential in commerce, which is brought by this clause of the Constitution within the control of Congress.

They go on to give reasons to show that the power to control commerce does not give the power to control trademarks. If the gentleman will read that portion of the decision on page 5 of the report he will find that clearly made out by the decision of the Supreme Court.

If I believed that was a good position which the gentleman takes I would see no necessity for passing this resolution. And further, if I believed that if the resolution were referred to the Judiciary Committee that committee would report back before the recess, I would have no objection to that course. If we could include that as an instruction to report back before the recess, or at the assembling of the House

after the recess, and thus have some reasonable prospect that the resolution would pass in time to get to the legislatures, I would not object.

Mr. COX. I ask unanimous consent that both these bills be referred to the Committee on the Judiciary, with leave to report at any time. Whenever the committee come to an agreement they can report. I think the gentleman had better accept that.

Mr. MCCOY. I am constrained to consent to something of that kind, because I do not wish to jeopardize the resolution.

The SPEAKER. It is proposed that further proceedings under the ordering of the main question be vacated and that, by unanimous consent, this bill go, with a bill now in the hands of the Committee on Commerce, introduced by the gentlemen from North Carolina [Mr. ARMFIELD], to the Committee on the Judiciary, with leave to that committee to report thereon at any time. The Chair hears no objection.

The joint resolution was accordingly referred to the Committee on the Judiciary, and the Committee on Commerce was discharged from the further consideration of the bill (H. R. 2573) to authorize registration and protection of trademarks; and the same was also referred to the Committee on the Judiciary, with leave to that committee to report on the joint resolution and bill at any time.

H. R. 2573.—A bill to authorize registration and protection of trademarks. Introduced by Hon. R. F. Armfield, of North Carolina, December 9, 1879. Referred to Committee on Commerce. H. R. 5088 reported as a substitute.

[House of Representatives, second session, December 9, 1879, Cong. Record, vol. 10, part 1, p. 38.]

#### TRADEMARKS.

Mr. Armfield introduced a bill (H. R. 2573) to authorize registration and protection of trademarks; which was read a first and second time, referred to the Committee on Commerce, and ordered to be printed.

[House of Representatives, second session, December 17, 1879, Cong. Record, vol. 10, part 1, p. 148.]

\* \* \* The Committee on Commerce was discharged from the further consideration of the bill (H. R. 2573) to authorize registration and protection of trademarks; and the same was also referred to the Committee on the Judiciary.

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[House of Representatives, second session, January 6, 1880, Cong. Record, vol. 10, part 1, p. 197.]

#### TRADEMARKS.

Mr. Reagan also, by unanimous consent, from the same committee [Commerce] reported back the bill (H. R. 2573) to authorize registration and protection of trademarks; and moved that the committee be discharged from the further consideration of the same, and that it be referred to the Committee on the Judiciary.

The motion was agreed to.

The bill is as follows:

A BILL to authorize registration and protection of trade marks.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be in the Department of the Interior an officer learned in the law, to be called the registrar of trade marks who shall be appointed by the President of the United States, by and with the advice and consent of the Senate, and shall be entitled to a salary of three thousand five hundred dollars a year, to be paid monthly.

SEC. 2. Owners of trade marks used in commerce with foreign nations, or among the several States, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country which by treaty, convention, or law affords similar privileges to citizens of the United States, may obtain registration of such trade mark by complying with the following requirements:



First: By depositing in the office of said registrar a written application specifying name, domicile, location and citizenship of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trade mark has been appropriated; a description of the trade mark itself, with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade mark has been used.

Second: By paying into the Treasury of the United States the sum of twenty-five dollars.

SEC. 3. The application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration, verified by the person or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade mark sought to be registered, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade mark is used in commerce, as above indicated, and other than that which is wholly between citizens of the same State; and that the description and fac-similes presented for registry truly represent the trade mark sought to be registered.

SEC. 4. The time of receipt of any such application shall be noted and recorded. But no alleged trade mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign or interstate commerce, as above mentioned, or is within the provision of a treaty, convention or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade mark as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. In an application for registration the registrar shall decide the presumptive lawfulness of claim to the alleged trade mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases. From a final decision of the registrar a summary appeal shall lie to the supreme court of the District of Columbia, sitting in banc.

SEC. 5. Certificates of registry of trade marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Secretary of said Department and countersigned by the registrar of trade marks, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade marks, and of statements and declarations filed therewith, and certificates of registry so signed and sealed, shall be evidence in any suit in which such trade mark shall be brought in controversy.

SEC. 6. A certificate of registry shall remain in force for thirty years from its date, except in cases where the trade mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country, by virtue of (their) act, at the time that such trade mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years, such registration may be renewed on the same terms and for a like period.

SEC. 7. Applicants for registration under this act shall be credited for any fee, or part of a fee, heretofore paid by them into the Treasury of the United States with intent to procure protection for the same trade-mark.

SEC. 8. Registration of a trade mark shall be prima facie evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the wrongful use of said trade mark, at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade mark used in foreign or interstate commerce, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act, and Courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

SEC. 9. No action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

SEC. 10. Any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade mark, or an entry respecting a trade mark, in the office of the registrar of trade marks, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sus-



tained in consequence thereof to the injured party, to be recovered in an action in the case.

SEC. 11. Nothing in this act shall prevent, lessen, impeach or avoid any remedy in law or in equity which any party aggrieved by any wrongful use of any trade mark might have had if the provisions of this act had not been passed.

SEC. 12. Nothing in this act shall be construed as unfavorably affecting a claim to a trade mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade mark in controversy is used on goods intended to be transported from one state to another state for the purpose of commerce, or to a foreign country, or in lawful commercial intercourse with an Indian tribe.

SEC. 13. The registrar shall prescribe rules for assignments for duly registered trade marks and the recording thereof in his office.

H. R. 2981.—A bill providing a stamp tax on certain articles, and to afford incidental protection to trademarks. Introduced by Hon. Lucien B. Caswell, of Wisconsin, December 15, 1879. Referred to Committee on Patents. Not reported.

[House of Representatives, second session, December 15, 1879, Cong. Record, vol. 10, part 1, p. 112.]

#### TRADEMARKS.

Mr. Caswell also introduced a bill (H. R. 2981) providing a stamp tax on certain articles, and to afford incidental protection to trademarks; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

H. R. 5088.—A bill to authorize the registration of trademarks and to protect the same. Introduced by Hon. N. J. Hammond, of Georgia, March 12, 1880. Reported as a substitute for H. R. 2573 and H. Res. 125. Passed in House and in Senate. Approved by the President, March 3, 1881 (21 U. S. Stat. L., p. 502, chap. 138.)

[House of Representatives, second session, March 12, 1880, Cong. Record, vol. 10, part 2, p. 1514.]

#### TRADEMARKS.

Mr. Hammond, of Georgia, from the Committee on the Judiciary, to whom was referred House resolution No. 125, "to amend the Constitution of the United States," and a bill (H. R. 2573) "to authorize the registration and protection of trademarks," and several petitions on the same subject, by unanimous consent, reported, as a substitute, a bill (H. R. 5088) to authorize the registration of trademarks, and to protect the same; which was read a first and second time, and, with the accompanying report, recommitted, and ordered to be printed.

[House Report No. 561, Forty-sixth Congress, second session.]

#### REPORT BY COMMITTEE ON THE JUDICIARY ON PROPOSED AMENDMENT TO THE CONSTITUTION AND H. R. 2573, TO AUTHORIZE REGISTRATION OF TRADEMARKS, ETC.

At the October term, 1879, the Supreme Court of the United States decided the case of *Emil Steffens and others* *advs.* The United States, being indictments for violations of the trademark acts of the United States. They held those acts to be void because unconstitutional. As the opinion states the character of those acts and why they are unconstitutional, and that this report may be full and clear, we present it entire, as follows:

#### DECISION OF THE SUPREME COURT.

Mr. Justice Miller delivered the opinion of the court. (See ante, p. 413.)

The bill seeks to reenact substantially the trademark legislation of 1870 (Rev. Stat., secs. 4937-4947, inclusive), save that it is confined to

foreign and interstate commerce. Its theory is that by thus separating them from interstate commerce the objections of the Supreme Court as to constitutionality will be removed.

The resolution to amend the Constitution is as follows:

ARTICLE XVI.

SECTION 1. Congress, for promotion of trade and manufacture, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks.

It is based upon the idea that such legislation, though confined to foreign and interstate commerce, is unconstitutional, or its advocates may only fear that that may be so, and wish the amendment *ex abundante cautela*, and to give confidence to those using trademarks.

If the Congress of the United States now has power to pass such laws, the amendment would be useless. Has it that power?

After careful consideration we are of opinion that it has not. The Supreme Court in the foregoing opinion avoided deciding that question. A trademark is a convenience of commerce. Its purpose is to identify the thing to be sold. But it is no more than the guaranty in writing, or by some words, sign, or device, attached to the thing to be sold, that it is what the seller represents it to be by such writing, etc. By themselves they are not merchandise. Their only use is to attach to merchandise for such identification. They are not necessary to commerce. On the countless things sold in this country, foreign and domestic, there are no trademarks but on about 8,000.

In *Paul v. Virginia* (8 Wallace) the court held that Congressional control did not cover policies of insurance sent from one State of the Union into another where a premium was paid therefor. They said the policies were but "mere contracts of indemnity against loss by fire." We think trademarks mere contracts of indemnity against loss by fraud.

Thus the Supreme Court has held a contract to be within Federal control in *Almy v. California*. That was a bill of lading for goods to be shipped out of the State. But that decision rested solely upon the ground that "a bill of lading or some other instrument of the same import is necessarily always associated with every shipment of articles of commerce from the ports of one country to another. The necessities of commerce require it." (See *Almy v. California*, 24 Howard, 170.) And that decision rests not on the power of Congress over commerce, but on the prohibition against the States taxing exports, etc. The bill of lading was but evidence of the contract of shipping. Taxing it taxed the exported article. And in the *Pennsylvania Telegraph Company v. Western Union Telegraph Company* (96 U. S. R., 9) the court pronounced the telegraph "one of the necessities of commerce. It is indispensable as a means of intercommunication, but especially so in commercial transactions." We think this last case could better stand on the power "to establish post-offices and post-roads." Yet, if put on the commerce clause, it, like *Almy v. California*, is based on the necessity of the thing legislated upon to foreign or interstate or Indian commerce. As we have said, trademarks are not necessary to such commerce. But even if they were, our opinion would be unchanged. In the case of *Steffens*, quoted above, the court said:

It is not every species of property which is the subject of commerce, or which is used or even essential in commerce, which is brought by this clause of the Constitution (commerce clause) within the control of Congress. The barrels and casks, the



bottles and boxes in which alone certain articles of commerce are kept for safety, and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of Congressional legislation more than other property.

But, while we think Congress can not so legislate with regard to trademarks under the power "to regulate commerce with foreign nations, and among the several States and with the Indian tribes" (article 1, section 8, Constitution), trademarks, in commerce with foreign nations and with the Indian tribes, can be protected under the treaty-making power.

The President has "power, by and with the advice and consent of the Senate, to make treaties, provided two-thirds of the Senators present concur." (Constitution, article 2, section 2.) "All treaties made, or which shall be made, under the authority of the United States," are laws of equal dignity with United States statutes. (Constitution, article 6, section 2.) If complete in themselves, they are self-operative. If they need legislative aid, Congress can give it under its power "to make all laws which shall be necessary and proper for carrying into execution the foregoing powers, and all other powers vested by the Constitution in the Government of the United States, or in any department or officer thereof." (Last clause, article 1, section 8, Constitution.)

In *United States v. Coombs* (12 Peters, R., 72) it was held that, though under the commerce clause certain offenses on land might not be reached, yet they could be punished under that general clause. The court said: "Any offense which thus interferes with or obstructs or prevents such commerce and navigation, though done on land, may be punished by Congress under its general authority to make all laws necessary and proper to execute their delegated constitutional authority."

Having thus disposed of trademarks in commerce with foreign nations and the Indian tribes, we have remaining interstate commerce. Trademarks are used in interstate commerce upon articles patented and not patented. Under the power of Congress of "securing for limited times \* \* \* to inventors the exclusive right to their respective \* \* \* discoveries" (article 1, section 8) and to give such protection, Congress has forbidden anyone to "mark upon anything made, used, or sold by him for which he has not obtained a patent the name or imitation of the name" of the patentee, or to put "patent," "patentee," or "letters patent," or "any word of like import, with intent to imitate or counterfeit the mark or device of the patentee," without his consent, and prescribed a penalty for a violation. (Rev. Stat., sec. 4900.) If the language is not broad enough, or the penalty be not severe enough, Congress may, under that power, give further protection to trademarks on patented goods. Thus may Congress now protect "any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof not known or used by others" and patentable under the laws of the United States. (Rev. Stat., sec. 4886.)

The sole remaining question is whether the protection of trademarks upon things not patentable demands an amendment of our organic law.

The owners of trademarks now have, in every State of the Union, the common-law protection of injunction to protect and an action for damages to punish their infringement. In nineteen of the States there



are severe penal statutes against tampering with trademarks. These statutes have been made as the developments of trade demanded. In all probability they would have been made in many other States had Congress not attempted to legislate upon the subject. Certainly the States have shown no unwillingness to protect this species of property.

The wish for uniformity in this regard throughout the Union would apply to many things which our fathers left to the sole control of the States. The Constitution of our country owes much of the consideration and reverence which we have for it to its stability. It should never be amended save for compelling reasons. Therefore, without disparaging the importance of trademarks, the committee thinks the arguments in favor of the amendment are insufficient, and that the resolution should be reported back to the House with a recommendation that it do not pass.

As some legislation on this subject is greatly desired by manufacturers and merchants, and as some may be needed to systematize the registration of trademarks, we recommend the passage of the bill hereto attached.

It is the bill introduced by Mr. Armfield somewhat modified. It reenacts the sections 4937-4947 of the Revised Statutes almost verbatim, except that its operations are confined to trademarks used in commerce with the Indian tribes and foreign nations.

This bill omits the first section of Mr. Armfield's bill, for these reasons: The committee know no good reason for the creation of a new office and new salary to accomplish this work. They perceive no good reason for taking this matter from the Patent Office. One of the main reasons urged for any law on the subject is to comply with existing treaties. In each of these treaties owners of foreign trademarks are required to deposit them in the Patent Office. The law made to aid the treaties should conform thereto, and we have made the bill throughout to conform to that purpose.

Your committee have added the act of 1876, "to punish the counterfeiting of trade-mark goods, and the sale or dealing in counterfeit trade-mark goods," because, by some this is thought to be absolutely necessary to protect this species of property. Those provisions are in Statutes at Large, volume 19, pages 141 and 142.

The appeal to the supreme court of the District of Columbia is omitted because it is thought unnecessary.

The committee also add to the bill that our citizens wishing to register trademarks in foreign countries, where prior registration here is a condition precedent to registration there, may register here for such purpose.

The committee recommend the passage of the accompanying substitute.

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[House of Representatives, second session, April 23, 1880, Cong. Record, vol. 10, part 3, pp. 2701-2707].

#### REGISTRATION OF TRADE-MARKS.

Mr. HAMMOND, of Georgia. Mr. Speaker, I rise to a privileged motion which I desired to make yesterday, and that is to call up the bill touching legislation in regard to trademarks to carry out certain treaties made between this country and foreign governments.

Mr. CONGER. Is this a privileged question?

Mr. COX. It is. The Committee on the Judiciary was allowed to report at any time. I made the motion, I remember, very distinctly.

Mr. HAMMOND, of Georgia. I ask to call up a bill (H. R. No. 5088) to authorize the registration of trade-marks and protect the same, which was reported from the Committee on the Judiciary as a substitute for House bill No. 2573 and House joint resolution No. 125, in order that it may be considered at this time.

The bill was read, as follows:

A BILL (H. R. No. 5088) to authorize the registration of trade-marks and protect the same.

*Be it enacted, etc.,* That owners of trade-marks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements:

First. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with facsimiles thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used.

Second. By paying into the Treasury of the United States the sum of \$25, and complying with such regulations as may be prescribed by the Commissioner of Patents.

SEC. 2. That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations, or Indian tribes, as above indicated; and that the description and facsimiles presented for registry truly represent the trade-mark sought to be registered.

SEC. 3. That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

SEC. 4. That certificates of registry of trade-marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith and certificates of registry so signed and sealed shall be evidence in any suit in which such trade-marks shall be brought in controversy.

SEC. 5. That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

SEC. 6. That applicants for registration under this act shall be credited for any fee, or part of a fee, heretofore paid by them into the Treasury of the United States with intent to procure protection for the same trade-mark.

SEC. 7. That registration of a trade-mark shall be prima facie evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any



trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

SEC. 8. That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business, or upon any article injurious in itself or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

SEC. 9. That any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.

SEC. 10. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

SEC. 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

SEC. 12. That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office.

SEC. 13. That citizens and residents of this country wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.

SEC. 14. That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trade-mark, pursuant to the *Statutes of the United States*, to which, or to the package in which the same are put up, if fraudulently affixed said trade-mark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by fine not exceeding \$1,000 or imprisonment not more than two years, or both such fine and imprisonment.

SEC. 15. That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trade-mark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the fourteenth section of this act.

SEC. 16. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the fourteenth section of this act.

SEC. 17. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, molds, or any false representation, likeness, copy, or colorable imitation of any die, plate, brand, engraving, or mold of any private label, brand, stamp, wrapper, engraving on paper or other substance, or trade-mark, registered pursuant to the



statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the fourteenth section of this act.

SEC. 18. That any person or persons who shall, with intent to defraud any person or persons, knowingly and willfully make, forge, or counterfeit, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mold, or trade-mark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the fourteenth section of this act.

SEC. 19. That any person who shall, with intent to injure or defraud the owner of any trade-mark, or any other person lawfully entitled to use or protect the same buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trade-mark registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the fourteenth section of this act.

SEC. 20. That if the owner of any trade-mark registered pursuant to the statutes of the United States, or his agent, make oath in writing that he has reason to believe and does believe that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, or molds of his said registered trade-mark are in the possession of any person, with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colorable imitations of his said trade-mark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trade-mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person, with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States and the commissioners of the circuit courts may, within their respective jurisdictions, proceed under the law relating to search warrants, and may issue a search warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, and said counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, and said empty boxes, envelopes, wrappers, cases, bottles, or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purposes of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages to be publicly destroyed.

SEC. 21. That any person who shall, with intent to defraud any person or persons, knowingly and willfully aid or abet in the violation of any of the provisions of this act shall, upon conviction thereof, be punished by a fine not exceeding \$500, or imprisonment not more than one year, or both such fine and imprisonment.

Mr. HAMMOND, of Georgia. The report submitted by the committee carried with it not only the bill known as the Armfield bill, but the resolution introduced by the gentleman from Iowa [Mr. McCoid], touching the same subject-matter. The reference covers both, and therefore I made a motion to take up the report and the matter covered thereby, and in the argument I shall make in favor of the bill I shall also present the view of the Judiciary Committee in opposition to the resolution.

In 1870 Congress passed the dozen sections of the Revised Statutes of the United States, sections 4937 et seq., relating to trade-marks. They prescribed the terms upon which any person in the United States or "in any foreign country which, by treaty or convention, affords similar privileges to citizens of the United States," entitled to a trade-mark, should be protected therein. The remedies thereby prescribed for infringement of one's rights in that regard were injunc-

tion and action on the case for damages. In August, 1876, Congress passed another act "to punish the counterfeiting of trade-mark goods and the sale of or dealing in of counterfeit trade-mark goods." (United States Statutes, volume 19, page 141.) That act made many crimes relating to trade-marks, each punishable "by fine not exceeding \$1,000 or imprisonment not more than two years, or both such fine and imprisonment."

In November, 1879, the Supreme Court held all that legislation to be unconstitutional and void. See *Steffens and others v. The United States*, October term Supreme Court, 1879. Congress had never legislated upon the subject before; nor since has there been any such legislation, unless the registration of prints and labels under the copyright act of 1874 (Statutes 18, p. 79) be so classed. It, however, is on a different subject, and, when attacked, may fall under the same condemnation. The United States is therefore without any statutory rules for registration and protection of trade-mark rights.

By some this is thought to be a serious want. Those who think it can be now constitutionally supplied ask Congress to pass the bill called the Armfield bill, "To authorize the registration and protection of trade-marks." That bill was referred to the Committee on Commerce on the 9th of December last, and on the 17th of that month referred to the Committee on the Judiciary.

That bill proposed to put trade-marks under the control of a salaried officer, newly made by the bill, and allow an appeal from his decision to the supreme court of the District of Columbia. In all other respects it is substantially, indeed almost literally, the legislation of 1870 with this modification only: it is confined to commerce with foreign nations, with the Indian tribes, and among the several States. Its friends claimed that thus all objections on the score of constitutionality would be removed. It will be perceived from the report which I had the honor to present that the Judiciary Committee did not agree to that conclusion. So far as I am advised, that committee unanimously believed that so much of that bill as applied to commerce among the several States would be unconstitutional. That I may be understood, let me call attention to the points made in that report.

TRADE-MARKS ON INTERSTATE COMMERCE NOT IN CONGRESSIONAL POWER.

Congress has power "to regulate commerce with foreign nations and among the several States and with the Indian tribes." (Constitution, art. 1, sec. 8.) But is legislation as to trade-marks regulating commerce?

The Supreme Court in the case of *Steffens*, heretofore cited, avoided any expression of opinion on this point. They said only this, namely:

The argument is that the use of a trade-mark—that which alone gives it any value—is to identify a particular class or quality of goods as the manufacture, produce, or property of the person who puts them in the general market for sale. That the sale of the article so distinguished is commerce. The trade-mark is, therefore, a useful and valuable aid or instrument of commerce, and its regulation by virtue of the above provision of the Constitution belongs to Congress, and that the act in question is a lawful exercise of this power.

It is not every species of property which is the subject of commerce, or which is used or even essential in commerce, which is brought by this clause of the Constitution within the control of Congress. The barrels and casks, the bottles and boxes in which alone certain articles of commerce are kept for safety and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of Congressional legislation more than other property. (*Nathan v. Louisiana*, 8 How., 73.)



In the case of *Paul v. Virginia* (8 Wallace, 168) this court held that a policy of insurance made by a corporation of one State on property situated in another was not an article of commerce and did not come within the purview of the clause of the Constitution we are considering. "They are not," says the court, "commodities to be shipped or forwarded from one State to another, and then put up for sale." On the other hand, in the case of *Almy v. The State of California* (24 How., 169) it was held that a stamp duty imposed by the legislature of California on bills of lading for gold and silver transported from any place in that State to another out of the State was forbidden by the Constitution of the United States, because such instruments were a necessity to the transaction of commerce, and the duty was a tax upon exports.

The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, we propose to leave undecided. (*United States v. Steffens*, October term, 1879.)

Let us examine the question. A trade-mark is property but is not the subject of commerce. It is not bought or sold. In itself it is worthless. It is only valuable when attached to merchandise which is to be sold. In the license cases it was argued that diseases, etc., attended commerce, and therefore disease-breeding commerce was beyond State control and within the Federal jurisdiction. But Chief Justice Taney said no; "they are not things to be regulated and trafficked in." (5 How. U. S. R., 576.) Trade-marks are not essential to commerce. Out of the myriads of things trafficked in by the people of this country, less than eight thousand are under trade-marks. Every manufactured article trafficked needs, for protection and shipping, a barrel or cask, a bottle or box or wrapper; and yet who would have ever supposed them subject to Congressional control if the decision in *United States v. Steffens* had omitted to say they were not?

A policy of insurance is sold and sent from one State to another, and may be transferred again and again. But in no fair sense is it an article of merchandise. "They are not commodities to be shipped or forwarded from one State to another and then be put up for sale," said the court in *Paul v. Virginia*, and they are "mere contracts of indemnity against loss by fire," said Justice Field in the telegraph case (96 U. S. R.), and therefore they were under State jurisdiction, and not Federal control.

When affixed to merchandise to identify its origin or quality or the like, what is a trade-mark but "a contract of indemnity against loss" by fraud or deceit? It is but the owner's guarantee. It is weaker in this regard than the policy of insurance, for the trade-mark is never sold. Possibly it is stronger than the policy, because attached to a thing sold. But I think not. A merchant in Georgia shipping his cotton to New York or Liverpool wishes to guarantee its quantity and quality, and writes such paper to whom it may concern in his office. It is a contract controlled wholly by State laws. Congress can not legislate to punish any one for counterfeiting that paper, or using that paper to defraud another. Surely the wildest dreamer would not call such legislation regulating commerce. Now how is the case changed, if that paper be pasted on the bale of cotton? But when so pasted on it would be just such a contract as a trade-mark attached to an article; no more and no less.

True, the court has held that a State may not tax a bill of lading. But why? Not because Congress had power to legislate as to them, but because the States were prohibited from taxing exports, etc., and taxing such contracts was virtually taxing exports. They said:



A bill of lading, or some other instrument of the same import, is *necessarily always* associated with *every* shipment of articles of commerce from the ports of one country to another. The *necessities* of commerce *require* it. It is hardly less necessary to the *existence* of such commerce than casks to cover tobacco or bagging to cover cotton, when such articles are exported to a foreign country, for *no one* would put his property in the hands of a shipmaster without taking written evidence of its reception on board the vessel and the purpose for which it was placed in his hands. \* \* \* A bill of lading, or some equivalent instrument of writing, is *invariably* associated with *every* cargo of merchandise exported to a foreign country, and *consequently* a duty upon that is in substance and effect a duty on an article exported. (*Almy v. California*, 24 Howard, R. 170.)

In *United States v. Steffens* you observed the court said that decision was "*because* such instruments were *necessities* of commerce." And yet in *Steffens's* case they also said not even such necessity would make Congressional control complete. For surely the box or barrel or other receptacle of the thing sold is as necessary to commerce as a bill of lading, and they are not in Congressional control. Nor can the opinion of the divided court in *Pennsylvania Telegraph Company v. Western Union Telegraph Company* (96 U. S. R., 9) be used against this view. It rather strengthens it. The court there said the electric telegraph has become "*one of the necessities of commerce. It is indispensable as a means of intercommunication, but especially so in commercial transactions.*" \* \* \* "*Goods are sold and money paid upon telegraphic orders; contracts are made by telegraphic correspondence; cargoes secured and the movement of ships directed.*" But in no fair sense can trade-marks be likened to telegraphic *communication*. They are not sent forward to secure contracts and the like. And it took both the commerce clause and the post-office clause to support that opinion. I repeat, trade-marks are but a convenience of commerce. They are no more necessary to commerce than are the photographed or engraved cuts of manufactured articles, nor more numerous. And if this legislation would be constitutional, Congress may engage in regulating the picture business.

But valuable as are the opinions of the Supreme Court they should not be the measure of the power we shall exercise in Congress. They pass upon State laws said to conflict with the supreme law, and may give the benefit of doubts in favor of the Federal power or the States as they like. But Congress is coordinate with the court and the legislative body of the Government, whose ermine they wear. They must therefore hold Congressional legislation valid unless manifestly and plainly unconstitutional. The only safety, then, is for Congress to solve its doubts against the exercise of power. If it will not, the result is Congress can do all things not plainly forbidden. This is at war with the plan of our fathers. That plan restricted Congress to the exercise of certain delegated powers. One of them was regulating commerce. That power was delegated to the United States that the States might not cripple commerce.

The sixth article of confederation declared:

No State shall lay any imposts or duties which may *interfere with any stipulations* in treaties entered into by the United States, &c.

By article 9 the States reserved the power of "imposing such imposts and duties on foreigners as their own people are subjected to" and the power of "prohibiting the exportation or importation of any species of goods or commodities whatsoever." The Constitution gave Congress the power "to regulate commerce with foreign nations, and among the

several States and with the Indian tribes" (article 1, section 7) and (by article 2, section 10) put the States under this disability:

No State shall, without the consent of the Congress, lay any imposts or duties on imports or exports, except what may be absolutely necessary for executing its inspection laws; and the net produce of all duties and imposts, laid by any State on imports or exports, shall be for the use of the Treasury of the United States; and all such laws shall be subject to the revision and control of the Congress.

Freedom from State constraint was the thing sought and secured.

The right to regulate the commerce thus freed from conflicting State control was not to grant such control as is here claimed. Grant this demand and who can deny the right of Congress to prescribe the weight and size of a bale of cotton, the form of a package for wheat or tobacco, to be shipped from one State to another?

I know that Congress has undertaken to control the shipment of cattle and nitroglycerine from one State to another. But if that legislation be constitutional it may rest upon that defensive power inherent in all governments to protect their subjects or citizens from disease and death. On that ground the Supreme Court of the United States, in the License Cases, sustained the power of the States to legislate against intoxicating drinks, even though such legislation touched imports, etc. Besides, cattle and nitroglycerine are things sold, while trade-marks are not. Thus the Committee on the Judiciary found itself compelled to strike interstate commerce from the bill.

#### FOREIGN TRADE-MARKS.

The next question was, Can we constitutionally legislate as to foreign trade-marks? The President of the United States has "power, by and with the advice and consent of the Senate, to make treaties, provided two-thirds of the Senators present concur." (Constitution, article 2, section 2.) Congress has "power to make all laws necessary and proper for carrying into execution the foregoing powers and all other powers vested by the Constitution in the Government of the United States or in any department or officer thereof." (Article 1, section 8, Constitution.) Congress, though powerless in this regard under the commerce clause, may so legislate in aid of the treaty-making power. This idea is fully illustrated and sustained by the Supreme Court in *United States v. Coombs* (12 Peters's Reports, 78). The question was, whether certain obstructions to commerce, not at sea nor within tide marks, but on land, could be punished by Congress? The court said:

Any offense which thus interferes with or obstructs or prevents such commerce and navigation, though done on land, may be punished by Congress *under its general authority* to make all laws necessary and proper to execute their delegated constitutional authority.

I do not enter into the extent of the treaty-making power. The contest between that power and the control of all commercial questions by Congress, which began with the treaty with the Creek Indians in 1790 and remains unsettled to this day, is not involved in this issue. Sufficient for present purposes is the decision of Marshall, Chief Justice, in *Foster & Elam v. Neilson* (2 Peters): "A treaty is to be regarded in courts of justice as equivalent to an act of the legislature whenever it operates of itself, without aid of any legislative provision," which language was adopted in *United States v. Forty-three Gallons of Whisky* (96 U. S. R., 146). This being true, all that is



desirable in this regard may be done by the treaty-making power alone, or by it and Congress together. The treaty-making power has entered into certain obligations as to trade-marks with various foreign nations. That the exact nature of these obligations may be understood, I quote them even at the expense of being tedious.

TREATIES AS TO TRADE-MARKS.

We had many commercial treaties prior to the trade-mark act of 1870. But in three of them only were trade-marks mentioned or considered, namely, those with Russia and Belgium, made in 1868, and with France, made in 1869. That with Russia was as follows:

The high contracting parties, desiring to secure complete and efficient protection to the manufacturing industry of their respective citizens and subjects, agree that any counterfeiting in one of the two countries of the trade-marks affixed in the other on merchandise, to show its origin and quality, *shall be strictly prohibited and repressed*, and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven.

The trade-marks in which the citizens or subjects of one of the two countries may wish to secure the right of property in the other, must be lodged exclusively. to wit, the marks of citizens of the United States in the department of manufactures and inland commerce at St. Petersburg, and the marks of Russian subjects at the Patent Office at Washington.

Subsequently, in March, 1874, the same parties "having recognized the necessity of defining and rendering more efficacious" said stipulations, "agreed upon the following arrangements:"

ARTICLE I.

With regard to marks of goods, or of their packages, and also with regard to marks of manufacture and trade, the citizens of the United States of America shall enjoy in Russia, and Russian subjects shall enjoy in the United States, the same protection as native citizens. (Coddington's Dig. of Trade-Marks, 484, 485, 486.)

The treaty of 1868 with Belgium was the same as that with Russia, except that the words "and repressed" after "shall be prohibited" were omitted, Brussels was substituted for St. Petersburg, and this was added: "It is understood that if a trade-mark has become public property in the country of its origin, it shall be equally free to all in the other country." This treaty was renewed *in hæc verba* in 1875. (Ib., 488, 489, 490, 491.)

The French treaty was:

ARTICLE I.

Every reproduction in one of the two countries of trade-marks affixed in the other to certain merchandise to prove its origin and quality *is forbidden* and shall give ground for an action of damages in favor of the injured party, to be prosecuted in the courts of the country in which the counterfeit shall be proven, *just as if the plaintiff was a subject or citizen of that country.*

The exclusive right to use a trade-mark for the benefit of citizens of the United States in France, or of French subjects in the territory of the United States, can not exist for a longer period than that fixed by the laws of the country for its own citizens.

"If the trade-mark has become public property in the country of its origin, it shall be equally free to all in the other country." Paris is named as the place for recording trade-marks of our citizens, the Patent Office in Washington for Frenchmen. (Ib., 491, 492.)

Those treaties made after the act of 1870 were with Austria, the German Empire, Great Britain, and Brazil. That with Austria, proclaimed in 1872, is exactly like that with France, except that after



declaring such reproduction of trade-marks "*is forbidden*" the language is:

And shall give to the injured party ground for such action or proceedings to prevent such reproduction and to recover damages for the same as may be authorized by the laws of the country in which the counterfeit is proven *just as if the plaintiff was a citizen of that country.* (Ib., 494.)

That with the German Empire, proclaimed on the same day in 1872, simply declared:

With regard to the marks of labels of goods or of their packages, and also with regard to patterns and marks of manufacture and trade, the citizens of Germany shall enjoy in the United States of America, and American citizens shall enjoy in Germany, the same protection as native citizens. (Ib., 496.)

The treaty with England, proclaimed in 1878, declared:

The subjects or citizens of each of the contracting parties shall have in the dominions and possessions of the other *the same rights* as belong to *native subjects or citizens*, or as are now granted or may hereafter be granted to the subjects and citizens of the most favored nations, in everything relating to property in trade-marks and trade-labels.

And it obliged the claimant only to "fulfill the formalities required by the law of the respective countries." (20 U. S. Stats., 703.)

The treaty with Brazil, proclaimed in 1879, gives "the same rights as belong to native citizens or subjects in everything relating to property in marks of manufacture and trade," and declares that "any person who desires to obtain the aforesaid protection must fulfill the formalities required by the laws of their respective countries." (Act of 1879.)

Those treaties undertook to secure to the citizens of those foreign nations with respect to trade-marks all the rights which our own citizens enjoyed; no more, but no less. What those rights were was fully stated by Judge Story in 1844, in *Taylor v. Carpenter*:

When the plaintiffs were manufacturers in England of "Taylor's Prussian thread," and the defendant, in America, imitated their names, trade-marks, envelopes, and labels, and placed them on thread of a different manufacture; held that it was a fraudulent infringement by the defendant of the right of the plaintiff, for which equity would grant relief, whether other persons had or had not done the same. In the courts of the United States alien friends are entitled to claim the same protection of their rights as citizens. (3 Story's Reports, 458.)

That "aliens have the same rights as citizens in respect to the protection of their trade-marks" was decided as to "Chinese Liniment" in 1849 by Judge McLean. (See *Coffeen v. Brunton*, 4 McLean, 516.) And so Davis's "Pain Killer" was protected in Canada in 1867, "LL" whisky in Ireland in 1863, and others which might be cited. And at the date of the treaties with France, Belgium, and Russia, and long before, besides the protection given in the United States courts and all our State courts by injunctions and actions for damages, many of the State courts punished infringement of trade-marks by fine and imprisonment. It was so in Connecticut, Massachusetts, Michigan, Missouri, Nevada, New York, Ohio, Oregon, and Pennsylvania. And many others since then have enacted such penal statutes.

All these rights were acquired by such treaties for the foreign subjects because possessed by our citizens. The treaties *proprio vigore* gave those rights. Our Patent Office, the place designated in the treaties for depositing those trade-marks, was established already. Many foreign trade-marks were lodged there before the act of 1870

was passed. Foreign manufacturers and traders and our officers regarded these treaties as self-executing.

But as the treaty with Russia declared that counterfeiting of trade-marks "shall be strictly prohibited and repressed," as that with Belgium said it "shall be prohibited," and as the common law was not in force in Russia, Belgium, or France, the legislation of 1870 was urged upon Congress. It is plain from the debates that it never could have passed had it not been thought important in aid of those treaties. (See the remarks of Senators Sumner and Carpenter on this point, Congressional Globe, vol. 80, p. 4821.)

And now petitions from the Board of Trade of Philadelphia, and from some of the largest and most influential manufacturers of New York, ask for such legislation. And they urge no reason therefor but our treaty and commercial relations with foreign nations. No other petitions on the subject have been presented to Congress, so far as the Committee on the Judiciary is advised, except one from Boston in favor of a constitutional amendment hereafter mentioned. The Committee on the Judiciary recognized the importance of maintaining not only every treaty obligation of the United States, but of doing so in such a manner as to keep the confidence of the world. They know the benefits of foreign markets for the products of the brain and muscle of our people. They confess to a feeling of pride that we not only minister to the comfort and pleasure of our neighbors, but that they dig their wealth from the bowels of the earth with Yankee picks, and keep it away from thieves with Yankee locks. And therefore they directed me to report Mr. Armfield's bill for passage, striking out only the new office and new salary because we thought them unnecessary, and interstate commerce because it could not be constitutionally retained.

If the foregoing position is true, the whole subject of trade-marks with those in treaty relations to us is eliminated from this discussion. What else may be eliminated? Many articles which bear trade-marks are patented. The patentee must fix thereon or on the package containing the same the word "patented," stating the day and year of the patent. He may put that in any form which will give notice, and sign it by his name. Should anyone in any manner "mark upon anything made, used, or sold by him for which he has not obtained a patent the name or any imitation of the name" of the patentee without his consent, or if such person puts "patent," "patentee," or "letters-patent," "or any word of like import with intent to imitate or counterfeit the *mark* or *device* of the patentee" without such consent, he shall for each offense suffer a penalty of not less than \$100. (Rev. Stat., 4900.) If this statute is not now broad enough to protect all such trade-marks as may be affixed to patented articles, it can be made so by an amendment of the patent laws.

The Committee on the Judiciary have omitted to say anything in the bill on this subject. They doubt whether such an incongruous medley as a civil punishment for infringing a patent or the mark thereof as is now provided by law, with a criminal proceeding to punish such infringement of the same mark if registered as a trade-mark, could do any good. It might do harm, and we are not aware that patentees are asking any further protection than is given by present laws.

## THE PENAL SECTIONS OF THIS ACT.

Thus far I am in full accord with the Committee on the Judiciary on the bill reported for passage. But here I part from them, and, pursuant to notice given in committee, at the proper time will move to strike out all the penal sections. The report of the Committee on the Judiciary shows that they added to the Armfield bill the penal enactments of 1876 (19 Statutes, 141, 142), being all of the reported bill after section 14. Those sections punish every person who deals in or sells or keeps or offers for sale or procures the sale of goods covered by a colorable imitation of a trade-mark, or puts a trade-mark on goods made to imitate trade-mark goods, or fills a bottle or box, etc.; covered by a trade-mark with an imitation of its intended contents, or has plates, etc., to make false trade-marks, or imitate a trade-mark, or sells a bottle, etc., having on it a trade-mark which he can erase without destroying it. If he do either with intent to defraud, the punishment is a fine not exceeding \$1,000 or imprisonment not more than two years, or both such fine and imprisonment. It punishes aiders and abettors with one-half of said fine and one-half of the imprisonment.

To those sections I can not assent. Mark it! No treaty obligation demanded this act of 1876. The bill was introduced into the Senate and passed there without discussion. It was so carelessly written that the language covered commerce wholly within the States, as well as without. It was so hastily gotten up that its short title is ungrammatical and the Supreme Court did not know what Congress intended to express by the act. One of its friends sought to pass it in the House without a reference, claiming it was a bill to "protect honest merchants and manufacturers." (17 Record, 4493.) It was referred, not to a law committee, but to the Committee on Patents, who had nothing to do with crimes. They reported it back saying four hundred manufacturers, merchants, and dealers, in New York, Boston, and Philadelphia, had petitioned for its passage. They gave no other reason therefor, but called the previous question. At the last moment Mr. Hewitt, of New York, tried to protest for the thousands of small dealers in New York who might be entrapped by its provisions, but it was forced through. It is not strange that a creature of such hasty and violent birth languished, and, languishing, died in less than three years. The eight eminent doctors who tried to save its life said they knew not what was its ailment except that it was stuffed with incongruous food, and that it might have died anyhow even if it had not swallowed the States.

Shall we resurrect the corpse? Shall we give to those owners of trade-marks, protected by treaties which pledged only such protection as our own citizens have for theirs, this high right which our citizens can not enjoy in this country? It would be at least decent to wait till we could put our own citizens on the same plane with foreigners and Indians. Wait till the McCoid amendment becomes a part of the Constitution—you who urge its passage. Do not enact this and then urge McCoid's amendment because the foreigner and Indian is better protected than our citizen, amend the Constitution to make it fit a statute.

Have gentlemen thought of the severity of this punishment? He who fraudulently imitates a mark or device on a patented article commits no crime. He may be sued for \$100 for each offense. (Rev. Stat., 4900.)



Take another case. On an American vessel in mid-ocean is a young girl returning home. In charge of the master, she has the right to be secure against even discourtesy. But forgetful of his duty as a man, despising his sacred trust, in the darkness of night he attacks her, alone, friendless, helpless, and with threats seduces and deflowers her. In Georgia we could put one at hard labor for twenty years for such a crime. Death would be too good for the scoundrel. But see that man at the bar of a United States court, convicted of thus violating section 5349 of the Revised Statutes, and hear the judge, burning with virtuous indignation, pronounce on him the extreme penalty of the law, a fine of \$1,000 and imprisonment for twelve months. And imagine him adding, "I regret that you are not found guilty of fraudulently putting a false drink in a bottle having on it the trade-mark of 'LL' whisky; for then I could punish you at least double as much as I can for this diabolical crime."

But not only is the punishment too severe, but it is bad policy to increase the criminal jurisdiction of the United States courts, unless it be necessary in order to maintain the power, dignity, or purity of the Government or some of its departments. Before the war it was rare to see a prisoner before such courts. Violations of the postal laws were almost the only crimes then known to its practice. But now the business is changed. The criminal dockets occupy the whole time of the courts. The swarm of consequent officers are a burden to the people, and the penalties inflicted are often unjust to the criminals.

This punishment means more than like punishment inflicted by State authority. It means pursuit by men who arrest not to vindicate the law, but to be paid for releases. It means a system of spies in every neighborhood. It means arrest by military and not civil officers only. It means indignities to prisoners. It means trial away from home and without convenient counsel and witnesses. It means conviction and banishment to distant prisons, far off from the aid and sympathy of friends and children and wives. Under a forced construction of the statutes by the Attorney-General, all the prisoners of the United States are sent to Albany or Detroit, upon the pretext that they are "convenient" and the State prisons are not "suitable" or "available." (Rev. Stat., 5546.) It means a life broken by disease or death in a felon's cell. I do not overdraw the picture. Four men, convicted of illicit distillation, left the bar of a United States court for the penitentiary in Albany simultaneously. One was rescued by a pardon; death relieved the keeper of the custody of the other three.

It is not mercy nor a desire to reform the prisoners which has caused the United States courts to allow hundreds of men to plead guilty of violating its revenue laws and then to go away without bail and without punishment, save a threat of severity if caught again. This ridiculous farce has been carried on for years under orders from the law head of this Government. Why? Because the punishments are so ill-suited to the crimes that the country staggers when called upon to execute their sentences. Let us not only make no more such severe penal laws, but have the manliness to denounce those already of force and wipe the disgrace forever from our statute books.

I am told the laws would not be enforced, but are needed to prevent the crimes. The advocates of the bill would invoke the majesty of the United States to frighten citizens. No such spirit breathes

from the Constitution. If you would not have laws despised, pass none which you will not enforce. Make laws to provoke love, not to excite terror.

I will not weary the House by a critical notice of the twentieth section of the bill. Let me call attention to two things in it. It gives about the same right of search for fraudulent trade-marks and plates, etc., for making them, as the Government uses to protect its currency. It authorizes seizures of private property and its destruction by a judge. The citizen is convicted of fraudulent purposes without trial by jury. The mention of these things will condemn that section

McCOID'S CONSTITUTIONAL AMENDMENT.

But another important question remains. The report shows that the friends of trade-marks seek to enlarge the powers of Congress that it may legislate thereon. The proposition is to amend as follows:

ARTICLE I.

SECTION 1. Congress, for promotion of trade and manufactures and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trade-marks.

It was introduced in the House on the 2d of December, 1879, and referred to the Committee on Manufactures, of which its author is a member, and on the 11th of December, 1879, that committee reported in favor of its adoption. (See Report No. 3, Forty-sixth Congress, second session.) On the 17th of December, 1879, its author sought to pass it in the House, without discussion, under the operation of the previous question. He said there could be no objection to its passage. Mr. Armfield, thinking it unnecessary, opposed its passage. Finally the House awoke to the awkwardness of amending the Constitution thus hurriedly, and it was proposed to refer the resolution and Mr. Armfield's bill, then before the Committee on Commerce, to the Committee on the Judiciary. The chairman of the Committee on Manufactures, Mr. Horr, of Michigan, begged that the only bill which his committee had ever had (as he said) should not be taken away. But the proposition to refer was carried, with the quasi pledge that the Judiciary Committee would report early. It redeemed the pledge as soon as the importance of the subject justified a report. It is fair to assume that the report of the Committee on Manufactures presented all the reasons for this amendment. They were not convincing to the Committee on the Judiciary. Their report touched not the form of the proposed amendment; not because that was unobjectionable, but because they opposed the substance of the change. Nor did their report elaborate the reasons which induced the conclusion. Suffer me, therefore, to present my views in answer to the original report in its favor.

The first reason therein given is that, under the invalid legislation of 1870 the United States has registered 7,785 trade-marks, taken from their owners therefor \$211,750, gave them in law nothing therefor, as the pretended protection was void, and that that money must be paid back or the trade-marks made good by amending the Constitution and then passing a ratifying law. To say nothing of such awkward reasons for amending our organic law, let us content ourselves by saying it is cheaper to pay back the money than to have Congress and three-fourths of the States talk over and pass the amendment.

The second reason is that this is necessary, that we may keep our treaty obligations. It appears what those treaties are, and that they required no legislation on the part of the United States, that foreign manufacturers and merchants so understood, and that the act of 1870 was passed because it was thought best to systematize in statutory form the common law on the subject. Up to this day only three hundred and seventeen foreign trade-marks are registered in this country. This number hardly justifies the high-sounding periods used by the trade-mark advocates about keeping treaty faith.

But suppose it was all otherwise, suppose the treaties were not authorized by the Constitution. Is it not an astounding proposition that it is necessary to amend our Constitution to carry out a treaty? Who makes treaties on behalf of the United States? The President, by and with the advice of the Senate, two-thirds of those present concurring. He and all of them are bound by oath to support the Constitution, and a treaty not authorized by the Constitution is no treaty; it is *ultra vires* and void. Every foreign nation contracting with our Government knows that our President is not our sovereign, but our servant; that neither he nor any other constitutional officer of our Government has any authority beyond that granted in the Constitution, and they all recognize the rule as expressed by Story on Agency, section 307*a*, namely:

In respect to the acts and declarations and representations of public agents, it would seem that the same rule does not prevail which ordinarily governs in relation to mere private agents. As to the latter (as we have seen) the principals are, in many cases, bound, when they have not authorized declarations and representations to be made. But in cases of public agents the Government or other public authority is not bound unless it *manifestly appears* that the agent is acting *within* the scope of his authority, or he is held out as having authority to do the act, or is employed in his capacity as a public agent to make the declaration or representation for the Government. Indeed, this rule seems indispensable in order to guard the public against losses and injuries arising from the fraud or mistake or rashness and indiscretion of their agents.

If any one has treated with us under a mistaken notion of the power of the President in this regard, all such a one can ask is to be released from the contract made by mistake, and we will, on request, consent to such release without question. But the doctrine that if the treaty-making power has exceeded its authority we must enlarge the power of attorney or be faithless is monstrous.

There is no necessity for such legislation. Mr. Cleveland, of New Jersey, while discussing this bill in 1870, admitted that the courts of England and this country had "so construed the law (common law) as to protect manufacturers as well as the public." (Globe, 91, p. 2857.) When the bill went before the Committee on Patents in the Senate they ordered all this matter stricken out as unnecessary and "a new departure" not fit to be made. Mr. Willey, in reporting the bill, said his committee had "thought that under the common law every man had a right to his own trade-mark and could protect himself." (Globe, 83, p. 4821.) Mr. Sumner said the bill had "put into the text of a statute rules and principles which have been matured at the common law and recognized by our courts, but which have new character and value and explicitness by being set forth in the statute." (Ib.)

Mr. Carpenter said:

They are wholly unnecessary at the common law, and so far as the rights of our citizens are concerned in England [and of course here] they are mere surplusage, the common law covering all that would be covered by these sections. (Ibid.)



It is claimed that the States can not adequately protect trade-marks. Why not? Their judges are as honest and as learned in the law as those upon the United States benches. The jurors, if different in the two courts, are not better in those of the Federal courts; in some parts of the country they are much below the State standard of intelligence and virtue. States' officers are more numerous, and equally faithful; their courts more numerous and more accessible; justice can be had cheaper and quicker in the State courts.

But it is said the State laws are inharmonious and conflicting. Is that true? Certain States have special industries. The manufacturing States protect their wares by patent rights and State statutes suitable to their condition and peculiar circumstances. How many using trade-marks are also covered by the patent law I know not. The examiner of trade-marks could not inform me. He writes me that "the medicine, tobacco, and whisky trades have registered, perhaps, one-third of the whole number;" and the States noted for these industries may, he thinks, be credited with the larger proportion of the registration thus far effected. Massachusetts specially protects watches. Some of the Western States do the like as to beer, etc. With these exceptions examine the following statement of the statutes. The dates sometimes do not go back far enough, for they come from the codes and not from the original acts.

*Punishment in jail or by fine, showing extent of, in each.*

Date.	State or Territory.	Number of months and amount of fine.
1872.....	California.....	6 months or \$500, or both.
1875 (1847).....	Connecticut.....	6 months or \$100, or both.
1877.....	Dakota.....	12 months or \$500, or both.
1873.....	Iowa.....	6 months or \$200, or both.
1871.....	Maine.....	12 months (not less) or \$200 (not less).
1859.....	Massachusetts.....	6 months or \$500, double on watches.
1863.....	Michigan.....	6 months or \$1,000, or both.
1866.....	Missouri.....	3 to 12 months and \$500 to \$5,000 fine.
1865.....	Nevada.....	5 to 30 days and \$25 to \$500 fine.
1877.....	New Jersey.....	6 months or \$100.
1850.....	New York.....	12 months or \$5,000.
1859.....	Ohio.....	12 months or \$500, or both.
1864.....	Oregon.....	6 months or \$30.
1869.....	Pennsylvania.....	3 years and \$100.
1876.....	Utah.....	6 months or \$300, or both.
1873.....	Nebraska.....	1 to 20 years in penitentiary and \$500.
1874.....	Illinois.....	\$200 fine.
1873.....	Illinois <sup>1</sup> .....	\$5 each.
1874.....	Indiana <sup>1</sup> .....	\$5 each.
1874.....	Kentucky <sup>2</sup> .....	\$5 each.

<sup>1</sup> Counterfeit beer kegs, etc.

<sup>2</sup> For cheating by false brand, \$200.

And in many others, doubtless, cheating by false marks, etc., may be reached by the criminal laws against cheating generally. In over half of these the date is since the act of Congress of 1870 was passed. Who will undertake to say why Alabama, Arkansas, Colorado, Delaware, Florida, Georgia, Louisiana, Maryland, Minnesota, Mississippi, New Hampshire, Rhode Island, South Carolina, Texas, Tennessee, Virginia, Vermont, Wisconsin, and West Virginia have not passed such statutes? In all probability, but for believing the acts of 1870 and 1876 sufficient, many of them might have made such laws. But they might not have thought the matter very important; for it appears (by absence of reported cases) that no one has ever sought to protect himself at law as to trade-marks in either of the States just named except Georgia. In the States which have statutes on the sub-

ject is a fixed purpose to punish such crimes, and uniformity in the character of punishment and but little variety in its quantum.

And there is no evidence of any hostility to such laws nor indisposition to make such laws in the States which have them not. I know not what States have the most trade-marks. From their affinity to patents and designs it is fair to presume that they are abundant when patents and designs abound. The South has few patents and designs; we are not manufacturers, but farmers. Alabama has but 61, being 1 to every 16,344 of her population; Arkansas has but 28, being 1 to every 17,303; Florida has but 9, being 1 to every 20,916; Georgia has but 74, being 1 to every 16,002; Louisiana has but 59, being 1 to every 12,321; Mississippi has but 45, being 1 to every 18,398; South Carolina has but 36, being 1 to every 19,600; Texas has but 142, being 1 to every 5,769; and Virginia has but 107, being one to every 11,450.

On the other hand, look at some of the manufacturing States. New York has 2,556, being 1 to every 1,717; Connecticut has 504, being 1 to every 945; and Massachusetts has 1,134, being 1 to every 403. Count out of Massachusetts the women and children and add her proportion of trade-marks, and there will be about one patent or design or trade-mark for every man in her borders.

But it is not in those States of the South only where there are no such statutes. Neither Colorado, nor Minnesota, nor New Hampshire, nor Rhode Island, nor Wisconsin, nor West Virginia has such laws.

I do not underrate the importance of the trade on nonpatentable articles, in medicine, tobacco, or whisky. Nor will I stop to question the value of the trade-marks to their owners. I will not deny their value to the public, but there is less in that than is claimed. The mass of purchasers trust more to smell and taste in selecting medicine, tobacco, and whisky, or the like, than to trade-marks, so often and so easily imitated that they know not which is genuine. And if they can not test by their senses because of the goods being covered, etc., they trust to the responsibility of their merchant rather than to the manufacturers' pictures. Certain Turkish merchants "having paid at Lyons for golden fabrics (*by order of the Grand Seignior*) unwittingly delivered brass to him. He beheaded them." So says Browne in his *Law of Trade-Marks* (p. 50) and warningly adds: "Thus much for implicit faith in trade-marks."

I admit that an identical law throughout the country would be very convenient for these parties. Uniform modes of conveying and holding property during life and of disposing of it by will might be convenient. Some would like uniform rules for taking testimony, uniform actions for debts and injuries, uniform punishment for crimes and the like. But the system of our Government is different from that.

The report by the Committee on Manufactures in favor of this amendment declares:

It is the paramount interest of the Government to protect innocent purchasers of manufactured goods from deceptions, frauds, and countless impositions.

That is not true. This Government has naught to do with the protection of purchasers of manufactured goods. It ought not to have; that work properly belongs to the several States.

That report adds:

The interest and safety of all demand that it [power to protect trade-marks], along with the power of making war, peace, and treaties; of taxation, regulating

commerce, and coining money; of granting patents and copyrights, should be vested in the General Government.

Suffer me to call attention to this effort to give a dignity and importance to trade-marks to which they are not entitled. The proposed amendment is for "the promotion of trade and manufactures," and the report claims that this trade-mark power should stand in the Constitution with patents and copyrights. The Supreme Court in the case first cited said they were entirely distinct, and all recognize the distinction. The author spends a lifetime of seclusion and study that he may write a book. He is frequently not rich, but poor; not honored, but despised. A copyright but protects from piracy that which, while it may support him, blesses his race. The scientist or inventor constructs in his brain what no other mind can produce. To perfect his projects costs time and toil. To-day he is buoyant with hope, to-morrow in despair. Capital opposes his innovations; ignorance fights him. He may be driven from home, as was Fourdrinier from France, for inventing the paper-making machine, or Jacquard from Lyons, for improving weaving machinery. It is right that genius should be protected and rewarded. And yet so opposed were our fathers to monopoly that to these benefactors of mankind they gave constitutional protection only for "a limited time," in consideration of public use of their inventions, etc., in all future time.

But what thought or study, what toil or risk, what care or expense to the capitalist was involved in such trade-marks as "the shirt," "exactly twelve yards," "Bismarck" (collars), "genuine Yankee soap," or "Mrs. Winslow's soothing syrup"? Why should they be protected and forever? However, it may as well be forever, for there is no residuum of good to the public to be abandoned by their authors. Mark, I am discussing the names, not the things. If the things be worth protection they can have it under copyright or patent laws. Nor would I cast a slur upon trade-marks. I recognize their convenience and usefulness. But their friends make them painfully little by contrast when they class them in importance with the power of taxation by which governments live, with war power by which they defend life, and with the power of making peace by which that life is made useful and ennobled.

I have been thus tediously arguing this proposition, not because of any fear of the passage of this resolution. But so important is stability in our Constitution that I would not have public confidence jostled by even a considerable following for this proposed amendment. I trespass on your patience with a few familiar facts. The Constitution was signed in September, 1787, ratified by eleven States by the middle of 1789, and later by North Carolina and Rhode Island. In 1789 twelve amendments were proposed. The two first were rejected—one to limit representatives of the people and the other to prevent an increase of salaries of Members of Congress during their term of office. It is a pity this last one was not ratified. The resolution proposing these amendments declared by preamble the reasons for them in this language:

The conventions of a number of the States having at the time of the adoption of this Constitution expressed a desire, in order to prevent misconstruction or abuse of its powers, that further declaratory and restrictive clauses shall be added, and as extending the ground of public confidence in the Government will best insure the beneficent ends of its institution.



And what were those amendments ratified? First, freedom of conscience, freedom of the press and of petition for redress of grievances; second, the right to keep and bear arms; third, no quartering of soldiers on citizens except by prescribed law; fourth, security of persons, houses, papers, and effects against unreasonable searches and seizures; fifth, sixth, seventh, and eighth, just compensation for property taken for public use, security of life, liberty, and property by jury trial, due process of law, moderate bail, aid of counsel, and speedy and open deliverance; ninth, "the enumeration of certain rights shall not be construed to deny or disparage others retained by the people;" tenth, "the powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively or to the people." They were ratified by the several States within a year.

The decision in *Chisolm v. Georgia* showed that under the Constitution a sovereign State might be destroyed by the Supreme Court. To prevent such possibility this eleventh amendment placed the States above judicial jurisdiction. It was proposed in 1794 and ratified in 1796. The twelfth amendment fixed the mode of electing our President and Vice-President and of ascertaining the result. It was ratified in 1804. I leave the history of facts which called for these amendments untouched. You know it well. I speak not of their weight and dignity. Such speaking would be wasted in this presence.

Remember that no one of these amendments enlarged the powers of the General Government; they were to "prevent misconstruction or abuse of its powers." They were "restrictive clauses" and their purpose was "to extend the ground of public confidence in the Government." And thus the fair column stood, based on States and having for its capital the reserved rights of the States and the people, till after our late war. The thunder of cannon did not shake it; fraternal blood did not stain its polish. There it stands to-day in all respects the same save that the thirteenth, fourteenth, and fifteenth amendments gave to the slave freedom and elective franchise and to the world a pledge of fidelity to our public debt.

The difficulties thrown in the way of its amendment by the Constitution itself and the caution heretofore observed in touching its limitations should make us pause. A start in that direction is feared by all who love our dual system. The United States is strong enough. Let us magnify the States by an honest trust and generous confidence. Let us repeat for each: "The people of this Commonwealth have the sole and exclusive right of governing themselves as a free, sovereign, and independent State, and do, and forever hereafter shall, exercise and enjoy every power, jurisdiction, and right which is not or may not hereafter be by them expressly delegated to the United States of America in Congress assembled."

These are brave words. Do you recognize the quotation? The Constitution which contains them contained every right guaranteed by the ten amendments just mentioned. Those words have stood unchallenged for a century in the organic law of that grand old Commonwealth whose breast was first bared to British lead at Concord and Lexington, which flashed defiance to British tyranny by the bold signature of John Hancock to the Declaration of Independence, and proudly boasts of that sentiment of her immortal son, "Liberty and Union, one and inseparable, now and forever."

Let us guard the system of our fathers; the system of sovereign States combined into a Federal Union; the authority of each, absolute in its sphere, working together for the good of the people.

Two such silver currents when they join,  
Do glorify the banks that bind them in.

I would not detract one iota from the dignity or the power of the United States. In all the attributes of nationality, to it delegated by the Constitution, it is a nation, but with no powers or duties not therein nominated. As such nation, in its orbit, it moves like the sun, grand, majestic, glorious; but out of its orbit, whether by force, legislative or judicial, centripetal or centrifugal, it makes of our system chaos and blazes but to burn.

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[House of Representatives, 2d session, April 27, 1880, Cong. Record, Vol. 10, part 3, pp. 2795-2803.]

#### TRADE-MARKS.

MR. CRAVENS. I move that the House go to business on the Speaker's table.

The SPEAKER pro tempore. The clerk will report the title of the bill coming over as unfinished business.

The Clerk reads as follows:

A bill (H. R. No. 5088) to authorize the registration of trade-marks and protect the same.

\* \* \* \* \*

MR. MCCOY. Mr. Speaker, in 1870 Congress passed a law creating a uniform and harmonious system of legislation on the subject of trade-marks. That law was supposed to be based on the clause of the Constitution giving power to Congress to legislate for the protection of patentable discoveries of individuals and copyrights of their production. That law existed until 1876, when it was amended by a penal clause making it much more efficient. Since that time it has been executed and trade-marks have been registered, certificates issued, and the business of the country in that regard has been conducted under the law of 1870. I believe nobody complained of the law or was dissatisfied with it, either from the point of its interference with State legislation or any other; and it gave universal satisfaction, except to those pirates and infringers whose unlawful trade was defeated by it.

Last October the Supreme Court decided the laws all unconstitutional, and when we met in December it appeared to me as a plain and practical way of getting over the difficulty in which we found ourselves by that decision of the Supreme Court to amend the Constitution and get the power we thought we had in 1870 and 1876, and up to the decision of that court, and, under that power which we would get by an amendment to the Constitution, legislate as we had done before.

The matter had been discussed over the country by the lawyers and

in the papers a great deal, and when we met, December 2, the resolution to amend the Constitution was introduced, and, as the gentleman from Georgia [Mr. Hammond] says, was referred to the Committee on Manufactures, the proper committee under the rules of the House. It was considered by that committee and unanimously reported, favorably recommending the submission of the amendment to the Constitution, and urging it with such reasons in brief as they had at the time. That committee having jurisdiction of the subject in the House, and having reported favorably as to the propriety of the amendment, this House has the unanimous report of the committee to whom they have given jurisdiction on that subject; but when the resolution came up in the House for passage, the bill introduced by the gentleman from North Carolina [Mr. Armfield], reenacting the old law under another clause of the Constitution, was urged as all that was required. The question was raised in that discussion whether or not we had, by virtue of the power to regulate commerce in the Constitution, power now, without an amendment, to pass a similar law to that of 1870 and 1876.

The constitutional question having been raised in the House, it was suggested that the matter be referred to the Committee on the Judiciary, and to that I consented; and it went to the Committee on the Judiciary on the subject, as I understood it and, as I think, the House understood it, of the constitutionality of the Armfield bill; that is, whether or not Congress can now legislate on trade-marks without an amendment under the commerce clause of the Constitution.

The Committee on the Judiciary have finally reported, and in their report they say that Congress has not the power, under any general clause of the Constitution, to legislate on the subject, and I understand the gentleman from Georgia [Mr. Hammond] to say that the Committee on the Judiciary are unanimous in the opinion that Congress has not the power, under the commerce clause, to pass this kind of legislation.

That committee has recommended the bill which is reported and asked for its passage. I will, therefore, first discuss that bill.

I think, Mr. Speaker, this bill is not one this House wants to pass, for several reasons. It is entitled "A bill to authorize the registration of trade-marks and to protect the same." The first clause says, "Trade-marks used in commerce with foreign nations and with the Indian tribes." The first objection to the bill is this: The committee which reports it says we have no power to legislate under the commerce clause, and yet the bill proceeds at once to say "used in commerce." That is in the first section; and in the third section they use the same language, with this additional clause, "Within the provisions of a treaty, convention, or declaration with a foreign power." The idea seems to be in the committee to place the bill itself under the commerce clause, while in their report they expressly say that Congress has no such power. I only notice that, and leave it, to show the doubt of the Judiciary Committee where this power exists if at all.

I take it on their own ground. I understand the gentleman from Georgia and the Judiciary Committee to say this, that we have no power to legislate on trade-marks, but that under the treaty power and the provision of the Constitution which says we shall make all needful legislation for the execution of the power given to the President to make treaties, we may pass this bill. Now let us see. The



chain of title of constitutional power is this, as I understand it, that the President can make a treaty according to a certain clause with regard to trade-marks, and it is necessary for Congress to legislate to execute the things to which the President has agreed to. I believe that is the theory of the gentleman from Georgia.

In order, therefore, that this Congress should be enabled to pass a bill on this subject they must first find that the President and the Senate have made a treaty under the Constitution by which they agree to do certain things in reference to these trade-marks, and next that we have the power under the general provisions of the law to execute that treaty and legislate for the things which are agreed upon therein. Now, if that is the position of the Judiciary Committee I want to ask a few questions of some of its members. They say in this bill that they pass it for the execution of treaties with foreign nations and with the Indian tribes. That is the claim set forth by the gentlemen in advocacy of this bill.

Now, Mr. Speaker, I desire to ask the gentleman from Georgia, or any other gentleman on the Judiciary Committee, what treaty provision has been made with the Indians in which it is necessary for Congress to pass such a bill as this at all? Has the President of the United States made a treaty with the Indian tribes agreeing to protect their trade-marks, or has he made a treaty with the Indians agreeing that they shall protect our trade-marks? Unless that treaty has been made we can not pass the bill under the very conditions specified in the report from the Judiciary Committee itself, for they say that we must first have a treaty and then Congress may pass laws to execute the same. Now, I claim that there being no treaty with the Indians in reference to such protection of trade-marks, we have not the power to pass such a bill; and I ask the gentleman from Georgia if he can not legislate as between the States how can he legislate as to trade-marks with the Indians? I would like any gentleman on that committee to state any reason or how we can legislate if there is no treaty with the Indians in this respect, and if the Indian has no trade-mark. As I understand it the trade-mark of the Indian is ordinarily a lifted scalp, and generally it is impressed on the head of the white man; that is at least one in which they have the right of priority of use.

Under that reasoning of the Judiciary Committee to which I have alluded the power to legislate as to the Indians falls to the ground, and may be disposed of without further comment. They therefore admit, so far as this bill is concerned and with reference to the Indians—and this report shows it—that that portion of the bill is unconstitutional, and, of course, we can not pass it if there is no treaty whatever regarding it.

Now, with reference to treaties with foreign nations, Mr. Speaker, I do not understand that we have any treaty with foreign nations that would justify or make it necessary to pass such a bill as this. In the first place, our treaties with reference to trade-marks never contemplated such a state of affairs as this bill would create. The only treaties with foreign countries in which protection was promised prior to 1870 were the treaties with Russia and with Belgium.

In those treaties we agreed that counterfeiting the trade-marks should be "strictly prohibited." The counterfeiting of trade-marks was prohibited at that time by the common-law provision, and being against the principles of the common law which recognized the right

of property in trade-marks the violation of that right would come within the provision of the treaties, and the parties injured would have had remedy in damages. They would have had that remedy under the common law. These two words of treaty obligation are not sufficient to justify an argument for this bill. It is doubtful whether any more was intended by the contracting parties than the guaranty of protection at common law.

These two treaties are the only ones with reference to trade-marks on which the right to legislate could be claimed that had been made before 1870. In 1870 we did pass a general trade-mark law, and the President and the Senate when they made treaties understood that we had the power to legislate upon trade-marks as a Government, and when we agreed to protect foreign trade-marks it was upon the supposition that we had the power to pass a general law. If we did not have at that time constitutional power to do that, that part of the treaty was simply void, because we had not the power to make a treaty if we had not the power to legislate for its execution, and what this Government did after that agreeing to protect trade-marks was done under a misapprehension and we are not bound by it.

Foreign governments are presumed to know that this Government is one of limited powers, having only those powers which are conferred on it in the Constitution, and to know and recognize the extent of those powers as well as we, so that in justice and equity we would not be bound to pass any law for the protection of foreign trade-marks only so far as power existed at the time the treaties were made to enact laws for their execution. But if that is true, then we are not morally or in justice bound to any foreign government to pass such legislation, which gives the preference to foreign citizens over our own. But if gentlemen upon the Judiciary Committee base this legislation, as they say they do, and are unanimous in that, upon treaties with foreign nations, they must first have a treaty and then legislate to execute it. Now what is the fact? We have now in existence treaties with foreign nations upon this subject, namely, with the Argentine Confederation, with Austria, with Belgium, with Brazil, France, the German Empire, Great Britain, and Russia. With all other foreign nations we have no treaty, and yet gentlemen ask us to pass a general law which will cover all nations who may, through their citizens, ask protection of our laws. They do not limit it to those with whom we have treaty obligations on the subject.

We have no such treaties with Bolivia, with Chili, with China, with Colombia, with Denmark, with Mexico, with Japan, with Spain, with Switzerland, and other nations. And yet under the provisions of this law the citizens of all these nations with whom we have no treaties whatever could come here and claim protection of their trade-marks in our courts.

The Judiciary Committee say we could not pass a law or legislate on the subject as regards these nations with whom we have no treaties, because we have not the power, except where necessary and proper to execute treaties, and such legislation, therefore, would be void. So that the law is unconstitutional so far as it legislates for foreign nations which have no treaties with us on the subject, as well as being void as to the Indians.

Now, as to Congress getting power to legislate upon the subject at all through the treaty power, I put this question to the Judiciary

Committee: Admitting that Congress has no power to legislate upon the subject of trade-marks for our own citizens and internally, can Congress get more power by virtue of a treaty than it now has? Can a treaty with a foreign Government grant to Congress a power it has not without the treaty to legislate internally and affecting our own citizens? The Judiciary Committee have expressed no opinion on that subject and do not enter into a discussion of it; but it seems to me the gravest question connected with this bill. Even admitting we had the treaties by which we had agreed to protect foreign trade-marks by national legislation, can we get the power to legislate on that subject, affecting the internal relations of our citizens in trade and commerce, the domestic relations, the police and State regulations, and rights and remedies, as the Judiciary Committee say? Can we get that power by virtue of a treaty?

As regards that question I believe this to be a correct principle of law: A treaty does not confer upon Congress a power to legislate as between persons in the State, whether citizens or foreigners, in their internal commerce where that power does not exist, without such treaty, incidental to some general power. But a treaty agreeing to legislate in such cases by controlling the transactions between foreign citizens and the people of the United States is void. I refer the committee and the House to the following brief upon that subject: 5 McLean, 348; 10 Pet., 362; 2 Cranch, 358; 4 Wheat., 316; Story on the Constitution, third edition, sections 1508, 1519; also sections 1243 and 1244:

[Extracts from debates on the sixth article of the Constitution, to be found in Elliott's Debates, volume 3.]

They can by this make no treaty which is repugnant to the spirit of the Constitution or is inconsistent with the delegated powers.—*Speech of Governor Nicholas, of Virginia*, page 508.

Though the king can make treaties, yet he can not make a treaty contrary to the constitution of his country.—*Speech of Governor Mason, of Virginia*, page 514.

The exercise of the power [to make treaties] must be consistent with the object of the delegation.

\* \* \* \* \*

The object of treaties is the regulation of intercourse with foreign nations, and is external. I do not think it possible to enumerate all the cases in which such external regulations would be necessary. \* \* \* Would it not be considered as a dangerous principle in the British Government were the King to have the same power in internal regulations as he has in the external business of treaties? Yet, as among other reasons it is natural to suppose he will prefer the interest of his own to that of another country, it is thought proper to give him this external power of making treaties. This distinction is well worthy of the consideration of gentlemen.—*Speech of Madison*.

Suppose we had no general law of the United States, would the President ever have made such treaties?

The act must be for the means requisite and fairly applicable to the attainment of the end of some other express power granted. (Story, section 1245.)

If we had the power to legislate for the registration and protection of trade-marks under any clause of the Constitution, then it would be within the power of the President to make a treaty for a reciprocity in international legislation. And it would be within the discretion of the Legislature to make such laws as should be necessary and proper to carry into execution his treaty.

Especially do I refer gentlemen to the case in tenth Peters, case of



New Orleans against the United States. The question was as to the United States having power to control the quays of New Orleans.

Under the King of France before we received that territory the sovereign had that power to make all the regulations. Under the King of Spain it was the same. And when the territory was ceded to us by treaty they ceded to us the same sovereign power over that territory that they had. The question arose in this case whether or not under that treaty the United States Government got the power to control these quays. The decision is in tenth Peters. I read from page 736 of that report. The Supreme Court say that the government of the quays would be a police power; and then they say this:

The Government of the United States as was well observed in the argument—

This case was argued by Webster on the part of New Orleans—

is one of limited power. It can exercise authority over no subjects except those which have been delegated to it; and—

Notice this sentence—

Congress can not by legislation enlarge the Federal jurisdiction; nor can it be enlarged under the treaty-making power.

That is just the point I make, that the power of Congress to legislate upon subjects over which the general clauses of the Constitution do not give them power can not be increased by a treaty. And the gentleman from Georgia [Mr. Hammond] has found no decision, and I presume the Judiciary Committee have been diligent and have searched the reports and have given us all the authority by which they sustain this power, yet they have found no decision but one; and I wish to call the attention of the House to that. The gentleman from Georgia supports this legislation by that reference alone. He says this:

Congress has "power to make all laws necessary and proper for carrying into execution the foregoing powers and all other powers vested by the Constitution in the Government of the United States or in any department or officer thereof." (Article 1, section 8, Constitution.) Congress, though powerless in this regard under the commerce clause, may so legislate in aid of the treaty-making power. This idea is fully illustrated and sustained by the Supreme Court in *United States v. Coombs* (12 Peters's Reports, 78.)

You observe the gentleman says that the idea that we get this power from the treaty-making power is fully illustrated by the Supreme Court in this case:

The question was, whether certain obstructions to commerce, not at sea nor within tide-marks, but on land, could be punished by Congress? The court said—

And here he quotes the decision of the court—

"Any offense which thus interferes with or obstructs such commerce and navigation, though done on land, may be punished by Congress *under its general authority*"—

And the gentleman italicizes these four words "*under its general authority*"—

"to make all laws necessary and proper to execute their delegated constitutional authority."

And I would italicise those words. They make all laws necessary and proper under the general authority *to execute their delegated constitutional authority*. Nothing else. They must have delegated constitutional authority first. Then under this general clause they may execute that appropriately to the end intended.

But the gentleman from Georgia is mistaken when he says the Supreme Court put that decision upon the treaty-making power, and the Committee on the Judiciary, if they place this legislation upon this decision in twelfth Peters, are mistaken as to where the power rests. I read from that decision, page 78:

But we are of the opinion that under the clause of the Constitution giving power to Congress to regulate commerce with foreign nations and among the several States, Congress possesses the power to punish offenses of the sort which are enumerated in the ninth section of the act of 1825, now under consideration.

It was not the treaty-making power under which they said we had this authority, but it was the power to regulate commerce with foreign nations. If the gentleman will read this decision carefully he will find that they said we had not the power under the judicial jurisdictional clause, that it was not a maritime offense; but that we had the power under the clause to regulate commerce. They did not place it upon the treaty-making power at all. We do not derive from the treaty-making clause the power to punish for offenses outside of those committed on the high seas and in the tide waters. I ask gentlemen of the Committee on the Judiciary to show me one sentence in that decision where the court placed this authority under the treaty-making power, or making the case favorable to this principle announced in their report. It is directly against them, for the court sought and cited a general clause of the Constitution under which Congress could claim the power, and did not rely on the treaty.

The expression of the Supreme Court in 10 Peters is not controverted, and I do not find a decision anywhere, and the Committee on the Judiciary have not found any, which states that Congress gains any such power under the treaty-making clause. That is the only decision which the gentlemen of that committee have cited, and they say it fully sustains the power of Congress under the treaty-making authority. And we see it, in fact, is against them.

I desire to call the attention of the House, and of the committee that made this report, to the following principle laid down in Kent, eleventh edition, page 266:

If the end be legitimate and within the scope of the Constitution, all means which are proper and plainly adapted to this end, and which are not prohibited, are lawful.

This is the extent, and the full extent I claim, to which Congress can go under that power. But the members of the Committee on the Judiciary themselves say that the end herein sought to be attained is not within the scope of the Constitution, the end being legislation on the subject of trade-marks. That committee has expressly said that the Constitution does not give any power to Congress to do that thing; that no power is given to the General Government by the Constitution to regulate trade-marks; that there is no express power in the execution of which the regulation of trade-marks is expedient, useful, or conducive to the end to be attained in any general power; that control of the subject is left to the States.

They say that it is not contained under the commerce clause, the patent clause, or the copyright clause. They might have placed it finally under the constitutional sovereignty power. They might have said that under the sovereignty of the United States this power might rest in its dealing with other sovereigns; but they put it nowhere in any constitutional power to be found within the scope of the Constitution.



Now I ask those gentlemen, and especially the gentleman from Georgia [Mr. Hammond], whose brilliant peroration on the subject of State rights closed his argument, this question: Should the President and Senate by treaty agree that none but Rhine wines should be sold in the United States, that, in the language of the treaty, "all others should be strictly prohibited," does the gentleman believe that Congress would have the power to legislate to execute that treaty? And if he does not believe that, will he point out to me wherein such a power to legislate would differ from that claimed in the present case, giving preferred rights and remedies to foreigners as between them and American citizens?

If the President and Senate should by treaty agree that the sale of all but foreign steel rails should be "strictly prohibited" in the United States, would the gentleman say that it is our duty to legislate to execute that treaty, and that Congress gained the power to do so because the treaty required it? If he can say so in the present case, he can as well say so in that; because he says that the treaty alone is the grant of power to Congress, that otherwise Congress would not have the power.

Suppose that the President and Senate should make a treaty providing that the sale of all but Havana cigars should be "strictly prohibited" in the United States. Would that confer upon Congress the power to legislate to execute that treaty, and to strictly prohibit the sale of all other cigars? If it would not, would power be conferred upon Congress by a treaty to protect foreign trade-marks and not our own? It seems to me that the Judiciary Committee, although they had this subject under consideration a long time, with instructions to report it as soon as possible, have certainly not reached the bottom of the subject in reporting and recommending a bill of this character.

Passing from the constitutional question, let me examine for a moment the practical question. If treaties are made requiring the Government to legislate in a certain way in harmony with foreign Governments, it would still remain a question with the legislative branch in their discretion whether they ought so to legislate. It would remain with them to decide whether they would do this thing which the President has agreed shall be done. We are the legislative branch, on which alone this power is conferred by the Constitution. It is within our discretion to determine whether we will pass the legislation which the President has stipulated shall be passed in any treaty.

Now, supposing you had the power, I ask whether in the exercise of that discretion you would favor the passage of this kind of a bill? Let us see what it is. Under this bill foreigners are to be protected by national legislation against infringement of their trade-marks. Under this bill they may go to United States courts for their remedies, both civil and criminal. They may there ask for damages; they may there ask for injunctions; they may there ask for search warrants to hunt out and destroy all implements supposed to be in the hands of any person for the purpose of infringing or pirating upon their trade-marks.

Under this legislation, if it should pass, you might find in our United States courts two persons standing at the bar of justice. One happens to be a Frenchman, a German, a Russian, or a Turk; the other happens to be an American citizen. The one invokes the power of that court to give him judgment for his damages, and he gets it: the other



is refused. One asks for a search warrant to hunt out and destroy suspected implements by which his trade-mark may be counterfeited. He gets it, while a similar application made by the other is refused. One goes into the United States courts under the criminal laws and prosecutes to punishment by the severest penalties of fine and imprisonment any man attempting to counterfeit his trade-mark; the other stands alone in that court without remedy. One, as against a citizen of the States, may sue in the United States courts; the American can not. One produces a United States certificate of registration, which is the *prima facie* evidence, from Maine to Alaska, of his ownership, upon which he readily wins his case; the other can not, but is left to grope in the long past to prove his prior use of his mark with all the difficulties of finding the evidence which time has swept away.

When that lone man rises up and asks, "Why am I not here with the same rights that these other men have?" you will see the Frenchman under his flag, the German under his flag, the Briton under his flag, the Russian or the Turk under his, pointing at him and saying, "You are an American citizen; by that misfortune you have under the legislation of your own Congress no rights here; we are preferred to you in every respect."

Mr. Speaker, for these several reasons I say this bill ought not to pass. I hope it will not receive the support of this House, nor even the support of the Judiciary Committee. First, it is unconstitutional, because it legislates for trade-marks in commerce with the Indians, with whom there is no treaty providing for such protection. Next, it undertakes to give the same protection to foreign nations with whom we have no treaties on the subject, and by the reasoning of the Judiciary Committee itself this legislation falls to the ground with reference to such nations. Next, as to foreign nations with whom we have treaties on this subject, those treaties were made under a misapprehension of our power as a nation, under the supposition that we had the authority to pass such laws as were passed in 1870 and 1876—legislation which we supposed until last October had full force. The treaty-making power in making these treaties acted under a misapprehension; and the immutable principles of justice require that no man or government or society shall be prejudiced by what has been done under a misapprehension of that kind.

But supposing these treaties to be in full force, to have been made with full knowledge of their effect, that would not confer upon Congress any additional power not within the scope of the Constitution. It would be disastrous for us to adopt the principle that any treaty made by the Executive can increase the powers of Congress.

This bill does not refer to external matters. Treaties relate to external matters between sovereigns. This bill goes into internal matters between citizen and citizen. Why, sir, you will find in this bill a provision that between citizens of the States this bill applies. When they are citizens of the same State, and the trade-mark in controversy is intended to be used for foreign commerce, this bill gives them all these rights as against every other citizen of the State. It undertakes to go into the State, and as between citizens of that State give them rights as above all others, if their trade-mark is intended to be used in foreign commerce or with the Indian tribes. All through the bill affects citizens of the States. If two men are engaged in ordinary traffic—in the grocery or any other business—in a State, this bill steps in

and affects the one without affecting the other, because of the trade-mark which happens to be on some of the goods.

Again, I object to the bill and hope it will not pass because if it were constitutional, if we had the power to pass it, if we could get this power from a treaty, it would not be a just and righteous law but would be an anomaly and an outrage upon the American statute book. The result would be that any American owning a trade-mark would be driven to assign that trade-mark to a foreigner and then come back under a foreign flag to get protection. If I had a trade-mark and wanted to have it protected by the United States courts under the provisions of this bill in the interstate commerce of the country, I would immediately assign it to some German, Frenchman, or some other foreigner, and then come back under the foreign flag and ask for my rights under this bill because I could not get them under my own flag.

This is not the way foreign nations do. We have treaties with Germany, and treaties with France, and they do not treat their citizens in this way. In violation of their treaties to-day on the statute books, France has this provision: The nineteenth article provides that all foreign products bearing the mark or name of a manufacturer resident in France, or the name or the place of a French factory, shall be excluded from France or seized. That is the way they do there. If an American comes with goods with the stamp of their factory on them they are excluded and can not come into the ports of that country, and are seized and confiscated. Yet you say, in opposition to that, they may come here and ours shall not compete with them in the commerce of this country under your legislation.

Take Germany. How does she treat her citizens under the treaty which says our citizens shall have the same rights as her own subjects? Section 13 of her trade-mark law is as follows:

Every native producer or trader who has received protection or authorization for his trade-mark may, in the event of another unlawfully making use of the same or the name of his firm, in virtue of this law enter an action against any person so doing in order to obtain a legal decision that he is not entitled to make use of such trade-mark. The producer or trader may likewise prosecute any person who unlawfully exposes or keeps for sale any goods unlawfully marked with the complainant's trade-mark; that the person so doing may be judicially declared unauthorized to expose or keep for sale any goods so marked.

Mr. HAMMOND, of Georgia. Will the gentleman allow me to ask him a question?

Mr. McCOID. Yes, sir.

Mr. HAMMOND, of Georgia. When the treaty comes in and says the foreigner shall have the same rights as the native, does not that make it practically read native or foreigner?

Mr. McCOID. If the gentleman will examine he will find this is a law made after the treaty, and not before it.

Mr. HAMMOND, of Georgia. The treaty is that each foreigner shall have in the country of the other the same rights that the citizen has at home. Therefore you legislate for the citizen, but you treat for the foreigners.

Mr. McCOID. Not at all. It is necessary for that nation under the treaty to legislate and execute it. They do not get rights which require legislation to create by a treaty; they only get them by legislation under the treaty. Does the gentleman say as a legal principle



that a treaty is law, where it requires legislation, without that legislation?

Mr. OSMER. They get recognition by the treaty.

Mr. McCOID. Yes; they get recognition by the treaty and the Government then enacts the law to give them the remedy. But a treaty agreeing to certain rights and remedies does not become a law without the legislation to carry it out. Now, under their legislation after the treaty, they have in Germany enacted what I have read in section 13.

I say I object to this bill because it gives the foreigner preference over our own people, and, for one, I do not want to place our citizens in any such relation. I object to it for its want of reciprocity, for its want of mutuality; I object to it on the ground that we do not have the same rights and can not give the same rights to American citizens under our laws which we give to them. I know very well we would like to do so. I know gentlemen say we would go to the extent of our power, but we do not do it because we have not the power. I say we had better wait until by grant of power from the States we can make a law which will be uniform, and harmonious, and equitable, and just both to our own citizens and to foreigners.

#### CAN TRADE-MARKS BE PROTECTED UNDER PATENT LAWS?

Now, Mr. Speaker, there is one other point which is spoken of in the report of the Committee on the Judiciary, and which was referred to by the gentleman from Georgia [Mr. Hammond] in his remarks. It is there said under the patent laws patented goods may be protected. In that I think the committee is entirely mistaken. The Judiciary Committee in saying that trade-marks may be protected under the patent laws must have forgotten that there is no analogy between them whatever. Although the patent laws require the name and date of the patent to be put on goods, there is no trade-mark in it. It has no reference to trade-marks.

On this subject I took the liberty of submitting certain interrogatories to the Commissioner of Patents, and I ask the Clerk to read those interrogatories and the reply which I received to them from the Commissioner.

The Clerk read as follows:

WASHINGTON, D. C., *April 20, 1880.*

DEAR SIR: In the determination of the necessity and practicability of national legislation upon the subject of the protection of trade-marks as between citizens of States, and a constitutional amendment under which such legislation may be had, it becomes important to know whether—

First. Under the power of Congress of securing for limited times \* \* \* to inventors the exclusive right to their respective \* \* \* discoveries (article 1, section 8), and to give such protection, and under which Congress has forbidden anyone to "mark upon anything made, used, or sold by him for which he has not obtained a patent the name or imitation of the name" of the patentee, or to put "patent," "patentee," or "letters patent," or any word of like import with intent to imitate or counterfeit the mark or device of the patentee without his consent and prescribed as penalty for a violation (Revised Statutes, section 4900), trade-marks are or may by further legislation be sufficiently protected on patented goods?

Second. Whether State legislation is sufficient to protect interstate trade-marks?

Third. The propriety of protecting foreign trade-marks by national legislation, and leaving domestic trade-marks without any such direct legislation?

Fourth. Why, if under patent laws trade-marks on patented goods may be sufficiently protected for our citizens, they may not also for foreign citizens?



Fifth. What conflicts or confusion would result from State legislation and national legislation as to trade-marks under treaties?

I respectfully request you to give your views on these questions and such facts as in your opinion sustain them. And also the results of national protection under late laws now declared unconstitutional.

Very respectfully, your obedient servant,

M. A. McCord.

To the COMMISSIONER OF PATENTS.

DEPARTMENT OF THE INTERIOR,  
UNITED STATES PATENT OFFICE,  
*Washington, D. C., April 21, 1880.*

SIR: In reply to your informal inquiries, relating to trade-mark legislation, I have the honor to state—

First. That there is no such relation between trade-marks and patents and patentable inventions by which the provisions of the existing laws relating to patents can be applied to the protection of trade-marks.

The United States Supreme Court in the Steffens case having expressly declared that the clause of the Constitution relating to protection to be given authors and inventors to their respective writings and discoveries can not be construed to extend to trade-marks, it would necessarily follow that any amendment of the patent laws (which derive their validity from such clause of the Constitution) intended to affect the matter of trade-marks would to that extent be invalid.

Second. Section 4900, Revised Statutes, to which you have called my attention, is mandatory in requiring patentees to mark their articles as patented, together with the day and year the patent was granted, as notice to the public, and as a prerequisite in maintaining any suit for infringement, except on proof that the defendant was otherwise duly notified. But the announcement which that section requires to be made on patented articles can in no way be construed as a trade-mark. The United States Supreme Court, as well as other courts, both in this country and England, have repeatedly held that the mere announcement of a fact upon an article of manufacture, or the use merely of a generic name, consisting of the name of the manufacturer, or words to denote quality, or the time and place of manufacture, are not proper subjects for a trade-mark under the common law. And it has also been held that after the expiration of a patent the public generally, in manufacturing the article, are entitled to use the name of the patentee to designate or identify such manufacture with the one previously patented.

Third. The number of trade-marks heretofore registered in this office, which amounts to between eight and nine thousand, is a very small part of the valuable trade-marks constantly in use throughout the country. But of late years the number of applications for the registration of marks at this office has very greatly increased; and from all that we can gather the principal reason seems to be that the legislation of the various States is so conflicting that no adequate protection could be afforded under the State laws, especially as to agents of foreign corporations, citizens of other States as well as of foreign countries using the same mark.

There are a vast number of unpatented and unpatentable articles of manufacture of great value, protection to the manufacture and the sale of which by the original manufacturers can only be given by trade-marks, and the sale of which articles is in no wise restricted by State or national lines. The protection afforded to such manufactures when imported from foreign countries by treaty regulations, such as now exist relating to trade-marks, is extremely valuable, and their value is so apparent to every citizen of this country that it is very natural for them to desire the same protection that is thus afforded foreigners. Whatever protection is afforded foreigners under our patent laws is also already extended to citizens, and no further amendment to those laws is needed for that purpose.

Fourth. One great advantage of the legislation by Congress on the subject of trade-marks has been the gradual adoption of a uniform system of adjudication by the United States courts in regard to the rights of the owners of trade-marks and the confidence which has been established with the public in all such matters that have come within the operation of Federal legislation and the adjudication of the Federal courts. Especially has this confidence been promoted by the penal protection afforded by recent legislation.

Notwithstanding the recent decision of the Supreme Court in holding the trade-mark acts invalid, this office is receiving continually applications to the number of forty or fifty a month for registration; and where it is shown that the applicants are

aware of the said decision, which fact is required to be made evident in every application, registration is granted subject to the provisions of the law hitherto in force.

I regret that the very short time given me to answer your inquiries has prevented a thorough consideration of the subject—a subject which is a much older one than that of patents and covers a far wider field. Patented articles are the product of inventive genius alone, and their production is confined to comparatively few, while trade-marks, in themselves also assignable personal property, are applicable to all articles of commerce, and may be adopted by anyone who wishes to distinguish his goods from those made by another.

Very respectfully, your obedient servant,

W. H. DOOLITTLE,  
*Acting Commissioner.*

Hon. M. A. McCoid,  
*House of Representatives.*

Mr. McCoid. I have a brief on the subject supporting this statement which I will print without reading. After the expiration of a patent it becomes public property, and in that respect would not be patentable as a trade-mark. The words imprinted upon patented articles of manufacture are common property after date of expiration of the patent. (*The Locke Manufacturing Company v. Levi C. Boyington* (October, 1875), *Official Gazette*, Patent Office, volume 9, January-June, page 455; *Edleston v. Vick*, 23 *English Law and Equity Reports*, *Official Gazette*, Patent Office, volume 14, page 270.) The office has hitherto refused to record such names as trade-marks, and the courts, both in England and this country, have declined to extend protection to their use. In this case the vice-chancellor held that in the matter of "Taylor's patent pins," the patent having expired, everybody had a right to use that term. If that alone constituted the whole of the label, it was public property.

C. E. Richardson et al. (3 *Official Gazette*, 120): The Commissioner refused registration of the words "A. Richardson's Union leather-splitting machine," on the ground that the words presented had become the generic name of the machines by which the public knew them.

The Consolidated Fruit Jar Company (14 *Official Gazette*, 169): When by long usage the name of a person in designating a certain class of manufactures has become generic in its character, such a name is at common law not a lawful trade-mark. The Commissioner is prohibited by section 4939 from registering as a trade-mark the name of a person merely. While the owners of a patent have the right by virtue of such patent to stamp goods manufactured thereunder with the name of the patentee, such right succeeds to the public with expiration of the patent, and the exclusive monopoly of such name can not lawfully be vested in the present or former owners of the patent as a trade-mark. (*Canal Company v. Clark*, 13 *Wallace*, 311.)

Another principle of the old trade-mark law was that the name of a person can not be used as a trade-mark or the generic name describing an article can not be made a trade-mark; and in the bill gentlemen have reported here they have made provision that the name shall not be made a trade-mark, carrying out the decisions to which I have alluded in that respect, also the old law, so that under the patent laws no such protection could be given as the Judiciary Committee seem to indicate. These are all false hopes, forced and unnatural.

I lay down these two propositions:

First. It is a public necessity that we have throughout the United States one universal, uniform, harmonious system of legislation upon the subject of trade-marks.



Second. There is no power granted to Congress in the Constitution to enact such a system, nor has Congress the power in any practical way to legislate upon the subject.

A trade-mark is a species of personal property of such intangible and invisible character as to require for convenience and control that it be evidenced to the rightful possessor by the grant of a certificate by Government, and although it belongs as a natural right at common law to the individual who originally adopts and uses it, yet that right should be merged into the statutory grant when made. In the mixed form of our Government it has long since been demonstrated by experience that such subject can alone be controlled harmoniously by the Congress, and it was the purpose of the fathers of the Government, who in convention framed the Constitution, to include in the powers of Congress all such subjects. The evils which led to this practice, under the old confederation, are familiar to all, and I take up no time to enumerate them. These evils were but examples of all that would result to the country if this subject of trade-marks is solved in any way except by giving the entire control of it to Congress. Confusion, conflict in State laws and State decisions and State practice, vexatious lawsuits, jealousies, and loss of value to all such property and the interests of manufactures and trade would result.

That this subject was not so specifically granted along with others of its analogues in the Constitution is because at that time it was unknown; but few cases had been reported; it was unmentioned in law books of the day, and its importance was unfelt. It has grown up since, and to make a grant of that power now is but carrying out the spirit of the founders of the Government. The very nature of the property is such that we can not cast lots upon it and divide it out to the jurisdiction of thirty-eight governments who are unable to form treaties with each other, and give the General Government what is left under interstate and foreign commerce. The commercial nations of the world have by reciprocal treaties expressed their opinion that reciprocity, uniformity, and harmony in the protection of trade-marks should exist. But there is no way of obtaining reciprocal action among individual States but by transferring the whole subject to Congress. Grants in the Constitution of power to Congress to legislate upon a subject of common interest is in the nature of a treaty of the States, and as all the nations have united in this necessity, so should the States in this amendment, to the end of securing a harmonious system of enactments. The conflicting action and failures on the part of nations to recognize the rights of trade-mark owners fairly exhibit the natural result of State legislation.

If protection is to be limited by State lines, trade-marks will become of little value.

It is laid down in all authorities on this subject that such marks in their very nature are unlimited by time or territory; that they have individuality—a singleness and unity which renders the subject indivisible.

The practical effect of an attempted regulation of these commercial signatures, under the theory that they come within the clause of the Constitution on the subject of commerce, is to give to one portion of our citizens superior protection and leave a large portion, perhaps the largest, out of its pale. It would be very offensive—simply outrageous—if such a law should prove to be valid and give to aliens the monopoly of



trade-mark protection, leaving our own countrymen to the cold remedies of common law.

It is far better not to undertake any Quixotic attempts against the Constitution, any mere tentative, temporary statute. Our foreign or interstate interests may as well wait as the larger portion of trade and traffic between citizens of the same State. Up to 1870 all that we had was the common law, and we extended in our courts to treaty-protected aliens equal protection with our own people. We are, not through our fault, thrown back to that status. Aliens only suffer with ourselves the temporary inconvenience of the statutory interregnum. They can not justly complain or retaliate. This is a Government of delegated constitutional powers; and they must wait the constitutional process by which that instrument can be amended and statutes passed. If we in good faith enter upon the path best calculated to secure that protection which they demand, it is all they can reasonably ask.

It is not the part of wisdom to allow the swift pressure of their interests to push us to that partial action which the Supreme Court well says "it is quite probable \* \* \* if the matter were now before that body [Congress] it would be unwilling to do, namely, make a trade-mark law which is only partial in its operation, and which would complicate the right which parties would hold in some instances under the act of Congress and in others under State laws." This is the discordant, partial, and unsatisfactory law now urged as a substitute for the constitutional amendment. The Supreme Court refused to make it by judicial construction, and we should refuse to make it by doubtful constitutional experiment.

#### NATURE OF TRADE-MARKS.

The origin of this species of property, the rights and remedies, sustain the proposition that it is and should be controlled by a comprehensive national code. First, trade-marks exist as a natural proprietary right, and received recognition and judicial protection prior to any statutory enactments. And they now, in the absence of any legislation on the part of the United States, or of any constitutional power to so legislate, still exists as the property of the person who has first adopted and used a mark on any certain article to distinguish it. Such person has the right of action for damages for the fraudulent use of his mark against any one who applies it to any similar article of other origin or make. He has this proprietary right for an unlimited time and bounded by no State or nation. He has also the equitable right to restrain the unlawful use of his mark.

The right exists. The owners ought to be further protected. The common-law remedies have been felt to be inadequate for many reasons.

First. The issue of whether or not the plaintiff is in the rightful possession of the mark by prior adoption and use must in each separate case be established. As time wears away this becomes very difficult, if not impossible. There is no court in which this issue may be once presumptively adjudged for all, and a record of such judgment certified and the results remain, once for all, *res adjudicata*.

Second. The remedies are not sufficient to restrain the greed of gain and the bravery of fraud. The gains are so out of proportion to the risk that, in the general stampede of pirates, a trade-mark depreciates as fast as fiat money. The public are so deceived they put no faith in even the genuine; and the manufacturer finds that which wholesome

legislation would render of great value to himself and the purchasing public comparatively worthless—not worth the expense of the endless petty litigation necessary to preserve it.

Third. Beyond the little circle of his own domestic life, his State, and his friends he is left to the dim sense of natural justice, which lends its cold hand to the alien suitor. He is without remedy.

But I believe as yet no one has seriously announced himself as opposed to additional statutory protection to trade-mark owners. But the discussion is between three classes of thinkers.

First, those who believe the local legislation of the States all that is required, and that the subject of trade-marks should, with the ear-marks and brands of domestic animals, be governed by domestic statutes of each State.

Second, those who believe that it is a subject that can be practically divided, and partial control left with the legislatures of States; and the other portion, under the head of commerce among the States, Congress has constitutional power to regulate.

And third, those who are of the opinion that it is an indivisible subject, entirely national in its vast importance, of which the mere commerce between citizens of different States would cover but little if any, and that no clause of the Constitution comprehends it; but that it has grown up and become recognized as requiring protection, in the interests of manufactures and trade, since the adoption of the Constitution, and that it is of sufficient importance to be made the subject of a grant of power to Congress, in order that the whole subject may be made the object of one uniform, harmonious, and efficient national statute.

Before entering upon the discussion of these propositions, let us inquire into the nature of the right or property to be protected. A trade-mark is the exclusive privilege of using a mark or symbol to distinguish articles of manufacture so that purchasers may identify them. To perfect a trade-mark as the property of a person requires the manufacturing of a certain article of salable property, the selection of a certain mark or design to identify such property as genuine, the impressing of that mark upon the property. These done, and the use is complete.

This adoption of the mark and impressing it on the goods is the complete and perfect use of a trade-mark. The manufacture of the goods before or the shipment and sale of the goods after are in no proper sense comprehended in the subject. (See Brown on Trade-Marks, section 52 and section 109.)

The mark does not exist, except it be as a conception of the mind; but in law or fact it does not exist until it is impressed upon goods, as your signature only exists when written. In fact, the marking the goods of a manufacturer with his commercial signature or stamp of genuineness is, if a part of either, a part of the finishing act of the manufacture of the article, rather than belonging to the transportation, sale, or commerce of such goods. The goods are prepared and marked in the manufactory before they are ready for transfer to the sales or shipping room. Of course every separate act of the manufacture, from the purchase of the raw material to the impress of the signet of trade, the seal of ownership, is prompted by and accompanied with an intent to sell in any and all the markets it is possible to enter. And the goods thus completed are intended to be the subjects of intrastate,



interstate, and foreign commerce. The entire thing enjoyed is the preference in market for certain goods. In the words of one court:

It is a right which can be said to exist only and can be tested only by its violation. It is the right which any person designating his wares or commodities by a particular trade-mark, as it is called, has to prevent others from selling wares which are not his marked with that trade-mark in order to mislead the public, and so, incidentally, to injure the person who is owner of the trade-mark.

The property which is to be the subject of constitutional and Congressional protection is in the combination of the article manufactured and the distinguishing mark, its consummation as the rightful possession of its owner, and its violation consists in stamping the mark on the goods.

As patents and copyrights are already subjects of Congressional clauses and of exclusive legislation by Congress, a comparison with them will give a clear idea of the nature of the property in trade-marks.

Primarily trade-marks differ from patents and copyrights. Their origin differs. A mark for use in trade is selected anywhere; the word, the idea, the sign, may be as old as Adam. It may be a mule's ear, a lion, an elephant, or a star. It originates only by adoption and use. Patents spring from original invention; the owner is father to the idea.

Copyrights also belong to the claimant by reason of originality of production. It is the creature of his intellect, his thoughts, his genius, and therefore his own.

In this they differ. Patents and copyrights become the owners' property in a different way and for different reasons from trade-marks. But even in this difference there is a latent analogy. Priority of use, the very twin of originality, is the title bond to a trade-mark. One is the priority of thought, of invention, of discovery; the other the priority of combination. And in that combination there is originality, thought, invention, and discovery. Many patents are but the result of priority of combination of "plain, simple, old, and well-known" things. Many grand and beautiful productions of the most brilliant stars in the literary world are but masterly conceptions of the combined effect of familiar fancies, the precipitate of old thoughts. In this sense the adopter and user of a trade-mark is both the author and the inventor of the combination of the marked goods. And he has no exclusive property in it except in that original application in which it is impressed upon the article.

But I am not differing from the opinion of the Supreme Court. I only intend to show you that while this subject of trade-marks was not contemplated by our fathers in the writing of the clauses of the Constitution on the subjects of patents and copyrights (as it was not in the clause on the subject of commerce), yet the subject, as it has grown into importance since their day, is analogous to them both, even in that in which it differs most, its very origin. But admitting this difference between them here in the literal want of a relation to invention or discovery, or in the want of originality or the fruit of intellectual labor, I venture to assert that this is the only point of difference. This absence of invention and originality excludes it from the contemplation of the clauses of the Constitution in relation to these subjects in the opinion of the Supreme Court. Pass from the birth of the proprietary right and examine the nature of the property. What do



you find? The species of property is the same. The character, the nature of some rights is best disclosed by their violation, and this is true of these three proprietary rights—patents, copyrights, and trade-marks. Their violation is an infringement. In all these it is identical. American decisions have from the first, and English decisions have at last, placed the protection of trade-marks along with patents and copyrights upon the ground of property. In deciding upon just the nature of this property and its distinctiveness from commerce let me call your attention to all property of this kind. I may omit some, but I believe they are included in these patents, copyrights, trade-marks, the good-will of trade, and the property in the name of a magazine or other serial literary publication.

In point of property all these stand upon the same ground. However that property may be acquired, it is itself the same in all. They are identical, too, in the remedies which the law extends to them. The nature of the injury in each in case of piracy or infringement is the same. That injury is felt in cheapening the price of the goods by an inferior competitor and destroying the reputation of goods by the discovery of the inferiority, or, if not inferior, by fraudulently securing the advantages of the character of another in the market. The common-law remedies are the same. The injured party has his action for damages for fraud or the infringement, and his equitable right to restrain by injunction, and ought to have the better remedies of the statutes against counterfeiting and pirating.

To sum up, then, the discussion of the nature of the property in trade-marks, I say a trade-mark is a symbol of genuineness impressed upon certain salable goods by the prior appropriator of that mark; that he has a species of property in the exclusive application of the symbol to the specified articles; that his remedies are damages for infringement and injunction, and other more efficient statutory protection; that in the species of property, the injury, and the remedies, it is identical with patents and copyrights.

IS THE POWER TO REGULATE TRADE-MARKS CONTAINED IN THE POWER TO REGULATE COMMERCE?

But the point of serious divergence of opinion, perhaps, is the next, that the subject can be practically divided into that regulation of trade-marks used in interstate commerce by itself, and that part used in State commerce by itself; and that Congress, under the power to regulate commerce among the States, already has all that is needed for her share, leaving to the States the rest. A great many still hold to this opinion.

I suppose the germ of that opinion, and the suggestion of that position which takes form in the bill (H. R. No. 2573) by Mr. Armfield, lies in the remarks of the Supreme Court in the late opinion declaring all present laws unconstitutional; and I want first to carefully examine that opinion upon that point. Of course we all know the danger of seizing upon the running words of a writer of an opinion who means no more than to decide the case in point, and dreams not of suggesting legislation, or any other improper *obiter dicta*. And we know, too, how utterly futile, how useless, and how injurious is the effort to cling to straws like a drowning man when a decision has swept away, as a flood, all the structure of law by taking from under it the foundation. No judge would express his opinion upon this subject now.

He would not prejudice a case off the bench which he was so careful to leave undecided on the bench.

You will find on page 5 of the report of the Committee on Manufactures, in the opinion of the court, the following language:

The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, *we propose to leave undecided*. We adopt this course because when this court is called on in the course of the administration of the law to consider whether an act of Congress or any other department of the Government is within the constitutional authority of that department, *a due respect for a coordinate branch of the Government requires that we shall decide that it has transcended its powers only when that is so plain that we can not avoid the duty*.

In such cases it is manifestly the dictate of wisdom and judicial propriety to decide no more than is necessary to the case in hand. That such has been the uniform course of this court in regard to statutes passed by Congress will readily appear to any one who will consider the vast amount of argument presented to us assailing such statutes as unconstitutional, and will count, as he may do on his fingers, the instances in which this court has declared an act of Congress void for want of constitutional power.

Here I suppose are the paragraphs in which is suggested the hope that such constitutional legislation is possible.

The question was, Does the trade-mark bear such a relation to commerce as to be controlled by Congress as an attribute of it? They say, "We propose to leave it undecided." But why? Because "*a due respect \* \* \** requires that we shall decide." Decide what? Decide "*that it has transcended its powers*." Then that is the disagreeable duty they propose to leave undone now, and to do "*only when \* \* \** we can not avoid the duty." It is as much as to say Congress has not yet in that way or under that claim or pretense transcended its powers. It has not been so foolish or so grasping or so ill-informed as to even believe it was acting under that clause of the Constitution.

When it is plain that such is the case, when Congress undertakes to enact a law which can only be valid in that clause, and upon the claim that a trade-mark bears such a relation to commerce in general terms as to be a subject of its control, then, and not till then, in a proper case we will add one more to the few instances in which the Supreme Court have declared its acts void for want of constitutional power. Then the court proceeds to show that Congress did not claim such power under the commerce clause. It could not regulate commerce except "*among the States*," "*with foreign nations*," and "*with the Indians*." And as the largest part of commerce is perhaps within the State, the power would not be adequate, not sufficient, not comprehensive enough. It was evident the regulations of trade should and were intended to be "*applicable to all trade, to commerce at all points*." "*Its broad purpose was to establish a universal system of trade-mark registration for the benefit of all who had already used a trade-mark, or who wished to adopt one in the future, with regard to the character of the trade to which it was to be applied or the locality of the owner*."

I should rather believe from this language that the reserved judgment of the court, so far as formed, though unexpressed, was that so far as it affected protection of trade-marks in a State or its use in interstate traffic, the act was unconstitutional as a regulation of commerce. I make these remarks upon that decision with much diffidence,



not willing to put words in the mouths of the court or twist these from their intended meaning.

Now, let us sum up the argument found in the decision of the Supreme Court against the constitutionality of this legislation under the commerce clause. They assert that it is not every species of property which is the subject of commerce or which is used or even essential in commerce which is brought by this clause of the Constitution within control of Congress. They say a due respect requires that they decide that Congress has transcended its powers only when they can not avoid it; and for that reason they leave it undecided. They show that this power of regulation conferred on Congress is limited, while trade-marks require unlimited regulation, and that the largest amount of traffic where it affects is beyond the limits of this power. They say it is evident Congress did not believe it was acting under this clause. They show that the broad purpose of Congressional legislation was manifestly to establish a universal system for the benefit of all without regard to trade or locality.

They regard a partial law as so objectionable as not likely to pass Congress. They say it would complicate rights and cause a conflict of law between State and nation. They close by saying the inquiry whether these statutes can be upheld in whole or in part as valid and constitutional must be answered in the negative. That it is not upheld as a universal system under the patent clause, as a whole—not under the commerce clause so far as affects interstate and foreign commerce, in part. That is a bold mind that can face these statements of the decision and say they meant to suggest that such a law could be valid.

But I am the more confident in this, because this view is sustained by the best reasons; and in my judgment, upon the merits of the case, should it ever come before that court, requiring their decision, they would decide the subject of trade-marks to bear no such relation to commerce as to bring it within Congressional control.

It is not a subject of commerce; it is not a vehicle or instrument of commerce. It does not come within any of the decisions extending the meaning of the term commerce in the Constitution. It will not do to say, because the goods to which a trade-mark is applied are intended to be transported from one State to another, or sold by a citizen of one State to a citizen of another, that the mark becomes so related to commerce as to be the subject of Congressional control. The argument proves too much, and would draw within the control of Congress all species of property and all the minutiae of its manufacture.

If you take the subject out of the field of specialties, such as patents and copyrights, and place it within that of commerce, then you leave it there to be divided into parts and give it an even worse status than if left entirely to the States. It becomes then your duty to carve out of it what is commerce within a State, what is commerce among the States, what is foreign commerce, and what is commerce with the Indians. Where will you draw your lines without confusion? How will you frame your statutes with precision? Who is to decide what claimant has the priority? Who is to reconcile conflicting decisions? How are you going to bring about uniformity in the system? When Massachusetts decides with A and South Carolina with B and Texas with C and the United States with E, and each within the limits of that part of the control of the subject committed by you to that particular government exercises his right of ownership to the same mark, who is to bring order out of that confusion?



You draw around your legislation the lines of constitutional limits by repeating the words "used in commerce with foreign nations, or among the several States, or with the Indian tribes," as Richelieu threw around his protégé with the gesture of his hand the muniments of Rome. Then, christened thus in constitutional phrase, you do the identical things which the Supreme Court have decided you can not do. Are the forms of the Constitution put on and off so lightly and so easily? Does the Constitution change like the colors of a chameleon? On a green branch is it green; on a black, black?

This, to my mind, is the simplest folly.

Suppose you say, "Used in commerce among the several States, or with foreign nations, or with the Indian tribes." Trade-marks used in commerce among the several States! How used? What do you mean by "used in commerce among States?" Trade-marks are just marks. In the simplest meaning of that word, can you use a mark in commerce? You may mark something that is going to be shipped; or you may ship something that is going to be marked; or you may mark something, and it may some time be shipped. Again, are you going to give the proprietary right of a citizen of a particular State to a trade-mark used within his own State by your act to another to be "used in commerce among the States or with foreign nations?" How are you to tell, in the exercise of your divided jurisdiction, how much conflict you create with the local rights of others? While I enjoy in Iowa the protection of my trade-mark in the local markets of my State, are you to permit others shipping in from other States or nations to pour in upon me, under the ægis of your protection and exclusive grant, goods impressed with my trade-mark? Then what do you mean, and where do you draw the line?

Mr. Speaker, do we not see that the subject is indivisible, inseparable; that, as Congress wisely attempted to do, had it had the power, what we want to get the power to do and do is to establish a universal system of trade-mark registration for the benefit of all, without regard to the character of the trade to which it is to be applied or the locality of the owner; to have a uniform system, one place of granting certificates, one place of record, one statute of protection, one penalty of violations?

We have seen it is like patents and copyrights in nearly every respect. Ought it not, like them, to be made the specific subject of Congressional control? Even were it possible to force the terms of the Constitution to meet the case, it would be vastly more harmful than to make a specific grant of the power, as the resolution provides. There is danger in extending the powers of Congress by inference and construction of its present clauses beyond their natural and original meaning. And it is much the safer and better plan to enlarge these powers by additional and express grants as in the progress of time they become necessary.

See the case of *Gibbons v. Ogden* (9 Wheaton R., 198).

In *Veazie v. Moor* (14 Howard, 568), Justice Daniels says:

Taking the term commerce in its broadest acceptation, supposing it to embrace not merely traffic, but the means and vehicles by which it is prosecuted, can it properly be made to include objects and purposes such as those contemplated by the law under review? (A law granting the exclusive right to navigate the upper waters of a river lying wholly within the limits of the State granting it, impassably separated from tidal waters and not forming a part of any continuous track of commerce between States.) Commerce with foreign nations must signify commerce which in some sense

is necessarily connected with those nations, transactions which either immediately or at some stage of their progress must be extra-territorial. The phrase can never be applied to transactions wholly internal between citizens of the same community or to a policy and laws whose ends and purposes and operations are restricted to the territory and soil and jurisdiction of such community. Nor can it be properly concluded that because the products of domestic enterprise in agriculture or manufactures, or in the arts, may ultimately become the subjects of foreign commerce, that the control of the means or the encouragements by which enterprise is fostered and protected is legitimately within the import of the phrase foreign commerce or fairly implied in any investiture of the power to regulate such commerce. A pretension as far-reaching as this would extend to contracts between citizen and citizen of the same State, would control the pursuits of the planter, the grazier, the manufacturer, the mechanic, the immense operations of the collieries and mines and furnaces of the country; for there is not one of these avocations the results of which may not become the subjects of foreign commerce, and be borne either by turnpikes, canals, or railroads from point to point within the several States toward an ultimate destination, like the one above mentioned.

Such a pretension would effectually prevent or paralyze every effort at internal improvement by the several States; for it can not be supposed that the States would exhaust their capital and their credit in the construction of turnpikes, canals, and railroads, the remuneration derivable from which and all control over which might be immediately wrested from them, because such public works would be facilities for commerce which, while availing itself of those facilities, was unquestionably internal, although intermediately or ultimately it might become foreign.

The rule here given with respect to the regulation of foreign commerce equally excludes from the regulation of commerce between the States and the Indian tribes the control of turnpikes, canals, or railroads, or the clearing and deepening of water courses exclusively within the States, or the management of the transportation upon and by means of such improvements.

To whip the devil around the stump and avoid the effect of a constitutional inhibition by the jugglery of a few empty words, were it possible, would be full of danger.

Why quibble around the Constitution and make a lame, indefinite, useless law, instead of manfully shouldering the whole question, get the necessary power in the good old way, and then legislate intelligently and safely? All that could be secured by any other course would be additional doubt, litigation, conflict, until the law would become a dead letter.

Now, in reference to the amendment here, I ask leave to substitute for the amendment in its language the following, which I will ask the Clerk to read:

The Clerk read as follows:

SECTION 1. Congress shall have power to provide for the registration and protection of trade-marks.

Mr. McCoid. That brings the constitutional amendment simply down to what we want, and there can be no objection, as I understand the gentleman from Georgia to say there might be, to the wording of the amendment, and I ask this to be made the section instead of the one in the resolution, so that there may be no objection to the wording of the resolution.

Now, Mr. Speaker, in reference to the amendment. Gentlemen here have expressed themselves—and I believe it is the general feeling upon the subject—that they are opposed and unwilling to amend the Constitution except upon a great necessity. I agree fully with the expressions of the gentleman from Georgia as to that venerable and venerated instrument, and I am in full accord with him on that subject that it is dear to us by the associations of history in connection with the times in which it was made, and that it is wise in its provisions.



But, Mr. Speaker, it is only the articles of incorporation of this Government, and the doctrine that it is unchangeable can not be maintained for a moment. The American people are not a stolid, unprogressive people, that require no changes in their organic law. We are not Asiatics, and I can see no argument in the assertion that the Constitution was designed by its founders not to be changed to fit the conditions of a growing, prosperous nation. The lion's skin may become too short. We are stretching our limbs; we are expanding our lungs; we are extending our territory, increasing the number of our States, extending new lines of railway, stretching telegraph wires across plains and mountains; we are swarming above and talking beneath the seas; we are overcoming new difficulties and contriving new forces and instruments of enterprise, and the giant form which is thus growing to manhood can not lie within the narrow confines of the cradle of its infancy. And those honored men whose names we revere and whose work has come down to us with the sanctity that attaches to it intended that there should be changes in the organic law and provided that changes should be made. In reference to this necessity, I beg leave to read one or two extracts from the Civil Policy of America, by Draper.

He writes:

The first and most important condition for the prosperity of a great nation is stability in its institutions. But stability must be carefully distinguished from immobility. We must bear in mind that the affairs of men are ever changing; successive generations live under essentially different conditions; public necessities are therefore continually varying, and disorder arises as soon as institutions prescribe one course and necessity demands another. To insure stability the political system must therefore admit of change—that change being in accordance with a law of variation which depends on a fixed principle. Unchangeability should belong to the law, not to the institutions issuing from it. In that manner alone can order and progress coexist, and the demand made by modern statesmanship with so much solicitude be satisfied. It truly affirms that there can be no real order without progress, and no real progress without order.

Institutions well adapted for five millions of people will certainly be very unsuitable for fifty. Institutions intended for a narrow coast line will certainly be inadequate if applied to one of the quarters of the globe. Edifices, though they may be built of iron, will fall to pieces if the architect has not made provision for expansion at one point and contraction at another. Where motion must in the necessities of the case occur, it is essential for safety that there should be a harmony among the moving parts. Inequality of progressive movement implies strain, strain implies fracture. It is therefore the province of statesmanship to determine how change shall be provided for in political institutions, and what is the true nature of the law by which they shall be modified. Above all, it is its province to discover the immutable principles on which that law must rest. It is better for communities to advance through legal forms than by revolutionary impulses, or by attempting to secure stability through incessantly failing experiments. The only safe guide for them to follow is furnished by a careful investigation of the circumstances under which their life has been and is to be spent.

Now, I have only to say further that changes in our Constitution should be made only for imperative reasons. It is only a question of necessity, so as to place ourselves as a nation and our people upon an equal footing with those of the commercial nations of the world. There is no power in the States to make treaties with each other. That power has been left to the General Government for them. This amendment provides no different rule with reference to this than is applicable to our treaties with England, France, Belgium, and the other nations of the world, stipulating that uniform laws shall govern all alike upon the subject of trade-marks. We have not hesitated to seek that uniformity of mutual protection by treaties with other governments, and why should we decline to unite our thirty-eight States



in the same uniformity through constitutional amendment and national legislation. We have not feared to change international law, why should we refuse to amend the interstate organic law. The Constitution, Mr. Speaker, is not a mummy of unchangeableness laid away in the pyramid of our reverence for our fathers, but the plastic charter for a living, growing, ever-changing people. Here is a great interest affecting vitally our trade and commerce, and we desire to legislate upon it. We thought we had the constitutional power. We enacted what we intended to be, in the language of the Supreme Court, a uniform system of trade-mark legislation. It worked well and satisfactorily to the whole people.

That legislation was declared void for want of constitutional power. It is admitted by the opponents of this amendment that it would be a great convenience to the people. The plain, direct, practical way out of the difficulty is first to secure the power, all that we supposed we had by the constitutional amendment, and then legislate as we did before.

The gentleman from Georgia seems to think the subject a trivial one, and not of sufficient importance to justify this action; and in his attempt to belittle it he talks of the protection of "Winslow's Soothing Syrup" and such things as that. I wish to remind the gentleman, in order to relieve his mind from that attempt to belittle the subject, that he justifies and eulogizes our fathers for placing the copyright clause in our Constitution; but he might, with a like spirit of unfairness, as well have ridiculed them by referring to these copyrighted works I have before me [holding them up]—the "Dashington Brothers' Negro Song-Book," the "Pitcher-of-Beer Songster," the "Sullivan and Harrington Sweet Jerusha Jane Songster," "Little Grant's Tired of Single Life Songster," "Mother Goose," "Weston Brothers' Laughing Chorus," and "Jenny Jones's Songster."

A MEMBER. Do not forget "Jack, the Giant-Killer."

Mr. McCoid. I will include "Jack, the Giant-Killer," as the gentleman suggests, and I might mention many others. The gentleman from Georgia attempts to belittle the subject; and yet he stands in the presence of the fact that the great sovereignties of Germany and America, the great sovereignties of France and America, the great sovereignties of Russia and America, the great sovereignties of Belgium and America, and all the powers with whom we have treaties have met in solemn convention, and the high contracting powers have considered this subject and made it an important clause in treaties between great nations. Yet the gentleman could not point to anything of the kind with reference to the copyright laws or the patent laws. It is a subject of far more importance to-day to the prosperity of the American people, their trade or their commerce, than I fear the gentleman from Georgia has any idea of.

If that trade-mark law had existed under the penal section in the acts of Congress protecting trade-marks, we would soon have had thousands and thousands more of them. The trade-marks registered in the Patent Office to-day do not represent one-tenth of the trade-marks in this country. You will find them in every grocery, in every store, in every manufactory, that are not recorded at all, because the people had not arrived at a knowledge of the efficiency of the protection of the national laws until 1876, when the penal clause was put in. Men will not protect themselves under the common law by suing for damages, for the

result is too small for the expense. But the penal laws to punish the pirating and counterfeiting of trade-marks would lead every man who had a trade-mark to pay the fees of the Patent Office and receive his registration.

#### STATE RIGHTS AND STATE LEGISLATION.

I must refer briefly to another question which the gentleman from Georgia discussed, as to whether States may properly protect these rights. We have, the gentleman says, in a great many of the States laws on this subject; that the common law and State legislation afford all the protection American owners of trade-marks need. The gentleman from Georgia says:

It is claimed that the States can not adequately protect trade-marks. Why not? Their judges are as honest and as learned in the law as those upon the United States benches. The jurors, if different in the two courts, are not better in those of the Federal courts; in some parts of the country they are much below the State standard of intelligence and virtue. States officers are more numerous and equally faithful, their courts more numerous and more accessible; justice can be had cheaper and quicker in the State courts.

Again he says:

This Government has naught to do with the protection of purchasers of manufactured goods. It ought not to have; that work properly belongs to the several States.

And then he closes his remarks with a brilliant rhetorical peroration on the subject of State rights and State sovereignty, in which he says, "The United States is strong enough; let us magnify the States."

It is really pitiable to see how every subject of legislative action, great or small, is poisoned, discolored, and put beyond the pale of just consideration in the minds of some men by the ghost of State rights. They seem to walk in a graveyard of the past, and every stone is a specter to harrow up their souls on this subject. They can not talk a half an hour upon any subject—the sword of Washington, the staff of Franklin, the dumb desk of Jefferson, or even the simple subject of trade-marks—without entering into learned disquisitions on the subject of State sovereignty. Excavators of the earth, they say, sometimes find stones from which when opened a toad leaps out. So it is with these gentlemen. They bring into this House some carefully prepared argument on the most innocent subject, and as you settle yourself in your seat to do justice in attention to their prepared eloquence you find yourself suddenly surprised and mortified to see leap forth as they open it the toad of State rights.

There is no State rights in this subject; none whatever. You are not asked to relinquish one power the States now have or to diminish in the least your State's right to control her domestic affairs. The common law will yet remain, the statutes of the States will yet remain, and their efficiency for domestic protection will be just as great. Why, the gentleman gives the States where statutes upon this subject exist, and says:

It appears (by absence of reported cases) that no one has ever sought to protect himself at law as to trade-marks in either of the States just named except Georgia.

And in Georgia there is no State legislation proper, for it but reenacts the common-law remedies. The United States passed a uniform system of legislation upon this subject in 1870, and added still more efficient amendments in 1876. Whoever heard of any complaint from

States? Was the glory of Georgia dimmed or her sovereignty humbled? Did it not give the most perfect and universal satisfaction except to pirates and infringers? Pshaw, now be reasonable! You say State legislation is enough for American owners of trade-marks. Well, then, why not good enough, ample enough, equally for aliens? Your logic cuts your own throat. Why are you here urging a bill to enact a code of trade-mark laws for foreigners—ay, the very laws which Congress did pass for all, and which it is desired to pass again for all as soon as this constitutional amendment is ratified, and which were declared void for want of constitutional power to pass them? Why do you urge these laws under another clause of the Constitution for foreigners only, and yet in the same breath say “there is no necessity for such legislation” for our own citizens? Will not State laws protect foreign citizens also? Are not your judges just as honest, your State jurors just as good, State officers just as numerous and faithful, State courts just as accessible, and justice there as much quicker and cheaper for citizens of other countries as of other States? By advocating this bill, this anomaly of legislation, you advocate this amendment, by which alone the same additional protection may be given to our people. Your arguments for it are magnified for our people with all the power of the audiphone.

Those laws are conflicting. Take, for instance, California. California gives a trade-mark to the man who first registers it with the secretary of state. In Oregon I think the right of a trade-mark is given to a man who first applies and registers his trade-mark with the secretary of state. In Missouri the trade-mark is obtained by a description acknowledged and recorded in the recorder's office of the county. Now, imagine those three laws in operation in the United States and one man claiming under the registry of California, another under that of Oregon, another under the law of Missouri, in virtue of a trade-mark recorded in some remote county. There would be no end to the litigation under such a conflict of laws.

The gentleman from Georgia states in his speech that in all these States, except in one case in Georgia, there has not been an action. Now, how do you account for the fact that in connection with a subject of so much importance as to be made the subject of all the treaties of the world there is not a single case reported in State courts except this case in Georgia? Why, it is because the laws are so futile and weak and unworthy that the people do not apply to them for a remedy. It would cost a man more to hire his attorney than all he would get in the form of petty damages for the infringement of his trade-mark. The gentleman is mistaken as to many of the States he has cited as having trade-mark laws. In many cases they are only penal clauses as to general brands—merely domestic arrangements, nothing else. But we find State legislation is utterly insufficient, and it will result in conflict. The Supreme Court say in their opinion the Legislature would possibly not pass a law protecting foreign trade-marks and leaving the rest to State legislation, which would result in conflict of legislation.

But gentlemen who argue for this bill for foreigners under treaties must find themselves admitting that State legislation is not sufficient, else why do aliens want more? There must be something urgent, important, necessary, which under treaties foreign citizens demand



and which common law and State legislation will not give. Your constitutional provision upon which you found your power says it must be "necessary and proper" legislation to execute a treaty.

Well, then, does not the same great occasion exist for our citizens of the United States to urge such legislation for themselves? I say State legislation is not sufficient. The Committee on Manufactures, to which the subject properly belongs, says the amendment and legislation under it is necessary. But the gentleman asks why? Because State laws are limited to State lines. Because some States will be more interested in protecting trade-marks than others, and those who feel no interest will not go to the expense of providing and enforcing adequate laws; just as under the old confederation, where the expenses of wars were to be contributed by the States, those States at a distance from the seat of war and secure from its dangers refused to contribute to its expense. Because conflicts will arise in legislation as well as in ownership of marks in different States. Because there will be no common court or office to determine the rights of claimants, keep a record of marks, and grant certificates. Certificates of trade-mark ownership are assignable like patents, and under a system of State certificates there would be no security against duplicates from different States.

State legislation has never been of sufficient advantage to be sought. Because commercial relations with other countries and among the States have become so intimate and great that the world looks to the General Government for a recognition of a subject so importantly connected with it. Because the subject is not local or domestic in its character, but is similar in every respect except its origin to patents and copyrights. There are no trade-mark laws except in the States of California, Connecticut, Kansas, Maine, Massachusetts, Michigan, Missouri, Nebraska, Nevada, New Jersey, New York, Ohio, and Oregon. Illinois has laws forbidding refilling vessels containing certain liquors. Iowa has a penal section for counterfeiting marks, stamps, or brands. Kentucky punishes the use of a false brand. Georgia gives courts of equity common-law powers by statute. Pennsylvania has some penal statutes. Indiana has a penal section against refilling bottles of certain liquors in certain cases. That is all. Substantially, there is no State legislation comprehending the subject of trade-marks.

Now, the gentleman from Georgia thinks there is no conflict, and State legislation could not result in conflict and confusion. The worst conflict to be feared is in the claim of ownership to a trade-mark. In the few and meager laws now existing in States let us see if there is any such conflict. Take California. Any mechanic, manufacturer, druggist, merchant, or tradesman in that State may secure the exclusive use of the mark usually fixed by him on his goods by filing with the secretary of state a copy or description of the same and claim of ownership, with his affidavit that he is the exclusive owner, or agent of the owner, and paying a fee of \$3.

In Missouri the mechanic, manufacturer, or other person executes a description of his trade-mark, acknowledges it, and records it in the county in the office of the recorder of deeds, which is notice to the world.

In Nevada anyone registering his trade-mark or name with the secretary of state is protected in that mark.

In Oregon the trade-mark is registered in the office of the secretary of state by the person who first presents the same for record, and gives that person the exclusive right to it. Different States protect trade-marks on different preferred things. One State mineral water, one beer, one flour, one watches, one wines, etc. It seems to me that here is chaos of confusion and conflict of laws sufficient even for the gentleman from Georgia. And now the addition of this partial legislation under this bill will but come in to render in its workings "confusion worse confounded" until, as even its advocates say, we will be driven finally to adopt the proposed amendment.

But why wander in this wilderness of unsatisfactory laws until taught by sad experience our duty? Let us go right over to the inevitable now. I know the pressure from foreign influences, from the State Department, and from attorneys representing the wealth involved in foreign trade-marks, which is brought to bear upon Congress to pass some measure of this character as a present necessity, leaving its constitutionality to the courts and its evils to be developed; and I feel that the bill will pass. But if it does I hope it may not be made an instrument of defeating the submission of the proposed amendment. It proposes no change in the Constitution as made by its framers, only an addition to it, and one in the nature of carrying out the will of its original framers. It is but doing what they did for like subjects. They gave to Congress power to legislate on certain subjects then known to them to be of public concern. Since their day one more of the same species has been added in the growth of the world's intercourse. We execute their unfinished will by adding it.

Let the matter be submitted to the States, and let the people vote upon it. That, at least, is their right. And it would be a pleasant and satisfactory evidence of common sentiments of attachment to the Union to see thirty or more of the States unite speedily in making a grant of power to the General Government to regulate a subject of such wide interest and concern. I hope sincerely to see such a proof of patriotism and fraternal unity.

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Mr. ROBINSON. I do not intend to occupy the attention of the House very long at this stage of the discussion of this bill and at this hour of the afternoon. I deem it of the utmost importance now that we have a vote on this bill to-day, because it should be disposed of during this afternoon, in order that it may not obstruct business to-morrow. I say, then, to the House that if they will bear with us a very few minutes longer we can have a final vote and end this question to-day.

The subject-matter embraced in the Armfield bill and in the constitutional amendment which my friend from Iowa [Mr. McCoid] has discussed to-day were referred together to the Committee on the Judiciary. As my friend from Georgia [Mr. Hammond] has said, quite at length, that committee gave full, earnest, and patient consideration to this matter. We heard all gentlemen who signified any desire to communicate any facts or make any suggestions to the committee. We were in communication with gentlemen in the large cities representing the various trade-mark associations, and their attorneys have visited us very frequently. Not only did we hear the attorneys and trade-mark people, but we also gave all the opportunity that was desired to the gentleman from Iowa himself.



As the result of our conferences and examination of this matter, the Committee on the Judiciary came unanimously to the conclusion that we should recommend the bill which is now under consideration by the House. The committee, besides relying upon their own judgment, were confirmed in that judgment by the concurrence of the several gentlemen representing the different interests involved. And unless the Committee on the Judiciary are very much mistaken, they had also the consent of the gentleman from Iowa that other attempts should be abandoned and this bill should be placed on its passage. However, that does not debar any gentleman at this time from opposing the proposed legislation.

Mr. McCoid. Do I understand the gentleman to say that I consent to this bill?

Mr. ROBINSON. Not at all to-day.

Mr. McCoid. But at any time?

Mr. ROBINSON. I said that the committee understood (they may have been misinformed) at the time this bill was reported to the House that the gentleman from Iowa had waived his preference for a constitutional amendment, and had consented to this bill after consultation with the attorneys representing the various trade-mark associations.

Mr. McCoid. That was an entire mistake.

Mr. ROBINSON. If the committee were in error I am ready to be corrected.

Mr. HAMMOND, of Georgia. Will the gentleman allow me to make a statement?

Mr. ROBINSON. Certainly.

Mr. HAMMOND, of Georgia. The gentleman from Massachusetts [Mr. Robinson] is somewhat in error in what he quotes from me. I stated that the attorneys for the New York petitioners and the gentleman from Iowa [Mr. McCoid] had met me and agreed that the constitutional amendment and the bill should travel *pari passu*. And I reported to the committee that he had abandoned his opposition to the bill. I may have misunderstood him. The conversation occurred between him, Mr. Cox, and myself at that door [pointing to one of the doors in the Hall].

Mr. McCoid. I may have said that if the constitutional amendment was passed I would have no objection to this bill.

Mr. HAMMOND, of Georgia. Did you not agree with Mr. Cox that you would no longer fight the bill?

Mr. McCoid. No, sir; I never would have voted for the bill under any circumstances.

Mr. HAMMOND, of Georgia. Then I misunderstood you.

Mr. ROBINSON. Passing that over, because it is not very material, we do not find that there is any general demand for the proposed constitutional amendment. We have discovered that in this way: After our hearings, which were protracted and numerous, we held the matter a long time under advisement before we would report the bill to the House. The gentlemen representing the different trade-mark associations were notified by the subcommittee that they should correspond with their clients, the different manufacturers throughout the country, and inform us if they demanded anything further than the bill we had agreed upon. Up to the present time the committee have received no information that this bill fails to give them entire satisfaction, with a single exception coming from the city of Lowell, in the State of Massachusetts.



With that exception alone before us, the committee did not deem it expedient to ask the Congress of the United States to enter upon the process of amending the Constitution in order to meet this one petition. They say that if after the passage of this bill, and after it shall have gone into operation as a law, there shall seem to be a need for further legislation, something broader, something that shall reach interstate commerce and transactions between citizens of different States, that want will make itself known at the national capital, and then we can proceed to amend the Constitution, if it shall be deemed expedient. At present there is no demand for it; and that perhaps is a sufficient answer to all the arguments of the gentleman from Iowa.

Upon the subject of the number of trade-marks there may perhaps be some confusion or misconception. The gentleman says that less than eight thousand trade-marks have been registered; and such is the fact; but we do not say, and it is not the fact, that the number eight thousand covers all the trade-marks used throughout the country. It is, however, a test of the importance of legislation upon this subject. Assume, if you please, that there are five hundred thousand trade-marks used in the United States. Perhaps I have not over-estimated the number. We find them, for instance, on the different cigar boxes. There are all sorts of brands. Everybody puts on a box of cigars, if he wishes, his peculiar trade-mark. It is popular for the time; when its popularity wanes it is removed and something else substituted. It is never registered; it never becomes one of the eight thousand. Why? Because its value is not sufficiently great to persuade the party that he wants registration. It needs no protection by law; it takes care of itself. Hence I submit your committee are justified, and the House will be justified, in believing that if only seven or eight thousand of the great number of trade-marks have been registered there is not a universal demand for general trade-mark legislation; it does not yet appear that that demand is prominent before the business community.

This matter has been in print before the House and within the inspection of the different Departments for weeks; and I desire to call the attention of the House to a communication which I think will carry weight in the minds of members. I allude to a communication from the honorable Secretary of State indorsing and recommending this bill. The Secretary of State may be supposed to know by actual experience what legislation may be needed under foreign treaties in order to carry them into effect; and certainly he is a gentleman whose judgment upon matters of legislation and the efficiency of statutes no one will question. This letter was addressed to the honorable gentleman from Georgia [Mr. Hammond] on the subcommittee, who had not time to read it to the House. I therefore send it to the Clerk to be read.

The Clerk read as follows:

DEPARTMENT OF STATE,  
*Washington, April 22, 1880.*

SIR: I desire to ask your especial attention to the bill (H. R. No. 5088) recently reported by you in behalf of the Judiciary Committee (Report No. 561) and to request your best efforts to secure its speedy passage.

From the point of view of the obligations of this Government to the various foreign governments with which trade-mark conventions have been concluded prompt action providing for the registration of trade-marks is of the greatest importance. The subject is continually being brought to the attention of this Department by the representatives of foreign governments at this capital, who are naturally solicitous for the

interests of their countrymen and for the observance of the treaty stipulations. The interests of our own people in foreign countries would also suffer even more seriously by the removal of the protection which the reciprocal provisions of the various trade-mark conventions now furnish them.

I therefore earnestly request your committee to take such action for the speedy passage of the bill as may appear to you most appropriate, and thereby free our own citizens abroad and the citizens of foreign countries here from the unfortunate state of uncertainty in which they are now placed, as well as provide for the proper fulfillment of the international obligations of the Government.

I am, sir, your obedient servant,

WM. M. EVARTS.

HON. N. J. HAMMOND,

*Chairman of the Subcommittee of the Judiciary Committee,  
House of Representatives.*

Mr. ROBINSON. Thus it will be seen that this bill has the indorsement of the State Department, which I submit is a strong recommendation.

One word in passing in regard to the allusion made to the patent laws. The committee do not say that section 4900, a part of the patent laws, makes provisions for trade-marks. But they do say that under that section the patentee who puts the word "patented," with the day of the month and year, upon his inventions, with any other sign or device which he may adopt, is protected to some extent under that section.

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The committee, I believe, are unanimous in reporting this bill, with the single exception of my honorable friend from Georgia [Mr. Hammond]. As he has stated his objections to the House, I must address a few words to him in the hearing of the House upon his criticisms on the penal sections of the bill. The committee, with the single exception of the gentleman from Georgia, agree that the bill is right. He says he would not have the penal sections of the bill, because we are to give foreigners the benefits of those provisions where we do not give them to our own citizens. I ask his attention to the language of the first section, which provides that "owners of trade-marks, used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country" that is in treaty with us, may obtain registration, etc. Who are the two classes of persons to be benefited by this penal legislation? First, owners of trade-marks resident in the United States; secondly, owners resident in other countries bound to the United States by treaty. That is all I care to say upon that point. I think the gentleman will see at once that our citizens are in this respect placed upon an equality with citizens of foreign countries.

In the next place, my friend says that the punishment is too severe. Let me follow his reasoning. He instances the case of seduction on the high seas, the punishment for which is provided in section 5349 of the Revised Statutes. He says that the criminal, upon conviction for this offense, is punished by a fine of \$1,000 or by twelve months' imprisonment. But what says my friend from Georgia in the next sentence? Death, he says, would be too good for the scoundrel. "If we had him in Georgia," he says, "we would put him in the penitentiary for twenty years." What is the logic of that? That in section 5349 the penalty is not severe enough. The trouble is not that our proposed legislation in this bill is too severe. If the penalty in section 5349 is not severe enough for the case of seduction, I will join



him in making it severer. I think he will see the logic of his own remarks.

In the next place his criticism is, while imitations under the patent laws are punishable only by a penalty of \$100 (and that is the fact), yet we provide a severer penalty and more stringent measures hereafter to reach imitations. So we do.

But let us compare the two. Under the trade-mark law you have the civil right against the party who pirates or adopts your trade-mark. But there you are limited, except under the penal sections. Then you follow the person who counterfeits or who fraudulently uses your trade-mark. But go to the patent laws. You not only have the right to prosecute the man who infringes by manufacture, by imitation, but you can follow every individual user the country over. And you and I, Mr. Speaker, are liable to the suit of any patentee on the smallest article we may carry in the pocket, if we have it contrary to the rights of the patentee.

Therefore it is not necessary that the patentee should be protected by such stringent legislation in addition to what is now provided, and there is therefore abundant reason why the trade-mark provision should be supplemented by some penal statute.

And it is true that the provisions which are ingrafted in this bill as the penal sections bear a strong resemblance to the provisions punishing the countefeiting of money. And they should, from the very nature of things. The attempt of a party who seeks to pirate my trade-mark is in the direction of an imitation by counterfeiting. You punish somebody for counterfeiting the current money of the United States. Right. You also would punish a man under this provision who would counterfeit my property in the trade-mark. He ought to be punished. It is a form of theft. It is insidious, it is secret, it reaches out into the trade, and not only wrongs me, but is an imposition on other men who purchase the article relying on my commercial signature, otherwise called my trade-mark. Therefore there ought to be some stringent legislation.

My friend's objection, after all, is not sound when he says there should be no penal legislation attached to this bill; and he intimated he would move to strike it out. I beg his attention to this, that every State except three that has given us trade-mark laws has attached to those laws the penalty of imprisonment for their infraction; every one. Why, in Nebraska it is not exceeding twenty years, if I am right about it, and the other States range down. I believe in Kentucky and Indiana there is a money fine only. But if it is right to protect the trade-mark at all, then we should give the owners of trade-marks that protection which will be efficient. Every State which has legislated on it has found it necessary to have penal legislation for the enforcement of the law. Therefore, by abundance of reasoning and by experience, we should, if we have here a trade-mark law, make it efficient by the same class of penalty.

But my friend says, "You are multiplying offenses before the United States courts," and he regrets that prosecutions are multiplied. No man regrets more than I that the courts are troubled anywhere in this land, State or national, for the prosecution of anybody for violation of the law. But in the gentleman's State, as well as in my own, there will be found, I presume, for many years to come men who are not sufficiently mindful of the rights of their neighbors, men who will



take what does not belong to them; and it has always been the policy of the law to restrain them by the strong arm, if necessary. Therefore, if it is sound we should have this legislation, it is also only logical we should go forward and maintain it by sufficient provisions.

I submit to my friend, when he says the States have done right in their legislation, that the State legislation seems to be efficient and sufficient the country over. Mainly it is because that penal legislation has been sustained; and when he and I, therefore, find it necessary to supplement the State legislation by national acts we shall also go forward of course to make our Congressional legislation efficient as well.

I will not, of course, go into the punishment of these persons and where they are sent, or the presence of United States courts, or the frequency of the visits of the marshals. I want to say that I believe that when the whole people of this country become better acquainted with the United States courts and the evidences of their power and authority they will have a great deal more respect and reverence for them. I hope the time will come when everywhere in this country the power of the United States shall be just as highly respected and just as ardently and fondly cherished as the power of any citizen's own State. It is the State and the Union together; and I know my friend joins with me in that; he has none of that unpleasant distrust for the United States courts. Carry them, if you want, to every man's door so that he sees their salutary operation every day, and I think he will rise in the morning and go to sleep at night proud in the presence of the power of the nation. I would not, therefore, strike out these provisions of the bill, because they are necessary to give life and force and strength and success to it, and I would not strike them out again for any narrow reason that we may sometimes, if we should offend against this law, be called upon by the national power to respond for that disobedience.

I have nothing further to say in advocacy of the bill. With the exception specified, it meets the unanimous approval of the committee, and I trust it will have the support of the House. I now yield to the gentleman from New York [Mr. Lapham].

Mr. ARMFIELD. I hope the gentleman will yield to me a portion of his time.

Mr. ROBINSON. What length of time does the gentleman require?

Mr. ARMFIELD. Not more than five or ten minutes.

Mr. ROBINSON. I will yield to the gentleman from North Carolina after the gentleman from New York has concluded his remarks.

Mr. LAPHAM. Mr. Speaker, but for the importance of the measure now under consideration I should not feel disposed to occupy the attention of the House for any time. Prior to the act of 1870 three or four treaties had been made between the United States and foreign governments which contained provisions relating to the subject of trade-marks with a view to reciprocity of rights between the owners and users of such trade-marks residing abroad and those transacting business in this country. Now, the trade-mark law of 1870 may be properly said to have been the outgrowth of such treaties; the beginning of a system calculated to secure these great ends to the people of both countries. Subsequent treaties were also made upon the same subject. But the question came before the Supreme Court of the United States in a criminal case under the penal provisions of the law of 1870, where

the law is held to its strictest accountability, and that court was compelled to decide that it was an infraction of the Constitution, because it covered in terms the entire subject of the use of trade-marks as well between citizens of the same State as between citizens of the different States and between citizens of this country and citizens of other countries, and between citizens of this country and the Indian tribes.

Let me call attention to two passages in the opinion of the Supreme Court which are illustrative of their views on this subject. The court in one part of its opinion said:

The question, therefore, whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, when used or applied to the classes of commerce which fall within that control, is one which in the present case we propose to leave undecided.

So that it is fair to assume, if the law of 1870 had been confined to commerce between the States and between citizens and the Indian tribes and to foreign commerce, the court would have upheld the law as a valid exercise of the power of Congress under the Constitution. Such is the power expressly delegated by section 8 of that instrument. The committee, in this connection, for the purpose of relieving this bill of any doubt, have decided to leave out the subject of commerce between the States, because there is a present and pressing necessity, as I hope to show before I conclude, for the passage of some measure of this kind at the present time.

In another part of the opinion the court uses this language:

In what we have here said we wish to be understood as leaving the whole question of the treaty-making power of the General Government over trade-marks and the power of Congress to pass laws necessary to carry such treaties into effect untouched by this decision.

So, Mr. Speaker, we have the two subjects of the power of this House and the power of Congress under the clause of the Constitution giving Congress a right to regulate commerce between the States and with the Indian tribes and foreign commerce. We have, I say, that subject left entirely untouched by the decision of the Supreme Court. We have also left entirely untouched the power of Congress to pass laws for the purpose of carrying into effect any treaties which we may have made or may hereafter make upon this subject. The Constitution confides to the President and the Senate the treaty-making power, and when they have made a treaty it clothes Congress with the power to pass all needful legislation which may be deemed essential for the purpose of carrying that treaty into effect.

If it be a treaty relating to trade-marks, then Congress has the power to legislate to carry it into effect, and this legislation is entirely proper. Now, as I have said, the bill under consideration, and stripping it of all possible objection, confines itself entirely to foreign commerce and commerce with the Indian tribes.

There is perhaps, Mr. Speaker, no portion of the country so especially interested in this subject as the great commercial city of the State which I have the honor in part to represent. Gentlemen from that city appeared before us to represent their views with regard to the proposed law, and they gave us their opinions as to whether this bill was in accordance with the views expressed by the court in the opinion to which I have referred.

In view of the provisions of this bill and of the urgent necessity of having it enacted into a law, I send to the Clerk's desk and ask to have

read a communication received from one of those counsel, and a certificate from a committee of the classes of persons interested in the same subject. The House will see from this the importance of the subject and the necessity for prompt and speedy action.

The Clerk read as follows :

NEW YORK, *March 22, 1880.*

DEAR SIR: It has occurred to me that you may prefer to be furnished with some evidence of the feeling of the public in respect of the trade-mark bill. I therefore take the liberty of handing you a paper which speaks for a large class and which explains itself.

We accept, with thanks, what the committee proposes, but will hereafter give Congress a better view of facts which, we hope, may lead to different conclusions.

With respect and esteem, your obedient servant,

ROWLAND COX.

HON. ELBRIDGE G. LAPHAM, *Washington, D. C.*

The undersigned, a committee appointed by the United States Trade-Mark Association, of New York, to conduct the advocacy of its interests before Congress, respectfully represent that they earnestly desire that favorable action may be taken upon the measure reported by the Committee on the Judiciary limiting the registration of trade-marks to owners protected by treaties. They sign this paper to prevent the possibility of it being made to appear that said association is in any sense opposed to the speedy enactment of a measure demanded by every consideration of justice and good faith.

RENAULD, FRANÇOIS & Co.,  
CHAS. RENAULD.  
DIXON CRUCIBLE Co.,  
ORESTES CLEVELAND.  
GLEN COVE STARCH WORKS,  
WRIGHT DURYEA.  
COLGATE & Co.,  
BOWLES COLGATE.  
GOODWIN & Co.,  
CHARLES G. EMERY.  
SAML. E. HISCOX.

MR. LAPHAM. It will be seen from this communication, as well as from the letter of the Secretary of State, which my colleague upon the committee [Mr. Robinson] has had read, and from the letter of the Commissioner of Patents, which the gentleman from Iowa [Mr. McCoid] caused to be read, that there is an urgent necessity at this time for having enacted into the form of law a provision which will guard our rights under the treaties which are now existing. Frauds upon trade-marks, which have been multiplied under the act of 1870, are almost as numerous, Mr. Speaker, as the trade-marks themselves. I have been furnished with a chart carried by one of the traveling agents of these pirates upon the rights of the owners of trade-marks of persons who have filed their applications and secured their rights to trade-marks between this country and Great Britain and the continent of Europe, which I exhibit [holding up the chart] for the purpose of illustrating the extent to which this system is carried on. You here see the devices which a traveling agent for the pirates carries with him, being almost exact imitations of the actual trade-marks registered under the law, with which he goes from man to man and from country to country, and imposes upon honest and unsuspecting purchasers a fraudulent article instead of the genuine article. This shows the necessity of the penal provisions of the bill in question. The imitations are about fifty in number, covering many of the leading manufactures used in commerce.



Thrice is he arm'd that hath his quarrel just.

But the men who carry on this nefarious traffic are more than thrice armed, as you will see from the specimens the agent carries along with him.

I do not deem it necessary, Mr. Speaker, to dwell at greater length upon the necessity at this time of legislating upon this subject, and of passing the law which has met the approval of the Committee on the Judiciary, and which meets the approval of the counsel who are interested in this question. I can not close, however, without saying a word or two upon another subject with reference to which my friend from Iowa [Mr. McCoid] is so deeply interested. While I concur in this legislation, and believe it ought to be adopted as a remedy for present evils, I am yet of the opinion that a law to be ample should not only secure the rights of persons engaged in foreign commerce and with the Indian tribes, but should secure the rights of people engaged in commerce among the different States, and should be carried to the extent of embracing the whole subject of trade-marks, State and national.

What is a trade-mark? The analogy between it and a patent is very strong indeed. It is the original discoverer who secured a patent right and only the original discoverer. It is the original finder of an article which a man can physically appropriate to his own use which gives him a right of property. If a man digs a nugget of gold out of the bowels of the earth, or with a bar or pick cleaves it out of the crevices of the rock, he has the physical power to appropriate it at once to his use and it becomes his property. If it happen to have been a nugget lost by some one who had been a prior owner his discovery gives him no right of property. So in the domain of patents; if a man invents, although he may be an original inventor as to himself, an article which had been previously used by someone else he acquires no right of property. It is only when he is not only the original but the first inventor that he can exercise and have the right. The same rule applies to trade-marks.

Let me illustrate, Mr. Speaker, by two instances which occur to me.

I remember a case arising in my own State, where an action was brought to restrain the owners of the Empire Spring, at Saratoga, from using upon their bottles the label "Congress Empire Spring." The proprietors of the Congress Spring filed the bill to restrain the use of that label upon the ground that it was a trade-mark to which they were entitled. The counsel for the defense, the Empire Spring, argued "You might as well go up on the mountain tops and bottle and label the air and claim an exclusive right to it as to claim the exclusive right to bottle and label the water as it bubbles from the perpetual springs in obedience to a law imposed upon matter by the hand of the Creator." But the court of last resort in my State said, "that by this use of the term or label 'Congress Spring,' which has been employed by the proprietors of that spring until the virtues of the water are known all over the civilized world, they have acquired a right which can not be invaded, and the insertion of the word 'Empire' between 'Congress' and 'Spring' is a mere device and does not excuse the person so using it from the consequences." And they held that the action was well brought.

Take a case in reference to inventions. The late Ross Winans, of Baltimore, was without doubt an original inventor of the idea of the

eight-wheel car to be used upon railroads, one of the most beneficial inventions in the whole history of railroads in this and in other countries. It enables a long car to be run with speed and safety upon down grades and short and reverse curves. So far as he was concerned the idea was his own, and yet when he came into court to try his title he was beaten. And how beaten? In building the Boston court-house, many years before his invention, the contractors had brought down from the Quincy quarries upon a tramroad with short curves and steep grades, on four-wheel cars or trucks, the blocks of granite that went into the main walls of the building. When the contractor desired to transport the long columns which were to be placed in the front of the court-house he was put to his "trumps"—to use a familiar expression—to know what he should do. He did not know how to obviate the difficulty and danger. A common laborer stepped out of the ranks and said, "I will tell you how to do that (it was the idea of the old-fashioned lumber wagon with a long reach put into it, to carry logs to the sawmill); take two of these trucks and put them as far apart as the length of your column, and put a bar or reach between them, and you will get along without any trouble and run around the curves and on the down grade with safety." The contractor did so, and the courts held that, although that was all the use ever made of it, it was a complete answer to the claim of Mr. Winans for his invention, and he was defeated in his action.

Therefore between this subject of patents and the subject of trade-marks there is a close analogy. The same reason which would induce me to have patents subject to national regulation would induce me to have trade-marks subject to national legislation and copyrights subject to national legislation also. I am in favor of and believe that there will ultimately be found to be a necessity for a constitutional amendment upon this subject, giving to Congress the unquestioned power and entire control over the whole subject of trade-marks. The conflicting legislation of thirty-eight States will not be ample for protection at home and can not give it abroad. But for the present, because it takes time to secure the adoption of a constitutional amendment, to protect us for the present under our treaties and to save our reputation with the nations with whom we are in treaty, I am in favor of passing this bill, which is not obnoxious to any objection, and waiting until the future to secure the better remedy which a constitutional provision will furnish us.

I now return to the gentleman from Massachusetts [Mr. Robinson] the remainder of the time which he so kindly yielded to me.

MR. ARMFIELD. I do not desire to protract the discussion or postpone the vote on this bill; but as the bill under discussion bears the name of the Armfield bill I desire to say a word or two in regard to it.

First of all, I desire to disclaim all responsibility for the bill in its present shape. It has been so altered by the committee that has had it in charge, both by leaving out what I put in and by putting in what I did not have in it and do not approve, that I must disclaim all responsibility for the paternity of the present bill.

My principal object in framing the bill which I introduced was to afford protection to the trade-marks that are used in interstate commerce. I regard the protection of trade-marks used in foreign commerce as merely an incident of my main design.



I had then, and I beg leave to say that I have now, very little doubt of the constitutional power of Congress to legislate upon trade-marks used in the commerce between the States. The Committee on the Judiciary tell us in their report that we have no power under the Constitution to legislate in regard to trade-marks, except under the treaty-making power given by the Constitution. They say in their report that while they think Congress can not so legislate with regard to trade-marks under the power to regulate commerce with foreign nations and among the several States and with the Indian tribes, yet they think that trade-marks used in the commerce with foreign nations and with the Indian tribes can be protected under the treaty-making power.

Now, if this be so, if it be a fact that Congress has no power to legislate upon the subject of trade-marks except under the treaty-making power, then it is perfectly clear that the bill now under discussion and reported from that committee is itself unconstitutional, because it has no reference whatever to the treaty-making power.

The very first clause of the bill, stating what trade-marks may be registered, says "that owners of trade-marks used in commerce with foreign nations or with the Indian tribes" may register their trade-marks. There is no limitation upon the kind of trade-marks that may be registered except that it shall be a trade-mark used in commerce with foreign nations or with the Indian tribes.

There is a limitation as to the residence of the person who may register a trade-mark. The bill says, "provided such owners (of trade-marks) shall be domiciled in the United States, or located in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States." That is not a restriction upon the kind of trade-mark to be protected. Any trade-mark used in foreign commerce or in commerce with the Indian tribes may be registered and shall be protected, provided the person applying for the registration and protection is domiciled in the United States or in a country that has a treaty with the United States or has a law protecting the trade-marks of citizens of the United States. Therefore, upon the committee's own showing, upon the ground which they themselves take, their bill is unconstitutional. But as I disagree with the committee in the conclusion to which they have arrived, there is no reason in all this why I should vote against their bill.

I believe that Congress has the power to legislate for the protection of trade-marks. I understand the gentleman from New York [Mr. Lapham] to differ from the report of the committee in this: He does not agree with the committee that the only power of legislating over trade-marks arises under the treaty-making clause of the Constitution. He believes with me, and not with the committee in their report, that Congress has this power under that clause of the Constitution which allows Congress to regulate commerce with foreign nations, with the Indian tribes, and between the States. He believes that under that clause we have the power to legislate upon the subject of trade-marks. But he says that, in order to remove all objections to the constitutionality of this bill, the committee have seen fit to leave out that part of my bill which protected trade-marks used in commerce between the States.

Now, Mr. Speaker, I am utterly at a loss to see how this can remove any objection to the constitutionality of the bill. The clause of the Constitution which gives Congress power to legislate in regard to



commerce between the States is the very same clause that gives it power to legislate in regard to commerce with foreign nations and with the Indian tribes. The eighth section of article 1 of the Constitution provides that Congress shall have power—

To regulate commerce with foreign nations, and among the several States, and with the Indian tribes.

These different branches of commerce are all included within the same clause. If it be constitutional for Congress to legislate in regard to trade-marks used in commerce with foreign nations and with the Indian tribes it is equally constitutional for Congress to legislate in reference to trade-marks used in interstate commerce.

Mr. LAPHAM. The gentleman will allow me to say that the difference is this: There can be no treaties made between the States or between a State and a foreign country.

Mr. ARMFIELD. That point might be good if the gentleman rested the authority upon the treaty-making power, which I understood him not to do.

I regard it as of more importance to protect the trade-marks used in interstate commerce than to protect those used in foreign commerce. Our first duty is to our own citizens. In any laws of this kind passed to prevent persons from being imposed upon by counterfeiting articles of food, medicine, or anything else, should we not first protect our own people and make the protection of foreigners a secondary consideration?

The trade-marks used in commerce between the States are much more valuable and numerous than gentlemen seem to suppose. These trade-marks are new things, which have sprung up within the last few years. They were almost totally unknown to the courts of this country and of Europe until the last decade. As illustrating the value of trade-marks, I may mention that there is one trade-mark used in my own State upon smoking tobacco which the owners claim is worth—the property in the trade-mark itself—\$100,000.

But Mr. Chairman, although the committee have seen fit to strike out the clause relating to articles used in commerce between the States, I am willing to support the bill. It still contains some good features. It protects commerce with foreign nations, and enables us to perform our treaty obligations. For this reason I am willing to support it, provided the severe penalties embraced in it be struck out. The bill which I had the honor to introduce embraced no penal clauses. It did not make the violation of the law a criminal offense. I thought, and still think, that the civil remedies which the courts now give, and would give under this bill if these penal clauses were struck out, would be sufficient to protect the title to trade-marks. I am opposed upon principle to piling up penalties in the legislation of the country. I do not think it necessary, in order to protect trade-marks, that a man who violates the trade-mark law should be subjected to imprisonment for two years and a fine of \$1,000. Nor do I think it necessary, in order to protect trade marks, that we should allow a man to swear out a search warrant, enter the house of any citizen, and, if he finds in his possession counterfeited labels, to drag him before a court, indict him, and punish him criminally, if he can be convicted of having these counterfeited labels in his possession with intent to defraud. The question of intent would be for the jury to determine upon any evidence satisfactory to their minds; and the mere fact that a man had in

his possession counterfeited labels might be deemed sufficient to make him liable to imprisonment in the penitentiary for two years and a fine of \$1,000.

I shall, therefore, cordially support the motion of the gentleman from Georgia [Mr. Hammond] to strike out these penal clauses. If that motion should prevail I shall cheerfully vote for the bill, because, although it does not go half so far as I think it ought to go, although it does not do all the good I desire to see done, yet I would take what I can get now and wait for further legislation in the future.

MR. HAMMOND, of Georgia. There are two or three formal amendments which I desire to offer on behalf of the committee, and also two amendments that I submit on my own behalf—one striking out section 20, the section authorizing searches; and the other striking out all the sections after section 13, being the penal parts of the bill.

The remarks which have been made fully explain all these amendments. I send them now to the Clerk's desk, and if there be no objection I desire they shall all be considered as pending, and I call for the previous question on the amendments and the bill.

The Clerk read as follows:

In section 1, insert, after the word "country," the words "or tribes."

In section 6, line 3, strike out the words "by them."

In section 16, lines 3 and 4; in section 17, lines 10 and 11; in section 18, lines 7 and 8; and in section 19, lines 8 and 9, strike out the words "the statutes of the United States" and insert "this act."

Amend by striking out section 20; and

Amend by striking out all of the bill after section 13, being the penal parts of the bill.

MR. ROBINSON. It is understood the first amendments read are by the whole committee, and the other motions to strike out are individual motions of the gentleman from Georgia.

MR. HAMMOND, of Georgia. I so stated.

\* \* \* \* \*

The clerk read the first amendment, as follows:

Amend section 1 by adding, after the sixth line, the words "or tribes;" so it will read "or located in any foreign country or tribes."

The amendment was agreed to.

The SPEAKER pro tempore. If there be no objection, the second and third amendments which come from the committee will be considered as agreed to.

There was no objection, and it was ordered accordingly.

The SPEAKER pro tempore. The amendments moved by the gentleman from Georgia [Mr. Hammond] will now be read.

The Clerk read as follows:

Strike out section 20, as follows:

SEC. 20. That if the owner of any trade-mark, registered pursuant to the statutes of the United States, or his agent, make oath in writing that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, or molds, of his said registered trade-mark are in the possession of any person, with intent to use the same for the purpose of deception and fraud, or makes such oaths that any counterfeits or colorable imitations of his said trade-mark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed the said registered trade-mark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person, with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States and the commissioners

of the circuit courts may, within their respective jurisdictions, proceed under the law relating to search warrants, and may issue a search warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, and said counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, and said empty boxes, envelopes, wrappers, cases, bottles, or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purposes of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, molds, counterfeit trade-marks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

\* \* \* \* \*

The bill was passed.

[Senate, second session, April 29, 1880, Cong. Record, vol. 10, part 3, p. 2860.]

#### HOUSE BILLS REFERRED.

The bill (H. R. 5088) to authorize the registration of trademarks and protect the same, was read twice by its title, and, on motion of Mr. Conkling, referred to the Committee on the Judiciary.

[Senate, third session, February 28, 1881, Cong. Record, vol. 11, part 3, p. 2195.]

#### REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Conkling, from the committee to whom was referred the bill (H. R. 5088) to authorize the registration of trademarks and protect the same, reported it without amendment.

[Senate, third session, March 1, 1881, Cong. Record, vol. 11, part 3, p. 2284.]

#### REGISTRATION OF TRADEMARKS.

The bill (H. R. 5088) to authorize the registration of trademarks and protect the same was considered as in Committee of the Whole.

The bill was reported to the Senate, ordered to a third reading, read the third time, and passed.

[House of Representatives, third session, March 1, 1881, Cong. Record, vol. 11, part 3, p. 2336.]

#### ENROLLED BILLS SIGNED.

\* \* \* \* \*

Mr. Upson, from the Committee on Enrolled Bills, reported that the committee had examined and found truly enrolled bill \* \* \* of the following title; when the Speaker signed the same.

A bill (H. R. 5088) to authorize the registration of trademarks and protect the same.

[Senate, third session, March 2, 1881, Cong. Record, vol. 11, part 3, p. 2370.]

#### MESSAGE FROM THE HOUSE.

A message from the House of Representatives, by Mr. George M. Adams, its Clerk, announced \* \* \* that the Speaker of the House



had signed the following enrolled bills \* \* \* and they were thereupon signed by the Vice-President.

\* \* \* \* \*

A bill (H. R. 5088) to authorize the registration of trademarks and protect the same.

[House of Representatives, third session, March 3, 1881, Cong. Record, vol. 11, part 3, p. 2467.]

# APPROVAL OF BILLS, ETC.

A message from the President, by Mr. Pruden, his secretary, informed the House that the President had approved and signed bills \* \* \* of the following titles:

An act (H. R. 5088) to authorize registration of trademarks and protect the same.

The act is as follows:

[21 U. S. Stat. L., 502, Ch. 133, approved March 3, 1881.]

AN ACT to authorize the registration of trade-marks and protect the same.

*Be it enacted by the Senate and House of Representatives of the United States in Congress assembled,* That the owners of trade-marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribes, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements:

First. By causing to be recorded in the Patent Office a statement specifying name, domicile, location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated; a description of the trade-mark itself, with facsimiles thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used.

Second. By paying into the Treasury of the United States the sum of twenty-five dollars, and complying with such regulations as may be prescribed by the Commissioner of Patents.

Sec. 2. That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated; and that the description and facsimiles presented for registry truly represent the trade-mark sought to be registered.

Sec. 3. That the time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another, and appropriate to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade-mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases.

Sec. 4. That certificates of registry of trade-marks shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trade-marks and of statements and declarations filed therewith, and certificates of registry so signed and sealed, shall be evidence in any suit in which such trade-marks shall be brought into controversy.

SEC. 5. That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trade-mark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of the term of thirty years such registration may be renewed on the same terms and for a like period.

SEC. 6. That applicants for registration under this act shall be credited for any fee or part of a fee heretofore paid into the Treasury of the United States with intent to procure protection for the same trade-mark.

SEC. 7. That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

SEC. 8. That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in any unlawful business or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.

SEC. 9. That any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark, or an entry respecting a trade-mark, in the office of the Commissioner of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered in an action on the case.

SEC. 10. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

SEC. 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

SEC. 12. That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his office.

SEC. 13. That citizens and residents of this country wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.

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S. 1751.—A bill to provide for the publication and registration of the title and claims to the property called trade-marks. Introduced by Hon. William W. Eaton, of Connecticut, May 12, 1880. Referred to the Committee on the Judiciary. Indefinitely postponed.

[Senate, second session, May 12, 1880, Cong. Record, vol 10, part 4, p. 3265.]

#### BILLS INTRODUCED.

Mr. EATON. I desire to introduce a bill drawn by a very valued and intelligent constituent of mine, and I should like to have it referred to the Committee on the Judiciary. It is for the publication and registration of trademarks, a subject which I understand that committee have now in hand.

By unanimous consent, leave was granted to introduce a bill (S. 1751)

to provide for the publication and registration of the title and claims to the property called trademarks; which was read twice by its title, and referred to the Committee on the Judiciary.

[Senate, third session, February 28, 1881, Cong. Record, vol. 11, part 3, p. 2195.]

REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Conkling, from the Committee on the Judiciary, \* \* \* to whom was referred the bill (S. 1751) to provide for the publication and registration of the title and claims to the property called trademarks, moved its indefinite postponement; which was agreed to.

H. R. 6505.—A bill to provide for refunding of fees in all cases of void registration of trade marks. Introduced by Hon. Samuel S. Cox, of New York, December 6, 1880. Referred to the Committee on the Judiciary. Not reported.

[House of Representatives, third session, December 6, 1880, Cong. Record, vol. 11, part 1, p. 11.]

VOID REGISTRATION OF TRADEMARKS.

Mr. Cox also introduced a bill (H. R. 6505) to provide for refunding of fees in all cases of void registration of trademarks; which was read a first and second time, referred to the Committee on the Judiciary, and ordered to be printed.

H. Res.—A resolution requesting the Secretary of the Interior to inform the House under what authority the registration of trade marks is permitted. Introduced by Hon. N. J. Hammond, of Georgia, December 20, 1880. Referred to the Committee on the Judiciary. Reported and adopted.

[House of Representatives, third session, December 20, 1880, Cong. Record, vol. 11, part 1, p. 270.]

REGISTRATION OF TRADEMARKS.

Mr. Hammond, of Georgia, submitted the following resolution; which was referred to the Committee on the Judiciary:

*Resolved*, That the Secretary of the Interior be, and is hereby, requested to inform this House under and by what authority the registration of trade marks is permitted, and fees for such registration are charged and collected, since the Supreme Court of the United States, at its October term, 1879, in the case of *Emil Steffins et al., v. The United States*, decided that the enactments of Congress authorizing such registration and collection of fees are void because unconstitutional.

[House of Representatives, third session, January 18, 1881, Cong. Record, vol. 11, part 1, p. 725.]

REGISTRATION OF TRADEMARKS.

Mr. HAMMOND, of Georgia. The Committee on the Judiciary have directed me to report back a resolution of inquiry with the recommendation that it be adopted.

The SPEAKER. It cannot be acted on during this call. The Chair will allow it to be reported now, and action can be taken on it under the rules immediately after the call of committees for reports has been concluded. The resolution will be read now.

The Clerk read as follows:

[The resolution is read as above.]

Mr. CALKINS. Is that resolution recommended by the Committee on the Judiciary for adoption?

The SPEAKER. It is; but it can not be acted on now. As soon as all of the committees shall have been called, the Chair will recognize the gentleman from Georgia to call up the resolution for action. The call of committees can not be interrupted.



[House of Representatives, third session, January 18, 1881, Cong. Record, vol. 11, part 1, p. 727.]

#### REGISTRATION OF TRADEMARKS.

The SPEAKER. The gentleman from Georgia [Mr. Hammond] is now recognized to call up the resolution of inquiry from the Secretary of the Interior.

Mr. ATKINS. Will it give rise to much debate?

Mr. HAMMOND, of Georgia. It will not. I send to the desk the resolution which the Committee on the Judiciary have directed me to report back with a favorable recommendation.

The Clerk read as follows:

[The resolution is read as above.]

Mr. KEIFER. I think the form of that resolution had better be changed; that it should be modified so as simply to make the inquiry, without giving any reason therefor. As it now reads it conveys a sort of reflection on the Secretary of the Interior, which I think should not be put in our resolution.

Mr. HAMMOND, of Georgia. That is immaterial to me. It is simply giving the reason why we make the inquiry.

Mr. KEIFER. The reason had better not go into the resolution, for it would seem to indicate that the Secretary of the Interior has been and is doing something wrong.

Mr. HAMMOND, of Georgia. Will the gentleman move some amendment?

Mr. KEIFER. I make the suggestion to the gentleman who wants the information to strike out all that part of the resolution which refers to the decision of the Supreme Court.

Mr. HAMMOND, of Georgia. I have no objection, so that we get the information.

Mr. KEIFER. My motion would be to strike out all that relates to the case decided by the Supreme Court, and simply to call for information on the subject of registration of trademarks.

Mr. HAMMOND, of Georgia. I have no objection to that, and I presume the committee will have none.

The SPEAKER. The gentleman can not accept the amendment, but the Chair will submit it to the House.

The question was taken upon the amendment proposed by Mr. Keifer; and it was agreed to.

The resolution, as amended, was then adopted.

[House of Representatives, third session, February 12, 1881, Cong. Record, vol. 11, part 2, p. 1521.]

#### REGISTRATION OF TRADEMARKS.

The Speaker also laid before the House a letter from the Secretary of the Interior, transmitting a report of the Commissioner of Patents relative to the registration of trademarks; which was referred to the Committee on Patents, and ordered to be printed.

#### FORTY-SEVENTH CONGRESS.

Five bills and one resolution were introduced in the House of Representatives in this Congress, and two bills and one resolution in the Senate.

S. 155.—A bill to provide for refunding of fees in all cases of void registration of trade marks. Introduced by Hon. James Donald Cameron, of Pennsylvania, December 6, 1881. Referred to the Committee on Patents. Reported adversely. Recommended.

[Senate, first session, December 6, 1881, Cong. Record, vol. 13, part 1, p. 21.]

BILLS INTRODUCED.

Mr. Cameron, of Pennsylvania (by request,) asked and, by unanimous consent, obtained leave to introduce a bill (S. 155) to provide for refunding of fees in all cases of void registration of trademarks; which was read twice by its title, and ordered to lie on the table, to be referred to the Committee on Patents when appointed.

[Senate, first session, March 2, 1882, Cong. Record, vol. 13, part 2, p. 1549.]

REPORTS OF COMMITTEES.

Mr. PLATT. I am instructed by the same committee [Patents] to report adversely the bill (S. 155) to provide for refunding of fees in all cases of void registration of trademarks. Perhaps some Senator interested in the bill would desire to have it go upon the Calendar; otherwise I ask for its indefinite postponement.

Mr. GARLAND. Is there a written report accompanying the bill?

Mr. PLATT. There is no written report.

Mr. GARLAND. Let it go upon the Calendar, then.

The PRESIDENT *pro tempore*. The bill will be placed upon the Calendar, with the adverse report of the committee.

[Senate, first session, April 13, 1882, Cong. Record, vol. 13, part 3, p. 2845.]

FEES IN TRADEMARK CASES.

The PRESIDENT *pro tempore*. The next case is reported adversely from the Committee on Patents. Does the Senator from Connecticut [Mr. Platt] wish that considered? It is the bill (S. 155) to provide for the refunding of fees in all cases of void registration of trademarks.

Mr. TELLER. Let that go over.

The PRESIDENT *pro tempore*. It is objected to, and will be passed over.

Mr. COCKRELL. Why not have it indefinitely postponed?

Mr. WILLIAMS. I think it had just as well be indefinitely postponed. It was unanimously rejected by the committee.

Mr. PLATT. I think so.

The PRESIDENT *pro tempore*. The bill will be indefinitely postponed if there be no objection. The Chair hears none and it is so ordered.

[Senate, first session, April 14, 1882, Cong. Record, vol. 13, part 3, p. 2878.]

FEES IN TRADEMARK CASES.

Mr. GARLAND. Yesterday the bill (S. 155) to provide for the refunding of fees in all cases of void registration of trademarks was postponed indefinitely. It was my intention to move to recommit that bill. The chairman of the Committee on Patents, the Senator from Connecticut [Mr. Platt], has no objection to its being recommitted. I now make the motion to reconsider the vote by which the bill was indefinitely postponed.

The motion was agreed to.

Mr. GARLAND. Now I move to recommit the bill to the Committee on Patents.

The motion was agreed to.

H. Res. 9.—A joint resolution proposing an amendment to the Constitution of the United States, to give Congress power to regulate trade marks. Introduced by Hon. Moses A. McCoid, of Iowa, December 13, 1881. Referred to the Committee on the Judiciary. Not reported.

[House of Representatives, first session, December 13, 1881, Cong. Record, vol. 13, part 1, p. 99.]

#### AMENDMENT TO CONSTITUTION.

Mr. McCoid also introduced a joint resolution (H. R. 9) proposing an amendment to the Constitution of the United States; which was read a first and second time, referred to the Committee on the Judiciary, and ordered to be printed.

H. R. 1200.—A bill to amend an act entitled "An act to authorize the registration of trademarks and to protect the same," approved March 3, 1881. Introduced by Hon. R. F. Armfield, of North Carolina. Referred to the Committee on the Judiciary. Not reported.

[House of Representatives, first session, December 16, 1881, Cong. Record, vol. 13, part 1, p. 169.]

#### TRADEMARKS.

Mr. Armfield also introduced a bill (H. R. 1200) to amend an act entitled "An act to authorize the registration of trademarks and to protect the same," approved March 3, 1881; which was read a first and second time, referred to the Committee on the Judiciary, and ordered to be printed.

S. Res.—A resolution concerning the refunding of fees in cases of void registration of trademarks. Introduced by Hon. Augustus H. Garland, of Arkansas, January 5, 1882. Adopted. Referred to the Committee on Patents.

[Senate, first session, January 5, 1882, Cong. Record, vol. 13, part 1, p. 247.]

#### TRADEMARK FEES.

Mr. GARLAND. I offer the following resolution and ask for its present consideration:

*Resolved*, That the Committee on Finance be instructed to inquire into the propriety of refunding to parties who paid for the protection, under the trade mark legislation, the fee required by the act of Congress touching that subject, which was decided by the Supreme Court of the United States, in the Trade-Mark Cases, (100 U. S., 82), to be unconstitutional, and report by bill or otherwise.

The Senate, by unanimous consent, proceeded to consider the resolution.

Mr. GARLAND. I may briefly state that under the trademark law, as it existed before the Supreme Court passed upon its constitutionality, each applicant for this protection had to pay a fee of \$25. The fee was paid in a great many instances. The matter was brought to the Supreme Court, and, as will be found in the one hundredth volume of reports, the court determined the act to be unconstitutional. These persons now, at least many of them, insist that they should be returned this fee of \$25. While I believe that it should be returned, I am not prepared, without further investigation, to say absolutely that it should be; but I think it is a fit subject of inquiry for the Finance Committee, and I simply offer the resolution so that the committee may be instructed to inquire into the propriety of it.

The resolution was agreed to.

[Senate, first session, January 10, 1882, Cong. Record, vol. 13, part 1, p. 303.]

#### REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. MORRILL. I am instructed also by the Committee on Finance to report back a resolution introduced January 5, 1882, in relation to



trademark fees, to ask to be discharged from its further consideration, and that it be referred to the Committee on Patents.

The same subject was reported back by the Committee on Finance and referred to the Committee on Patents at the last session of Congress, with other papers.

The report was agreed to.

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H. R. 4557.—A bill to provide for refunding of fees in all cases of void registration of trademarks. Introduced by Hon. Anson G. McCook, of New York, February 20, 1882. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, February 20, 1882, Cong. Record, vol. 13, part 2, p. 1302.]

#### TRADEMARKS.

Mr. McCook (by request) also introduced a bill (H. R. 4557) to provide for refunding of fees in all cases of void registration of trademarks; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

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S. 1440.—A bill relating to the registration of trademarks. Introduced by Hon. Orville H. Platt, of Connecticut, March 10, 1882. Referred to the Committee on Patents. Passed in Senate and House. Approved by the President, August 4, 1882. (22 U. S. Stat. L., p. 298, chap. 393.)

[Senate, first session, March 10, 1882, Cong. Record, vol. 13, part 2, p. 1778.]

#### BILLS INTRODUCED.

He [Mr. Platt] also asked, and, by unanimous consent, obtained leave to introduce a bill (S. 1440) relating to the registration of trademarks; which was read twice by its title, and, with the accompanying papers, referred to the Committee on Patents.

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[Senate, first session, March 23, 1882, Cong. Record, vol. 13, part 3, p. 2190.]

#### REPORTS OF COMMITTEES.

\* \* \* Mr. Platt, from the Committee on Patents, to whom was referred the bill (S. 1440) relating to the registration of trademarks, reported it without amendment.

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[Senate, first session, May 12, 1882, Cong. Record, vol. 13, part 4, p. 3862.]

#### REGISTRATION OF TRADEMARKS.

The bill (S. 1440) relating to the registration of trademarks was considered as in Committee of the Whole.

Mr. PLATT. The bill was reported by the Committee on Patents. I propose an amendment to make it clear that it applies to nothing except what is now contemplated by the act relating to the registration of trademarks. I propose to amend by inserting after the word "used," at the end of line 6, the words, "by the applicant in foreign commerce or commerce with Indian tribes;" so as to make the bill read:

That nothing contained in the law entitled "An act to authorize the registration of trade marks and protect the same," approved March 3, 1881, shall prevent the registry of any lawful trade mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.

The amendment was agreed to.

The bill was reported to the Senate as amended, and the amendment was concurred in.

The bill was ordered to be engrossed for a third reading, read the third time, and passed.

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[House of Representatives, first session, August 3, 1882, Cong. Record, vol. 13, part 7, p. 6850.]

#### REGISTRATION OF TRADEMARKS.

Mr. BUCK. I ask unanimous consent to take from the Speaker's table for present consideration the bill (S. 1440) relating to the registration of trademarks. The reading of the bill will show what it is, and I think there can be no objection to it whatever.

The bill was read as follows:

*Be it enacted, etc.,* That nothing contained in the law entitled "An act to authorize the registration of trademarks and protect the same," approved March 3, 1881, shall prevent the registry of any lawful trademark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.

Mr. VANCE. The Committee on Patents has considered that bill and it has the unanimous sanction of the committee. It is considered right and proper that it should pass.

Mr. BUCK. I will not give an explanation unless some gentleman desires it.

There being no objection, the bill was taken from the Speaker's table, read three times, and passed.

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[Senate, first session, August 5, 1882, Cong. Record, vol. 13, part 7, p. 6921.]

#### MESSAGE FROM THE HOUSE.

A message from the House of Representatives, by Mr. McPherson, its Clerk, announced \* \* \* that the Speaker of the House had signed the following enrolled bills; and they were thereupon signed by the President *pro tempore*:

\* \* \* \* \*

A bill (S. 1440) relating to the registration of trademarks.

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[House of Representatives, first session, August 5, 1882, Cong. Record, vol. 13, part 7, p. 6960.]

#### ENROLLED BILLS SIGNED.

Mr. Pierce, from the Committee on Enrolled Bills, reported that they had examined and found truly enrolled bills of the following titles; when the Speaker signed the same:

\* \* \* \* \*

A bill (S. 1440) relating to the registration of trademarks.

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[Senate, first session, August 7, 1882, Cong. Record, vol. 13, part 7, p. 6998.]

#### PRESIDENTIAL APPROVALS.

A message from the President of the United States, by Mr. O. L. Pruden, one of his secretaries, announced that the President had, on the 4th instant, approved and signed the following bills:

\* \* \* \* \*

An act (S. 1440) relating to the registration of trademarks.  
The act is as follows:

[22 U. S. Stat., p. 298, chap. 393. Approved August 4, 1882.]

AN ACT relating to the registration of trade-marks.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That nothing contained in the law entitled "An act to authorize the registration of trade-marks and protect the same," approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trade-mark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.

H. R. 5056.—A bill amending "An act to amend the law relating to patents, trademarks and copyrights." Introduced by Hon. John R. Buck, of Connecticut, March 13, 1882. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, March 13, 1882, Cong. Record, vol. 13, part 2, p. 1838.]

#### PATENTS, TRADEMARKS, ETC.

Mr. Buck introduced a bill (H. R. 5056) amending an act to amend the law relating to patents, trademarks, and copyrights; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

H. R. 5057.—A bill amending an act entitled "An act to authorize the registration of trademarks and protect the same." Introduced by Hon. John R. Buck, of Connecticut, March 13, 1882. Referred to the Committee on Patents. H. R. No. 6688 reported as a substitute.

[House of Representatives, first session, March 13, 1882, Cong. Record, vol. 13, part 2, p. 1838.]

#### PATENTS, TRADEMARKS, ETC.

\* \* \* \* \*

Mr. Buck also introduced a bill (H. R. 5057) amending an act entitled "An act to authorize the registration of trademarks and protect the same;" which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

H. R. 6688.—A bill relating to the registration of trade marks. Introduced by Hon. James M. Ritchie, of Ohio, July 1, 1882. Referred to the House Calendar.

[House of Representatives, first session, July 1, 1882, Cong. Record, vol. 13, part 6, p. 5553.]

#### REGISTRATION OF TRADEMARKS.

Mr. Ritchie, from the Committee on Patents, reported as a substitute for House bill No. 5057, a bill (H. R. 6688) relating to the registration of trademarks; which was read a first and second time, referred to the House Calendar, and, with the accompanying report, ordered to be printed.

#### FORTY-EIGHTH CONGRESS.

One bill was introduced in the House of Representatives in this Congress and one in the Senate.

H. R. 4553.—A bill to amend the law in relation to the registration of trade marks. Introduced by Hon. Halbert S. Greenleaf, of New York, February 4, 1882. Referred to the Committee on Patents. Reported. Referred to House Calendar.



[House of Representatives, first session, February 4, 1884, Cong. Record, vol. 15, part 1, p. 862.]

#### REGISTRATION OF TRADEMARKS.

Mr. Greenleaf introduced a bill (H. R. 4553) to amend the law in relation to the registration of trademarks; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

[House of Representatives, second session, January 24, 1885, Cong. Record, vol. 16, part 2, p. 987.]

#### REGISTRATION OF TRADEMARKS.

Mr. Vance, from the Committee on Patents, reported back favorably a bill (H. R. 4553) to amend the law in relation to the registration of trademarks; which was referred to the House Calendar, and the accompanying report ordered to be printed.

S. 2513.—A bill to amend the law in relation to the registration of trade marks. Introduced by Hon. Austin F. Pike, of New Hampshire, January 8, 1885. Referred to the Committee on Patents. Not reported.

[Senate, second session, January 8, 1885, Cong. Record, vol. 16, part 1, p. 541.]

#### BILLS INTRODUCED.

\* \* \* \* \*

He [Mr. Pike] also introduced a bill (S. 2513) to amend the law in relation to the registration of trademarks; which was read twice by its title, and referred to the Committee on Patents.

#### FORTY-NINTH CONGRESS.

Two bills were introduced in the Senate in this Congress.

S. 1034.—A bill to amend the law relating to patents, trade marks, and copyrights. Introduced by Hon. Orville H. Platt, of Connecticut, January 12, 1886. Referred to the Committee on Patents. Indefinitely postponed.

[Senate, first session, January 12, 1886, Cong. Record, vol. 17, part 1, p. 604.]

#### BILLS INTRODUCED.

\* \* \* \* \*

Mr. Platt introduced a bill (S. 1034) to amend the law relating to patents, trademarks, and copyrights; which was read twice by its title, and referred to the Committee on Patents.

[Senate, first session, March 9, 1886, Cong. Record, vol. 17, part 3, p. 2205.]

#### REPORTS OF COMMITTEES.

Mr. Gray, from the Committee on Patents, to whom was referred the bill (S. 1034) to amend the law relating to patents, trademarks, and copyright, moved its indefinite postponement, which was agreed to. \* \* \*

S. 1209.—A bill to amend the law in relation to the registration of trade marks. Introduced by Hon. Orville H. Platt, of Connecticut, January 25, 1886. Referred to the Committee on Patents. Not reported.

[Senate, first session, January 25, 1886, Cong. Record, vol. 17, part 1, p. 858.]

BILLS INTRODUCED.

\* \* \* \* \*

Mr. Platt introduced a bill (S. 1209) to amend the law in relation to the registration of trademarks; which was read twice by its title, and referred to the Committee on Patents.

FIFTIETH CONGRESS.

H. R. 7732.—A bill imposing a punishment for the counterfeiting of trade marks, labels, etc. Introduced by Hon. William D. Bynum of Indiana, February 27, 1888. Referred to the Committee on Patents. Reported. Referred to the House Calendar.

[House of Representatives, first session, February 27, 1888, Cong. Record, vol. 19, part 2, p. 1513.]

COUNTERFEITING TRADEMARKS, ETC.

Mr. Bynum introduced a bill (H. R. 7732) imposing punishment for the counterfeiting, etc., of trademarks, labels, etc.; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

[House of Representatives, first session, June 22, 1888, Cong. Record, vol. 19, part 6, p. 5480.]

COUNTERFEITING TRADEMARKS, ETC.

Mr. Smith, of Wisconsin, from the Committee on Patents, reported back with amendment the bill (H. R. 7732) imposing punishment for counterfeiting trademarks, labels, etc.; which was referred to the House Calendar, and, with the accompanying report, ordered to be printed.

FIFTY-FIRST CONGRESS.

Four bills were introduced in the House of Representatives in this Congress.

H. R. 160.—A bill to amend "An act to authorize the registration of trade marks and protect the same," approved March 3, 1881. Introduced by Hon. William E. Simonds, of Connecticut, December 18, 1889. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, December 18, 1889, Cong. Record, vol. 21, part 1, p. 230.]

REGISTRATION OF TRADEMARKS.

Mr. Simonds introduced a bill (H. R. 160) to amend "An act to authorize the registration of trade marks and protect the same," approved March 3, 1881; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.

H. R. 260.—A bill imposing punishment for counterfeiting trade marks, labels, etc. Introduced by Hon. William D. Bynum, of Indiana, December 18, 1889. Referred to the Committee on the Judiciary. Reported adversely.

[House of Representatives, first session, December 18, 1889, Cong. Record, vol. 21, part 1, p. 234.]

TRADEMARKS, ETC.

Mr. Bynum introduced a bill (H. R. 260) imposing punishment for counterfeiting, etc., trademarks, labels, etc.; which was read a first and second time, referred to the Committee on the Judiciary, and ordered to be printed.

[House of Representatives, first session, April 26, 1890, Cong. Record, vol. 21, part 4, p. 3913.]

#### ADVERSE REPORTS.

Under clause 2 of Rule XIII, adverse reports were delivered to the Clerk and disposed of as follows:

By Mr. Reed, of Iowa, from the Committee on the Judiciary, on the bill (H. R. 260) imposing punishment for counterfeiting, etc., trademarks, labels, etc.—ordered to be printed and referred to the House Calendar.

[House of Representatives, first session, May 27, 1890, Cong. Record, vol. 21, part 6, p. 5367.]

#### PETITIONS, ETC.

\* \* \* \* \*

By Mr. Wallace, of Massachusetts: Petition of the Massachusetts Association United Hatters of North America, praying passage of House bill 260—to the Committee on Patents.

[House of Representatives, first session, June 16, 1890, Cong. Record, vol. 21, part 7, p. 6161.]

#### PETITIONS, ETC.

\* \* \* \* \*

By Mr. Haynes: Petitions of Sandusky Trade and Labor Assembly, favoring the passage of House bill 260, imposing a punishment for counterfeiting trademarks, etc.—to the Committee on the Judiciary.

[Senate, first session, June 19, 1890, Cong. Record, vol. 21, part 7, p. 6241.]

#### PETITIONS AND MEMORIALS.

\* \* \* \* \*

Mr. Vest presented a memorial of District Assembly, No. 4, Knights of Labor, St. Louis, Mo., praying for the passage of House bill 260, for the punishment of parties counterfeiting trademarks, labels, etc. \* \* \* which was referred to the Committee on Education and Labor.

[House of Representatives, first session, July 12, 1890, Cong. Record, vol. 21, part 8, p. 7228.]

#### PETITIONS, ETC.

\* \* \* \* \*

By Mr. Hayes: Petition of the Cigar Makers' Union of Muscatine, Iowa, in favor of trademark bill—to the Committee on the Judiciary.

Also, petition of Cigar Makers' Union of Davenport, Iowa, favoring same measure—to the Committee on the Judiciary,

H. R. 3812.—A bill relating to patents, trade marks, and copyrights. Introduced by Hon. William E. Simonds, of Connecticut, January 6, 1890. Referred to the Committee on Patents. Reported and referred to the House Calendar.

[House of Representatives, first session, January 6, 1890, Cong. Record, vol. 21, part 1, p. 401.]

#### PATENTS, TRADEMARKS, AND COPYRIGHTS.

Mr. Simonds introduced a bill (H. R. 3812) relating to patents, trademarks, and copyrights; which was read a first and second time, referred to the Committee on Patents, and ordered to be printed.



[House of Representatives, first session, February 6, 1890, Cong. Record, vol. 21, part 2, p. 1119.]

#### PATENTS, TRADEMARKS, AND COPYRIGHTS.

Mr. Simonds, from the Committee on Patents, reported back favorably the bill (H. R. 3812) relating to patents, trademarks, and copyrights; which, with the accompanying report, was ordered to be printed and recommitted.

[House of Representatives, first session, February 18, 1890, Cong. Record, vol. 21, part 2, p. 1466.]

#### PATENTS, TRADEMARKS, AND COPYRIGHTS.

Mr. Simonds, from the Committee on Patents, reported back favorably the bill (H. R. 3812) relating to patents, trademarks, and copyrights; which was referred to the House Calendar, and, with the accompanying report, ordered to be printed.

H. R. 10972.—A bill imposing punishment for counterfeiting trade marks, labels, etc. Introduced by Hon. William D. Bynum, of Indiana, June 16, 1890. Referred to the Committee on the Judiciary. Reported adversely.

[House of Representatives, first session, June 16, 1890, Cong. Record, vol. 21, part 7, p. 6160.]

#### BILLS AND JOINT RESOLUTIONS.

Under clause 3 of Rule XXII, bills \* \* \* of the following titles were introduced, severally read twice, and referred as follows: \* \* \*

By Mr. Bynum: A bill (H. R. 10972) imposing punishment for counterfeiting, etc., trademarks, labels, etc.—to the Committee on the Judiciary.

[House of Representatives, first session, June, 24, 1890, Cong. Record, vol. 21, part 7, p. 6464.]

#### REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Reed, of Iowa, from the Committee on the Judiciary, reported adversely the bill of the House (H. R. 10972) imposing punishment for counterfeiting, etc., trademarks, labels, etc., accompanied by a report (No. 2539); which (by request) was referred to the House Calendar.

#### FIFTY-SECOND CONGRESS.

Six bills were introduced in the House of Representatives in this Congress, and three bills and one resolution in the Senate.

S. 454.—A bill to authorize the registration of trade marks and protect the same. Introduced by Hon. Frank Hiscock, of New York, December 10, 1891. Referred to the Committee on Patents. Not reported.

[Senate, first session, December 10, 1891, Cong. Record, vol. 23, part 1, p. 31.]

#### BILLS INTRODUCED.

\* \* \* \* \*

He [Mr. Hiscock] also introduced a bill (S. 454) to authorize the registration of trademarks and protect the same; which was read twice by its title, and referred to the Committee on Patents.

S. 984.—A bill to reenact the act entitled "An act to punish the counterfeiting of trade mark goods and the sale of or dealing in counterfeit goods." Introduced by Hon. Frank Hiscock, of New York, December 15, 1891. Referred to the Committee on Patents. Not reported.

[Senate, first session, December 15, 1891, Cong. Record, vol. 23, part 1, p. 65.]

#### BILLS INTRODUCED.

\* \* \* \* \*

Mr. Hiscock introduced a bill (S. 984) to reenact the act entitled "An act to punish the counterfeiting of trade mark goods and the sale of or dealing in counterfeit trade mark goods;" which was read twice by its title, and referred to the Committee on Patents.

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H. R. 94.—A bill imposing punishment for counterfeiting trade marks, labels, etc. Introduced by Hon. William D. Bynum, of Indiana, January 5, 1892. Referred to the Committee on the Judiciary. Not reported.

[House of Representatives, first session, January 5, 1892, Cong. Record, vol. 23, part 1, p. 127.]

#### COUNTERFEITING TRADEMARKS, ETC.

By Mr. Bynum: A bill (H. R. 94) imposing punishment for counterfeiting, etc., trademarks, labels, etc.—to the Committee on the Judiciary.

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H. R. 584.—A bill providing penalties for violation of the laws relating to trade marks. Introduced by Hon. John J. O'Neill, of Missouri, January 7, 1892. Referred to the Committee on Patents. H. R. 9528 reported as substitute.

[House of Representatives, first session, January 7, 1892, Cong. Record, vol. 23, part 1, p. 204.]

#### TRADEMARKS.

By Mr. O'Neill, of Missouri: A bill (H. R. 584) providing penalties for violation of the laws relating to trademarks—to the Committee on Patents.

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[House of Representatives, first session, March 30, 1892, Cong. Record, vol. 23, part 3, p. 2749.]

#### PETITIONS, ETC.

By Mr. McAleer. \* \* \* Also, petition of citizens of Philadelphia, favoring bill 584, providing penalties for violation of trademarks—to the Committee on Patents.

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[House of Representatives, first session, April 7, 1892, Cong. Record, vol. 23, part 4, p. 3072.]

#### PETITIONS, ETC.

By Mr. Busey: Petition of Samuel A. Richmond, of Tuscola, Ill., favoring the passage of House bill 584, providing penalties for violating laws relating to trademarks—to the Committee on Patents.

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[House of Representatives, first session, April 11, 1892, Cong. Record, vol. 23, part 4, p. 3185.]

#### PETITIONS, ETC.

By Mr. Patterson, of Tennessee: Petition in support of House bill 584, to prevent violation of trademarks—to the Committee on Patents.

\* \* \* \* \*

By Mr. Reyburn. \* \* \* Also (by request), petition for a change in the laws relating to trademarks—to the Committee on Patents.

[House of Representatives, first session, April 18, 1892, Cong. Record, vol. 23, part 4, p. 3402.]

PETITIONS, ETC.

\* \* \* \* \*

By Mr. Storer: \* \* \* Also, petition of the United States Printing Company of Cincinnati, praying for the passage of House bill 584, known as the trademark bill—to the Committee on Patents.

[House of Representatives, first session, April 19, 1892, Cong. Record, vol. 23, part 4, p. 3434.]

PETITIONS, ETC.

\* \* \* \* \*

By Mr. Newberry: \* \* \* Petition of Libby, McNeill & Libby and L. C. Young praying the passage of the bill introduced by Hon. J. J. O'Neill, of Missouri, known as House bill 584—to the Committee on Patents.

[House of Representatives, first session, April 22, 1892, Cong. Record, vol. 23, part 4, p. 3555.]

PETITIONS, ETC.

\* \* \* \* \*

By Mr. Tracey: Petition of citizens of West Troy, favoring the passage of the O'Neill bill, H. R. 584—to the Committee on Patents.

[House of Representatives, first session, May 13, 1892, Cong. Record, vol. 23, part 5, p. 4276.]

PETITIONS, ETC.

\* \* \* \* \*

By Mr. Stevens: Petition of the Shaw Stocking Company, of Lowell, Mass., asking for favorable action on House bill 584—to the Committee on Patents.

[House of Representatives, first session, May 21, 1892, Cong. Record, vol. 23, part 5, p. 4537.]

PETITIONS, ETC.

\* \* \* \* \*

By Mr. Charles W. Stone: Petition of citizens of Warren County, Pa., in favor of House bill 584, providing penalties for violation of trademark laws—to the Committee on Patents.

[House of Representatives, first session, July 23, 1892, Cong. Record, vol. 23, part 7, p. 6687.]

PETITIONS, ETC.

\* \* \* \* \*

By Mr. O'Neill, of Missouri: Eight petitions of citizens and residents, as follows: Four petitions of citizens of New York City, two of Lowell, Mass., one of Philadelphia, Pa., and one of the State of Rhode Island, all petitioning for the enactment as law the bill known as House bill No. 584, relating to trademarks—to the Committee on Patents.

H. R. 5573.—A bill relating to patents, trade marks, and copyrights. Introduced by Hon. Oscar Lapham, of Rhode Island, February 8, 1892. Referred to the Committee on Patents, H. R. 9528 reported as a substitute.



[House of Representatives, first session, February 8, 1892, Cong. Record, vol. 23, part 1, p. 951.]

#### BILLS INTRODUCED.

\* \* \* \* \*

By Mr. Lapham: A bill (H. R. 5573) relating to patents, trademarks, and copyrights—to the Committee on Patents.

H. R. 5760.—A bill to amend an act entitled “An act to authorize the registration of trade marks and protect the same,” approved March 3, 1881. Introduced by Hon. Ashbel P. Fitch, of New York, February 10, 1892. Referred to the Committee on Patents. H. R. 9528 reported as a substitute.

[House of Representatives, first session, February 10, 1892, Cong. Record, vol. 23, part 2, p. 1042.]

#### BILLS INTRODUCED.

\* \* \* \* \*

By Mr. Fitch: A bill (H. R. 5760) to amend an act entitled “An act to authorize the registration of trade marks and protect the same,” approved March 3, 1881—to the Committee on Patents.

[House of Representatives, first session, February 18, 1892, Cong. Record, vol. 23, part 2, p. 1286.]

#### TRADEMARKS.

Mr. Heard, from the Committee on Patents, reported back adversely the bill (H. R. 5760) to amend an act entitled “An act to authorize the registration of trade marks and protect the same,” approved March 3, 1881; which was laid on the table, and the accompanying report ordered to be printed.

H. R. 7216.—A bill to authorize the registration of trade marks and protect the same. Introduced by Hon. Ashbel P. Fitch, of New York, March 14, 1892. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, March 14, 1892, Cong. Record vol. 23, part 3, p. 2072.]

#### BILLS INTRODUCED.

\* \* \* \* \*

By Mr. Fitch: A bill (H. R. 7216) to authorize the registration of trademarks and protect the same—to the Committee on Patents.

H. R. 9528.—A bill to authorize the registration of trade marks and labels and protect the same. Introduced by Hon. Osee M. Hall, of Minnesota, from the Committee on Patents, July 13, 1892. Reported as substitute for H. R. 584, 5573, 5760.

[House of Representatives, first session, July 13, 1892, Cong. Record, vol. 23, part 6, p. 6125.]

#### REGISTRATION OF TRADEMARKS AND LABELS.

Mr. Hall, from the Committee on Patents, reported, as a substitute for the bills H. R. 584, 5760, 5573 \* \* \* a bill (H. R. 9528) to authorize the registration of trademarks and labels and protect the same; which was read twice, and, with the accompanying report, ordered to be printed.

S. 3478.—A bill relating to the registration of trade marks. Introduced by Hon. Orville H. Platt, of Connecticut, July 27, 1892. Referred to the Committee on Patents. Not reported.

[Senate, first session, July 27, 1892, Cong. Record, vol. 23, part 7, p. 6831.]

#### BILLS INTRODUCED.

\* \* \* \* \*

Mr. PLATT introduced a bill (S. 3478) relating to the registration of trademarks; which was read twice by its title, and referred to the Committee on Patents.

S. Res. —A resolution concerning the enforcement of the provisions of treaties with respect to patents and trade marks. Introduced by Hon. Orville H. Platt, of Connecticut, March 3, 1893. Adopted.

[Senate, second session, March 3, 1893, Cong. Record, vol. 24, part 3, p. 2482.]

#### PATENTS AND TRADEMARKS.

Mr. PLATT. I have had lying on my desk for at least four days a resolution which I desire to have passed. I will send it to the desk to be read.

\* \* \* \* \*

The Senate, by unanimous consent, proceeded to consider the resolution; which was read, as follows:

*Resolved*, That the Commissioner of Patents is requested to ascertain what legislation, if any, is necessary to enforce the provisions of existing treaties or conventions with foreign countries with respect to patents and trade marks, or to secure to citizens of the United States the enjoyment of privileges in foreign countries corresponding to those enjoyed by the citizens or subjects of such countries in the United States, and to report his conclusions to the Senate at the next session of Congress.

Mr. HOAR. I move to strike out the words "Commissioner of Patents," and insert in lieu thereof the words "Secretary of the Interior."

\* \* \* \* \*

The amendment was agreed to.

The resolution as amended was agreed to.

#### FIFTY-THIRD CONGRESS.

Ten bills were introduced in the House of Representatives in this Congress, and one in the Senate.

H. R. 1901.—A bill to authorize the registration of trade marks and protect the same. Introduced by Hon. Ashbel P. Fitch, of New York, September 9, 1893. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, September 9, 1893, Cong. Record, vol. 25, pt. 2, p. 1359.]

#### BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Fitch: A bill (H. R. 1901) to authorize the registration of trademarks and protect the same—to the Committee on Patents.

H. R. 1902.—A bill to amend an act entitled "An act to authorize the registration of trade marks and protect the same," approved March 3, 1881. Introduced by Hon. Ashbel P. Fitch, of New York, September 9, 1893. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, September 9, 1893, Cong. Record, vol. 25, pt. 2, p. 1359.]

BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Fitch: \* \* \* Also a bill (H. R. 1902) to amend an act entitled "An act to authorize the registration of trademarks and protect the same," approved March 3, 1881—to the Committee on Patents.

H. R. 1984.—A bill to authorize the registration of trade marks and labels and to protect the same. Introduced by Hon. Osee Matson Hall, of Minnesota, September 9, 1893. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, September 9, 1893, Cong. Record, vol. 25, part 2, p. 1361.]

BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Hall, of Minnesota: \* \* \* Also a bill (H. R. 1984) to authorize the registration of trademarks and labels, and to protect the same—to the Committee on Patents.

H. R. 3460.—A bill relating to patents, trade marks, and copyrights. Introduced by Hon. Oscar Lapham, of Rhode Island, September 25, 1893. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, September 25, 1893, Cong. Record, vol. 25, part 2, p. 1774.]

PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Lapham: A bill (H. R. 3460) relating to patents, trademarks, and copyrights—to the Committee on Patents.

H. R. 5862.—A bill appointing commissioners to revise the statutes relating to patents, trade and other marks. Introduced by Hon. Gaston A. Robbins, of Alabama, February 17, 1894. Referred to Committee on Patents. Not reported.

[House of Representatives, second session, February 17, 1894, Cong. Record, vol. 26, part 3, p. 2273.]

PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Robbins (by request): A bill (H. R. 5862) appointing commissioners to revise the statutes relating to patents, trade and other marks—to the Committee on Patents.

H. R. 5874.—A bill to authorize the registration of trade marks and labels, and to protect the same. Introduced by Hon. Osee Matson Hall, of Minnesota, February 19, 1894. Referred to the Committee on Patents. Not reported.

[House of Representatives, second session, February 19, 1894, Cong. Record, vol. 26, part 3, p. 2300.]

PUBLIC BILLS AND RESOLUTIONS INTRODUCED.

\* \* \* \* \*

By Mr. Hall, of Minnesota: A bill (H. R. 5874) to authorize the registration of trademarks and labels, and to protect the same—to the Committee on Patents.

H. R. 6441.—A bill to authorize the registration of trade marks and labels, and to protect the same. Introduced by Hon. Osee Matson Hall, of Minnesota, March 26, 1894. Referred to the Committee on Patents. Not reported.



[House of Representatives, second session, March 26, 1894, Cong. Record, vol. 26, part 4, p. 3252.]

## PUBLIC BILLS AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Hall, of Minnesota: A bill (H. R. 6441) to authorize the registration of trademarks and labels, and to protect the same—to the Committee on Patents.

S. 2015.—A bill to authorize the registration of trade marks and labels, and to protect the same. Introduced by Francis M. Cockrell, of Missouri, May 11, 1894. Referred to the Committee on Patents. Not reported.

[Senate, second session, May 11, 1894, Cong. Record, vol. 26, part 5, p. 4590.]

## BILLS INTRODUCED.

\* \* \* \* \*

Mr. Cockrell (by request) introduced a bill (S. 2015) to authorize the registration of trademarks and labels, and to protect the same; which was read twice by its title, and referred to the Committee on Patents.

H. R. 7669.—A bill for the protection of trade marks and labels. Introduced by Hon. Osee Matson Hall, of Minnesota, July 9, 1894. Referred to the Committee on the Judiciary. Not reported.

[House of Representatives, second session, July 9, 1894, Cong. Record, vol. 26, part 7, p. 7229.]

## PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Hall, of Minnesota: A bill (H. R. 7669) for the protection of trademarks and labels—to the Committee on the Judiciary.

H. R. 7835.—A bill to authorize the registration of trade marks and labels, and to protect the same. Introduced by Hon. Osee Matson Hall, of Minnesota, July 27, 1894. Referred to the Committee on Patents. Not reported.

[House of Representatives, second session, July 27, 1894, Cong. Record, vol. 26, part 8, p. 7969.]

## PUBLIC BILLS AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Hall, of Minnesota: A bill (H. R. 7835) to authorize the registration of trademarks and labels, and to protect the same—to the Committee on Patents.

H. R. 8533.—A bill to provide for the registration of trade marks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce. Introduced by Hon. Richard Bartholdt, of Missouri, January 16, 1895. Referred to the Committee on the Judiciary. Not reported.

[House of Representatives, third session, January 16, 1895, Cong. Record, vol. 27, part 2, p. 1051.]

## PUBLIC BILLS AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Bartholdt: A bill (H. R. 8533) to provide for the registration of trademarks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations or among

the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce—to the Committee on the Judiciary.

#### FIFTY-FOURTH CONGRESS.

Seven bills were introduced in the House of Representatives in this Congress and three in the Senate.

H. R. 1675.—A bill to provide for the registration of trade marks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations or among the several States, or with the Indian tribes, or among or in the Territories of the United States or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce. Introduced by Hon. Richard Bartholdt, of Missouri, December 16, 1895. Referred to the Committee on Commerce. H. R. 7477 reported as a substitute.

[House of Representatives, first session, December 16, 1895, Cong. Record, vol. 28, part 1, p. 183.]

#### PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Bartholdt: A bill (H. R. 1675) to provide for the registration of trademarks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce—to the Committee on Commerce.

H. R. 2304.—A bill to amend the act of Congress relating to patents, trade marks, and copyrights. Introduced by Hon. Charles G. Bennett, of New York, December 20, 1895. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, December 20, 1895, Cong. Record, vol. 28, part 1, p. 272.]

#### PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Bennett. \* \* \* A bill (H. R. 2304) to amend the act of Congress relating to patents, trademarks, and copyrights—to the Committee on Patents.

S. 1236.—A bill amending chapter 2 of the Revised Statutes relating to trademarks. Introduced by Hon. Orville H. Platt, of Connecticut, December 30, 1895. Referred to the Committee on Patents. Not reported.

[Senate, first session, December 30, 1895, Cong. Record, vol. 28, part 1, p. 410.]

#### BILLS INTRODUCED.

\* \* \* \* \*

Mr. Platt introduced a bill (S. 1236) amending chapter 2 of the Revised Statutes, relating to trademarks; which was read twice by its title, and referred to the Committee on Patents.

S. 1627.—A bill to amend sections 1, 2, 3, 6, 7, and 11 of an act entitled "An act to authorize the registration of trademarks, and protect the same," approved March 3, 1881. Introduced by Hon. George G. Vest, of Missouri, January 20, 1896. Referred to the Committee on Patents. Not reported.

[Senate, first session, January 20, 1896, Cong. Record, vol. 28, part 1, p. 785.]

# BILLS INTRODUCED.

\* \* \* \* \*

Mr. Vest (by request) introduced a bill (S. 1627) to amend sections 1, 2, 3, 6, 7, and 11 of an act entitled "An act to authorize the registration of trademarks, and protect the same," approved March 3, 1881; which was read twice by its title, and, with the accompanying paper, referred to the Committee on Patents.

H. R. 4349.—A bill to create State trademarks and to protect and promote foreign and interstate commerce. Introduced by Hon. Edward Sauerhering, of Wisconsin, January 20, 1896. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, January 20, 1896, Cong. Record, vol. 28, part 1, p. 810.]

# PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Sauerhering: A bill (H. R. 4349) to create State trademarks and to protect and promote foreign and interstate commerce—to the Committee on Patents.

H. R. 6402.—A bill for the protection of trademarks and labels. Introduced by Hon. Thomas W. Phillips, of Pennsylvania, February 21, 1896. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, February 21, 1896, Cong. Record, vol. 28, part 3, p. 2040.]

# PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Phillips (by request): A bill (H. R. 6402) for the protection of trademarks and labels—to the Committee on Patents.

H. R. 6577.—A bill to authorize the registration of trademarks and labels, and to protect the same. Introduced by the Hon. William F. Draper, of Massachusetts, February 26, 1896. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, February 26, 1896, Cong. Record, vol. 28, part 3, p. 2190.]

# PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

\* \* \* \* \*

By Mr. Draper: A bill (H. R. 6577) to authorize the registration of trademarks and labels, and to protect the same—to the Committee on Patents.

H. R. 7477.—A bill to provide for the registration of trademarks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce. Introduced by Hon. John B. Corliss, of Michigan, of the Committee on Interstate and Foreign Commerce, March 23, 1896, as a substitute for H. R. 1675. Passed in House. Referred to the Senate Committee on Patents. Not reported.



[House of Representatives, first session, March 23, 1896, Cong. Record, vol. 28, part 4, p. 3112.]

## REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Corliss, from the Committee on Interstate and Foreign Commerce, to which was referred House bill No. 1675, reported in lieu thereof a bill (H. R. 7477) to provide for the registration of trade-marks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce, accompanied by a report (No. 884)—which said bill and report were referred to the House Calendar.

[House of Representatives, first session, May 18, 1896, Cong. Record, vol. 28, part 6, p. 5380.]

## REGISTRATION OF TRADEMARKS.

Mr. CORLISS. Mr. Speaker, I am directed by the Committee on Interstate and Foreign Commerce to move to suspend the rules and ask for the present consideration of the bill which I send to the clerk's desk.

The bill was read as follows:

A BILL (H. R. 7477) to provide for the registration of trade-marks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce.

*Be it enacted, etc.* That any and all persons, firms, and corporations engaged in manufacture, bottling, packing, or selling soda water, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, or other beverages, or medicines, medical preparations, perfumery, compounds, mixtures, or other articles of merchandise in bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, with his, her, its, or their name or names or other marks or devices branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels used by him, her, it, or them in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, may obtain registration of such name or names or other marks or devices so used, as follows: Any such person, firm, or corporation may file in the Patent Office of the United States, to be recorded, a written statement specifying the name, domicile, citizenship, place or places of business and post-office address of such person, firm, or corporation, and giving a description and a facsimile of the name or names, or other marks or devices so used by him, her, it, or them, respectively, and the usual name of the article or articles manufactured, bottled, packed, or sold by such owner in such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, said statement declaring that such person, firm, or corporation is, at the time of such filing, the owner of such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, and that the same are used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and that such person, firm, or corporation has at the time a right to the use of such name or names, or other marks or devices, sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; and said statement shall be

sworn to by such person, or by a member of such firm, or an officer of such corporation before a notary public or other officer competent to administer oaths, who shall attach his official seal to the same: *Provided, however,* That for each such statement so filed, and at the time the same is filed, the person, firm, or corporation filing the same shall pay into the Treasury of the United States the sum of \$25 as a fee for such registration, and shall comply with such regulations as may be prescribed by the Commissioner of Patents: *Provided further,* That no registration shall be allowed under this act except by persons, firms, or corporations domiciled in the United States or located in any foreign country, or tribes which, by treaty, convention, or law, afford similar privileges to citizens of the United States.

SEC. 2. That when any registration has been made as provided in section 1 of this act the Commissioner of Patents may issue a certificate in the name of the United States of America, under the seal of the Department of the Interior, and signed by said Commissioner, stating and specifying the name, place or places of business, and post-office address of the person, firm, or corporation obtaining such registration as owner, and giving a description of the registered name or names, or other marks or devices, so used on such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels fully as set forth in said statement filed under section 1 of this act, and such certificate shall state that such name or names, or other marks or devices, have been registered by such owner in accordance with this act, giving the title and date hereof. Such certificate of the Commissioner of Patents shall, in any prosecution under this act, be prima facie evidence of registration in accordance with this act, and also prima facie evidence that the person, firm, or corporation so registered as owner is the true owner of the bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, the name or names, or other marks or devices, on which have been so registered.

SEC. 3. That after the name or names, or other marks or devices, which appear on any bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels have been registered as provided in section 1 of this act, any person, firm, or corporation who shall use in traffic any such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, or make the same the subject of commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, shall be guilty of a misdemeanor, and upon conviction thereof shall pay a fine of not more than \$300, or be imprisoned not more than four months, or both, at the discretion of the court.

SEC. 4. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use or sale of such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels might have had if this act had not been passed.

SEC. 5. That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the said certificates of registration, and for recording the said transfers in his office.

THE SPEAKER. Is a second demanded?

There was no demand for a second.

Two-thirds voting in favor thereof, the rules were suspended and the bill passed.

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[Senate, first session, May 19, 1896, Cong. Record, vol. 28, part 6, p. 5415.]

#### HOUSE BILLS REFERRED.

\* \* \* \* \*

The bill (H. R. 7477) \* \* \* was read twice by its title, and referred to the Committee on Patents.

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H. R. 8892.—A bill to authorize the registration of trademarks and to protect the same. Introduced by Hon. William F. Draper, of Massachusetts, May 12, 1896. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, May 12, 1896, Cong. Record, vol. 28, part 6, p. 5151].

# PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS.

By Mr. Draper. A bill (H. R. 8892) to authorize the registration of trademarks and to protect the same—to the Committee on Patents.

S. 3698.—A bill appointing commissioners to revise the statutes relating to patents, trades, and other marks. Introduced by Hon. Orville H. Platt, of Connecticut, February 15, 1897. Referred to the Committee on Patents. Reported without amendment.

[Senate, second session, February 15, 1897, Cong. Record, vol. 29, part 2, p. 1826.]

## BILLS INTRODUCED.

\* \* \* \* \*

Mr. Platt introduced a bill (S. 3698) appointing commissioners to revise the statutes relating to patents, trades, and other marks; which was read twice by its title, and referred to the Committee on Patents.

[Senate, second session, February 22, 1897, Cong. Record, vol. 29, part 3, p. 2078.]

## REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Platt, from the Committee on Patents, to whom was referred the bill (S. 3698) appointing commissioners to revise the statutes relating to patents, trades, and other marks, reported it without amendment.

## FIFTY-FIFTH CONGRESS.

Eight bills were introduced in the House of Representatives in this Congress and four in the Senate.

H. R. 33.—A bill to authorize the registration of trademarks, and to protect the same. Introduced by Hon. Charles F. Sprague, of Massachusetts, March 15, 1897. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, March 15, 1897, Cong. Record, vol. 30, part 1, p. 20.]

## PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS INTRODUCED.

\* \* \* \* \*

By Mr. Sprague. \* \* \* Also, a bill (H. R. 33) to authorize the registration of trademarks, and to protect the same—to the Committee on Patents.

H. R. 72.—A bill to provide for the registration of trademarks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce. Introduced by Hon. John B. Corliss, of Michigan, March 15, 1897. Passed in House. Referred to Senate Committee on Patents.



[House of Representatives, first session, March 15, 1897, Cong. Record, vol. 30, part 1, p. 21.]

PUBLIC BILLS, MEMORIALS, AND RESOLUTIONS INTRODUCED.

\* \* \* \* \*

By Mr. Corliss. A bill (H. R. 72) to provide for the registration of trademarks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce—to the Committee on Patents.

[House of Representatives, second session, February 25, 1898, Cong. Record, vol. 31, part 3, p. 2213.]

REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Hicks, from the Committee on Patents, to which was referred the bill of the House (H. R. 72), \* \* \* reported the same without amendment, accompanied by a report (No. 549); which said bill and report were referred to the House Calendar.

[House of Representatives, second session, April 18, 1898, Cong. Record, vol. 31, part 5, pp. 4056, 4057.]

TRADEMARKS ON BOTTLES, ETC.

Mr. Hicks. Mr. Speaker, I desire to call up House bill No. 72, to provide for the registration of trademarks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce.

The bill was read, as follows:

*Be it enacted, etc.,* That any and all persons, firms, and corporations engaged in manufacturing, bottling, packing, or selling soda water, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, or other beverages, or medicines, medical preparations, perfumery, compounds, mixtures, or other articles of merchandise in bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, with his, her, its, or their name or names or other marks or devices branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels used by him, her, it, or them in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, may obtain registration of such name or names or other marks or devices so used, as follows: Any such person, firm, or corporation may file in the Patent Office of the United States, to be recorded, a written statement specifying the name, domicile, citizenship, place or places of business, and post-office address of such person, firm, or corporation, and giving a description and a facsimile of the name or names, or other marks or devices so used by him, her, it, or them, respectively, and the usual name of the article or articles manufactured, bottled, packed, or sold by such owner in such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, boxes, kegs, tins, or other receptacles or vessels, said statement declaring that such person, firm, or corporation is, at the

time of such filing, the owner of such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, and that the same are used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and that such person, firm, or corporation has at the time a right to the use of such name or names, or other marks or devices, sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; and said statement shall be sworn to by such person, or by a member of such firm, or an officer of such corporation before a notary public or other officer competent to administer oaths, who shall attach his official seal to the same: *Provided, however,* That for each such statement so filed, and at the time the same is filed, the person, firm, or corporation filing the same shall pay into the Treasury of the United States the sum of \$25 as a fee for such registration, and shall comply with such regulations as may be prescribed by the Commissioner of Patents: *Provided further,* That no registration shall be allowed under this act except by persons, firms, or corporations domiciled in the United States or located in any foreign country, or tribes which, by treaty, convention, or law, afford similar privileges to citizens of the United States.

Sec. 2. That when any registration has been made as provided in section 1 of this act the Commissioner of Patents may issue a certificate in the name of the United States of America, under the seal of the Department of the Interior, and signed by said Commissioner, stating and specifying the name, place, or places of business, and post-office address of the person, firm, or corporation obtaining such registration as owner, and giving a description of the registered name or names, or other marks or devices, so used on such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels fully as set forth in said statement filed under section 1 of this act, and such certificate shall state that such name or names, or other marks or devices, have been registered by such owner in accordance with this act, giving the title and date hereof. Such certificate of the Commissioner of Patents shall, in any prosecution under this act, be prima facie evidence of registration in accordance with this act and also prima facie evidence that the person, firm, or corporation so registered as owner is the true owner of the bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, the name or names, or other marks or devices, on which have been so registered.

Sec. 3. That after the name or names, or other marks or devices, which appear on any bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels have been registered as provided in section 1 of this act, any person, firm, or corporation who shall use in traffic any such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels, or make the same the subject of commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, shall be guilty of a misdemeanor, and upon conviction thereof shall pay a fine of not more than \$300, or be imprisoned not more than four months, or both, at the discretion of the court.

Sec. 4. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use or sale of such bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, or other receptacles or vessels might have had if this act had not been passed.

Sec. 5. That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the said certificates of registration, and for recording the said transfers in his office.

\* \* \* \* \*

The SPEAKER. The question is on the third reading of the bill, the title of which will be read.

The Clerk read as follows:

A bill (H. R. 72) to provide for the registration of trade-marks on bottles, siphons, butts, hogsheads, barrels, half barrels, casks, half casks, quarter casks, kegs, boxes, tins, and other receptacles and vessels used in commerce with foreign nations, or among the several States, or with the Indian tribes, or among or in the Territories of the United States, or with or in the District of Columbia, and to prevent the fraudulent use of the same in such commerce.

Mr. McMILLIN. I ask consent that the bill be reported again.

The SPEAKER. Without objection, the bill will be again read.

Mr. HICKS. I think if my friend from Tennessee will hear the report it will satisfy him in regard to this matter. The bill has already been read at length.

Mr. McMILLIN. I only wanted to get some idea of the nature of the bill. If the report shows that sufficiently, I am entirely willing that it be read instead of having the bill read again.

Mr. BAILEY. I thought the question was on the third reading of the bill.

The SPEAKER. It is. If there be no objection, the Clerk will proceed with the reading.

Mr. BAILEY. I simply desire to say that if this matter will occupy much time I would ask the Chair to appoint the conferees, in the hope that our conferees might, as soon as possible, confer with those of the Senate, and that we may dispose of this matter before both Houses adjourn to-night.

The SPEAKER. The Chair desires to say that he expects of the House the usual courtesy with regard to his appointments. It is not his purpose to delay the matter beyond what is necessary, and whatever he may do, he again says, will be under the eyes of the House.

Mr. BAILEY. And everybody on this side is entirely willing for the Chair to take a proper time; but I understood the Chair to say, in response to my inquiry, that the Chair was ready to name them at any time.

The SPEAKER. The gentleman misunderstood the Chair.

Mr. BAILEY. I did. I understood the Chair to say that.

Mr. BOUTELLE, of Maine. I ask for the regular order, Mr. Speaker, if there is any regular order.

The SPEAKER. The Clerk will proceed with the reading of the bill.

The bill H. R. 72 was again read.

Mr. HICKS. Mr. Speaker, does any gentleman desire to make any remarks on this bill? If not, I ask that it be placed upon its passage.

The SPEAKER. The question is upon the engrossment and third reading of the bill.

Mr. HOPKINS. Before that is done, I think there ought to be some explanation of this bill.

Mr. CORLISS. I ask for the reading of the report.

Mr. HOPKINS. This is a matter of very great importance to the manufacturing and commercial interests of the country, and it ought not to pass this body without being well understood.

Mr. HICKS. I hold in my hand the report of the committee, giving, I think, full and sufficient reasons why this bill should become a law. I can not express myself in better language than I did in my report. I therefore ask for the reading of the report.

The SPEAKER. The Clerk will read the report.

The report (by Mr. Hicks) was read, as follows:

The Committee on Patents, to whom was referred the bill (H. R. 72) to provide for the registration of trade-marks on bottles, siphons, casks, etc., and other vessels used in commerce with foreign nations or among the several States, etc., submit the following report:

This bill is an important measure, and the subject-matter thereof was carefully considered by the Committee on Patents, first by a subcommittee and then in general committee, and the voice of the committee was unanimous in favor of the speedy enactment of the measure into law. This same measure was considered in the Fifty-



fourth Congress by the Committee on Interstate and Foreign Commerce, and that committee said in their report:

"This measure is intended to protect not only the reliable manufacturers and merchants against the unlawful use of receptacles well known and established in the markets as containing reliable goods, but also seeks to especially preserve for the consumer the original article and prevent the substitution of cheap and spurious merchandise in casks, boxes, and other receptacles known to contain reliable articles of merchandise in the first instance.

"This measure will extend the wise provisions of the trade-mark to the casks, bottles, and other receptacles. The importance of its provisions has been urged for many years by the leading business concerns, boards of trade, and commercial journals of the country. The Oil, Paint and Drug Reporter, one of the leading trade journals, in the interest of its patrons has urged the adoption of such a law, and the necessity for the passage of this bill seems urgent from the information received in the consideration thereof."

Numerous petitions were presented to your committee, representing many industries and manufacturing institutions, all of which urge the necessity of the protection granted in the pending bill. It is claimed by these industries and institutions that there is not in the law, as it now exists, adequate protection against the dishonest and fraudulent use of labels and trade-marks. Genuine articles sold by honest dealers, under skillfully designed and selected trade-marks, are so frequently the subject of piracy and dishonest dealing that the public are continually imposed upon, as well as retail dealers, who have difficulty in distinguishing the good from the bad and the real from the imitations. In view of the importance of honesty and fair dealing in business and trade, and the protection of the honest manufacturer, who is proud of his "trade-mark" and name, from the fraudulent dealer who depends upon his ability to impose his worthless articles upon an unsuspecting public by reason of his ability to unlawfully appropriate an honest trade-mark to further his imposition and fraud, it is, in the judgment of your committee, important to our manufacturing industries that this bill become a law, and they therefore urge its speedy enactment.

Mr. HICKS. Mr. Speaker, this measure was reported to the Fifty-fourth Congress by the Committee on Interstate and Foreign Commerce. It was unanimously reported by that committee and passed the House. In this Congress it was referred to the Committee on Patents and unanimously reported from that committee. We believe it to be a meritorious measure. I ask for the passage of the bill.

Mr. ROBBINS. I should like to ask the gentleman in charge of this bill whether it affects the liquor industry of the country in any way? There was a bill recently passed authorizing the branding of corks, etc. I see this bill provides for labels and trademarks on bottles.

Mr. HICKS. I yield sufficient time to my friend, Mr. Corliss, of Michigan, the author of the bill, who can explain fully to my colleague the object of the measure.

Mr. CORLISS. In answer to the inquiry of the gentleman, I will state that the liquor associations desire the passage of this measure, for the reason that under the present condition of affairs when a cask or bottle is stamped as containing a recognized liquor, there is now no protection under national law to prevent the substitution of a spurious article.

Many of the States have this law, but if a person manufactures liquor or any other substance that is to be sold in a cask or a bottle, he is not protected against the retailer taking the bottle or cask which is supposed to contain good whisky or some other standard article, putting in a spurious article, and selling it to the public under the old label, thereby deceiving customers. There is a great deal of complaint against this sort of thing, and there is no doubt that this is a good bill.

The bill was ordered to be engrossed and read a third time; and it was accordingly read the third time, and passed.

[Senate, second session, April 19, 1898, Cong. Record, vol. 31, part 5, p. 4070.]

## HOUSE BILLS REFERRED.

\* \* \* \* \*

The bill (H. R. 72) \* \* \* was read twice by its title and referred to the Committee on Patents.

S. 671.—A bill appointing commissioners to revise the statutes relating to patents, trade and other marks. Introduced by Hon. Orville H. Platt, of Connecticut, March 18, 1897. Referred to the Committee on Patents. Indefinitely postponed.

[Senate, first session, March 18, 1897, Cong. Record, vol. 30, part 1, p. 49.]

## BILLS INTRODUCED.

\* \* \* \* \*

Mr. Platt, of Connecticut, introduced the following bills; which were severally read twice by their titles and referred to the Committee on Patents:

A bill (S. 671) appointing commissioners to revise the statutes relating to patents, trade and other marks. \* \* \*

[Senate, second session, May 18, 1898, Cong. Record, vol. 31, part 5, p. 4992.]

## REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Platt, of Connecticut, from the Committee on Patents, \* \* \* to whom was referred the bill (S. 671) appointing commissioners to revise the statutes relating to patents, trade and other marks, reported adversely thereon; and the bill was postponed indefinitely.

H. R. 2807.—A bill to protect labor unions and others in the use of trade marks, labels, and forms of advertisement. Introduced by Hon. Sydney E. Mudd, of Maryland, April 14, 1897. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, April 14, 1897, Cong. Record, vol. 30, part 1, p. 721.]

## PUBLIC BILLS, RESOLUTIONS, AND MEMORIALS INTRODUCED.

\* \* \* \* \*

By Mr. Mudd: A bill (H. R. 2807) to protect labor unions and others in the use of trademarks, labels, and forms of advertisement—to the Committee on Patents.

H. R. 3128.—A bill to authorize the registration of trade marks, and to protect the same. Introduced by Hon. Josiah D. Hicks, of Pennsylvania, May 6, 1897. Referred to the Committee on Patents. Not reported.

[House of Representatives, first session, May 6, 1897, Cong. Record, vol. 30, part 1, p. 941.]

## PUBLIC BILLS, RESOLUTIONS, AND MEMORIALS INTRODUCED.

\* \* \* \* \*

By Mr. Hicks: A bill (H. R. 3128) to authorize the registration of trademarks, and to protect the same—to the Committee on Patents.

H. R. 4584.—A bill to create State trademarks and to protect foreign and interstate commerce. Introduced by Hon. Edward Sauerhering, of Wisconsin, December 10, 1897. Withdrawn.

[House of Representatives, second session, December 10, 1897, Cong. Record, vol. 31, part 1, p. 103.]

PUBLIC BILLS, RESOLUTIONS, AND MEMORIALS INTRODUCED.

\* \* \* \* \*

By Mr. Sauerhering: A bill (H. R. 4584) to create State trade marks and to protect foreign and interstate commerce—to the Committee on Patents.

[House of Representatives, second session, March 10, 1898, Cong. Record, vol. 31, part 3, p. 2716.]

REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Hicks, from the Committee on Patents, \* \* \* to which was referred the bill of the House (H. R. 4584) to create State trade marks and to protect foreign and interstate commerce, reported the same with amendment, accompanied by a report (No. 692); which said bill and report were referred to the House Calendar.

[House of Representatives, second session, March 22, 1898, Cong. Record, vol. 31, part 4, p. 3098.]

STATE TRADEMARKS.

Mr. SAUERHERING. Mr. Speaker, I ask unanimous consent for the present consideration of the bill (H. R. 4584) to create State trade marks and to protect foreign and interstate commerce.

The bill was read as follows:

*Be it enacted, etc.,* That in order to prevent the false branding or other marking of goods, wares, or merchandise, the product of any State or Territory of the United States or of the District of Columbia, which are or are intended to become articles of foreign or interstate commerce or commerce with the Indian tribes, the governor of any such State or Territory and the Commissioners of the District of Columbia are hereby authorized and empowered to adopt a public trade-mark each for his or their respective State, Territory, or the District aforesaid, and file a description and illustration of the same in the Patent Office of the United States; but no such trade-mark or label shall be entitled to such registration which consists of or simulates the arms, seals, or other insignia of the United States, or of any State or municipality, or of any foreign nation, or which is offensive to public sentiment or morals.

SEC. 2. That upon the receipt of any description and illustration of a trade-mark as provided in the preceding section, and upon payment of a fee of \$25, the Commissioner of Patents shall register the same, and a certificate of such registration, fully describing such trade-mark, shall be issued in the name of the United States of America, under the seal of the Department of the Interior, and signed by the Commissioner of Patents, and a full record thereof be made and kept in books for that purpose. Copies of any such trade-marks, and of the descriptions accompanying the same, and of the certificate of registry, when duly authenticated by the Commissioner or Assistant Commissioner of Patents, shall be received in evidence in all courts and by all officers of the United States, and shall be conclusive proof of the adoption and registration of such trade-marks.

SEC. 3. That every such trade-mark shall be used only under and in accordance with such rules, regulations, and restrictions as may be provided by or according to the laws of the State, Territory, or District adopting and filing the same, and upon goods, wares, and merchandise produced, grown, or manufactured therein, and upon packages and wrappers containing the same.

SEC. 4. That every person who, contrary to the provisions of this act or to the laws, rules, regulations, and restrictions of any State or Territory or the District aforesaid, affixes the registered trade-mark of such State, Territory, or District, or causes or procures the same to be affixed, or any colorable imitation thereof, calculated to deceive the public, to any goods, wares, or merchandise which are or are intended for sale, shipment, consumption, or use without and beyond the boundaries of such State, Territory, or District, or to any package or wrapper containing the same, shall be liable to an action on the case for damages for the wrongful use of said trade-mark



at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in commerce with foreign nations, or among the several States, or with the Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

SEC. 5. That every person who shall knowingly deal in, or sell, or keep, or offer for sale, or cause or procure the sale of, any goods, wares, or merchandise, in order that the same may become, or after they have become, subjects of foreign or interstate commerce, to which, or to the package or wrapper containing the same, there is fraudulently affixed any public trade-mark, as provided in this act, or any colorable imitation thereof calculated to deceive the public, shall be deemed guilty of a misdemeanor, and on conviction thereof shall be punished as provided in section 4 of this act.

SEC. 6. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package, or fraudulently uses, or causes or procures to be used, any wrapper to which is affixed any public trade-mark registered pursuant to the provisions of this act, or any colorable imitation thereof calculated to deceive the public, with any goods, wares, or merchandise, with intent to deceive or mislead any purchaser or user of the same as to their true character, origin, or source, shall, if said goods, wares, or merchandise have become or are intended to become subjects of foreign or interstate commerce or commerce with the Indian tribes, be deemed guilty of a misdemeanor, and on conviction thereof shall be punished as provided in section 4 of this act.

SEC. 7. That if any person shall brand, mark, stamp, stencil, label, name, or describe any goods, wares, or merchandise, or any package or wrapper containing the same, which have or may become subjects of foreign or interstate commerce, in such manner as may be calculated to deceive or mislead any purchaser or user of the same as to the true character of such goods, wares, or merchandise, or as to the place where they were grown, produced, or manufactured, or shall cause or procure the same to be done by others; or if any person for himself, or as the agent or factor for another, or as a member of any copartnership, or as a manager, superintendent, agent, or representative of any corporation, shall have in his possession or under his control any goods, wares, or merchandise which he knows or has good reason to believe bear any public trade-mark, or any brand, mark, stamp, stencil, label, name, or description, in contravention of the provisions of this act, he is guilty of a misdemeanor, and upon conviction thereof shall be punished as provided in section 4 of this act.

Mr. BENNETT. Mr. Speaker, reserving the right to object—

Mr. HOPKINS. Mr. Speaker, I object. This is too important a bill to be considered in this way.

\* \* \* \* \*

[House of Representatives, second session, April 18, 1898, Cong. Record, vol 31, part 5, p. 4058.]

#### STATE TRADEMARKS, ETC.

Mr. HICKS. Mr. Speaker, I now ask for the consideration of the bill (H. R. 4584) to create State trademarks and to protect foreign and interstate commerce.

The bill was read, as above:

\* \* \* \* \*

The Committee on Patents recommended the following amendments:

The Committee on Patents, to whom was referred the bill (H. R. 4584) entitled "A bill to create State trade-marks and to protect foreign and interstate commerce," beg leave to submit the following report, with several amendments, and recommend that said bill do pass.

In line 12, page 3, section 4, strike out the words "owner thereof" and insert the words "State, Territory, or District adopting the same."

In line 13, page 3, section 4, strike out the word "his" and insert the letter "a" therefor.

In lines 16 and 17, page 3, section 4, strike out the words "and to recover compensation therefor."

In line 10, page 4, section 5, strike out the words "section four of."

In line 13, page 4, section 6, strike out the words "section four of."

In lines 18 and 19, page 5, section 7, strike out the words "as provided in section four of this act," and insert the words "by a fine not to exceed the sum of \$1,000, or imprisonment not to exceed one year, or by both such fine and imprisonment, in the discretion of the court."

Mr. HICKS. Mr. Speaker, I move to amend this bill by striking out all of section 7 as it now exists and substituting therefor a penalty clause, which shall read as follows—

Mr. ROBBINS. Mr. Speaker, I should like to have order. This seems to be a very important bill, changing the whole trademark laws of the country.

Mr. HICKS. Oh, no.

Mr. ROBBINS. We want to hear something about it. It seems to be a very radical measure.

Mr. HICKS. My motion is that all of section 7 as read be stricken out, and that a penalty clause be inserted, to read as follows:

In all convictions under this act the person or persons so convicted shall be deemed guilty of a misdemeanor, and shall be punished by a fine not to exceed \$1,000, or imprisonment not to exceed one year, or either or both such fine and imprisonment, at the discretion of the court.

I now move the passage of the bill with the amendment.

Mr. DOCKERY. Has there been any general debate?

The SPEAKER. The Chair desires to suggest to the gentleman from Pennsylvania that the section which he moves to strike out has several amendments pending upon it. Action must first be taken upon the amendments.

Mr. HICKS. Of course we want to get it in the proper parliamentary form.

The SPEAKER. The question is first on the amendments before the motion to strike out is put.

Mr. DOCKERY. Mr. Speaker—

Mr. HICKS. I want, of course, to get the bill in proper parliamentary form.

Mr. DOCKERY. This bill seems to be a very important measure.

Mr. HICKS. It is, and concerns important interests that include all the food producers of the country.

Mr. DOCKERY. Changing the law in respect to trademarks. I am not familiar with this question, but it does occur to me that the bill can very properly go over until the House is in proper condition for its consideration. Under existing surroundings a bill of this importance, with a large number of sections, should be considered by the House. The committee is proposing to strike out one section, so that it is apparent that the committee itself has found some objection to its own measure. I do not know anything about the bill, but a gentleman on my right states that it changes the law relating to trademarks so that States may establish trademarks; and objection is also made by one or two gentlemen that jurisdiction is given to the United States courts without reference to the amount involved. It is obvious, Mr. Speaker, that it is an important measure, and I do not think it should be pressed for action until the House is in proper condition to consider it.

Mr. HICKS. I will state, in reply to my friend, that this bill is pressed by the food-producing interests of the country. They have appeared before the committee and urged the enactment of a measure such as this. The clause that we agree to strike out, section 7, is stricken out

at the request of the wine and liquor producers of this country, they claiming that it interferes especially with their interests, and we agreed, rather than have any serious opposition here upon the floor and interfere with interests that we have no desire nor intention to antagonize, that we will not insist upon the enactment of section 7, but insert a penalty clause instead thereof. I yield five minutes to the gentleman from New York [Mr. Chickering].

MR. CHICKERING. I thank the gentleman, but do not desire to take up the time of the House. The measure meets the requirements of the interests of my people fully.

MR. HICKS. The gentleman from New York [Mr. Chickering] represents the dairy interests of New York State. The assistant secretary of agriculture of that State, the superintendent of the dairy and food commission of New York, and the representatives of the American Produce Exchange of the city of New York and also of the State of New York, all appeared before the committee and urged the enactment of this measure. I believe that this amendment which has been suggested to the measure will not antagonize the food-producing interests and will in no way interfere with the real object of the measure. There should be no serious objection to the enactment of the bill into law.

MR. BARTLETT. How does it change the law?

MR. HICKS. It does not change the present law.

MR. DE VRIES. With that section out there will be nothing that will interfere with the wine and liquor interests of the country?

MR. HICKS. Nothing.

MR. DE VRIES. And the practice of branding for Sauterne, Burgundy, etc., will not be prohibited by any provision of this bill?

MR. HICKS. No, sir. The gentleman from New York [Mr. Fischer] has examined the measure and agrees to it. He thinks with this section 7 stricken out there can be no objection to the bill. He can speak for himself.

MR. FISCHER. I want to ask the gentleman from Pennsylvania a question. The question has been asked by friends about me. It relates to section 5. As I understand that section, it simply intends to prohibit the refilling of bottles and casks that are already marked and labeling them with other brands.

MR. HICKS. The gentleman correctly interprets that paragraph of the bill.

MR. FISCHER. And section 7, to which I called your attention, is obnoxious to the wine and liquor interests?

MR. HICKS. Yes, sir; that is your claim.

MR. FISCHER. And your committee has stricken it out, merely inserting a penalty in its place?

MR. HICKS. Yes; I do this to prevent antagonism to the part of the bill I am specially desirous of caring for, as already stated by me.

MR. DE VRIES. Section 6 also applies only to refilling. Is that not true?

MR. HICKS. Yes, sir; that is correct.

THE SPEAKER. The question is on the committee amendments to the section that is proposed to be stricken out.

MR. BARTHOLDT. Mr. Speaker, will it be in order to move to recommit the bill to the committee?

THE SPEAKER. It will be in order to recommit.

MR. BARTHOLDT. I make such a motion.



The SPEAKER. The gentleman from Missouri moves to recommit the bill to the committee.

Mr. DOCKERY. Pending that motion, I suggest to the gentleman from Pennsylvania that some accommodation of differences be made, so that the bill may be withdrawn. It does not seem to me that this is an opportune time to consider the bill.

Mr. HICKS. I will withdraw the bill on the request of my friend from Missouri, and in view of the disposition of the House not to consider the bill at this time.

Mr. BARTHOLDT. I consent to its being withdrawn, Mr. Speaker.

The SPEAKER. The bill is considered as withdrawn.

Mr. HICKS. I would like for it, however, Mr. Speaker, to retain its place and for the Committee on Patents to retain its place on the call of committees.

The SPEAKER. If there is no objection, the gentleman can call it up at some other time and his committee retain its place.

There was no objection.

Mr. RIDGELY. I would like to say a word upon this bill itself, Mr. Speaker.

Mr. ARNOLD. It is withdrawn.

Mr. RIDGELY. To the committee, not to the House.

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H. R. 8582.—A bill to amend the act of Congress relating to patents, trade marks, and copyrights. Introduced by Hon. Charles G. Bennett, of New York, February 24, 1898. Referred to the Committee on Patents. Not reported.

[House of Representatives, second session, February 24, 1898, Cong. Record, vol. 31, part 3, p. 2154.]

#### PUBLIC BILLS, RESOLUTIONS, AND MEMORIALS INTRODUCED.

\* \* \* \* \*

By Mr. Bennett: A bill (H. R. 8582) to amend the act of Congress relating to patents, trademarks, and copyrights—to the Committee on Patents.

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H. R. 8620.—A bill to amend the act of Congress relating to patents, trade marks, and copyrights. Introduced by Hon. John Murray Mitchell, of New York, February 24, 1898. Referred to the Committee on Patents. Reported and referred to the House Calendar.

[House of Representatives, second session, February 24, 1898, Cong. Record, vol. 31, part 3, p. 2154.]

#### PUBLIC BILLS, RESOLUTIONS, AND MEMORIALS INTRODUCED.

\* \* \* \* \*

By Mr. Mitchell: A bill (H. R. 8620) to amend the act of Congress relating to patents, trademarks, and copyrights—to the Committee on Patents.

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[House of Representatives, second session, March 10, 1898, Cong. Record, vol. 31, part 3, p. 2716.]

#### REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Hicks, from the Committee on Patents, to which was referred the bill of the House (H. R. 8620) to amend the act of Congress relat-

ing to patents, trademarks, and copyrights, reported the same with amendment, accompanied by a report (No. 691); which said bill and report were referred to the House Calendar.

S. 3956.—A bill to amend the act of Congress relating to patents, trade marks, and copyrights. Introduced by Hon. Orville H. Platt, of Connecticut, February 25, 1898. Referred to the Committee on Patents. Not reported.

[Senate, second session, February 25, 1898, Cong. Record, vol. 31, part 3, p. 2159.]

#### BILLS INTRODUCED.

\* \* \* \* \*

Mr. Platt, of Connecticut, (by request) introduced a bill (S. 3956) to amend the act of Congress relating to patents, trademarks, and copyrights; which was read twice by its title and referred to the Committee on Patents.

S. 4256.—A bill to establish a high court of patents, trade marks, and copyrights. Introduced by Hon. Henry C. Hansbrough, of North Dakota, March 28, 1898. Referred to the Committee on the Judiciary. Not reported.

[Senate, second session, March 28, 1898, Cong. Record, vol. 31, part 4, p. 3277.]

#### BILLS INTRODUCED.

\* \* \* \* \*

Mr. Hansbrough introduced a bill (S. 4256) to establish a high court of patents, trademarks, and copyrights; which was read twice by its title and referred to the Committee on the Judiciary.

S. 4794.—A bill to authorize the registration of trademarks and to protect the same. Introduced by Hon. Orville H. Platt, of Connecticut, June 20, 1898. Referred to the Committee on Patents. Not reported.

[Senate, second session, June 20, 1898, Cong. Record, vol. 31, part 7, p. 6140.]

#### BILLS INTRODUCED.

\* \* \* \* \*

Mr. Platt of Connecticut (by request) introduced a bill (S. 4794) to authorize the registration of trademarks and to protect the same, which was read twice by its title and referred to the Committee on Patents.

H. R. 9815.—A bill appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names. Introduced by Hon. Josiah D. Hicks, of Pennsylvania, April 12, 1898. Passed in House and Senate. Approved by the President June 4, 1898. (33 U. S. Stat. L., p. 431, chap. 379.)

[House of Representatives, second session, April 12, 1898, Cong. Record, vol. 31, part 4, p. 3769.]

#### PUBLIC BILLS, RESOLUTIONS, AND MEMORIALS INTRODUCED.

\* \* \* \* \*

By Mr. Hicks: A bill (H. R. 9815) appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names—to the Committee on Patents.

[House of Representatives, second session, May 3, 1898, Cong. Record, vol. 31, part 5, p. 4557.]

# REPORTS OF COMMITTEES.

\* \* \* Mr. Hicks, from the Committee on Patents, to which was referred the bill of the House (H. R. 9815) appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names, reported the same without amendment, accompanied by a report (No. 1256); which said bill and report were referred to the Committee of the Whole House on the state of the Union.

[House of Representatives, second session, May 10, 1898, Cong. Record, vol. 31, part 5, p. 4776.]

# REVISION OF PATENT LAWS, ETC.

Mr. HICKS. I ask unanimous consent for the immediate consideration of the bill (H. R. 9815) appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names.

The bill was read, as follows:

*Be it enacted, etc.,* That the President, with the advice and consent of the Senate, shall appoint three commissioners, whose duty it shall be to revise and amend the laws of the United States concerning patents, trade and other marks, and trade or commercial names, which shall be in force at the time such commission shall make its final report, so far as the same relates to matters contained in or affected by the convention for the protection of industrial property concluded at Paris March 20, 1883, the agreements under said convention concluded at Madrid April 14, 1891, and the protocols adopted by the conference held under such convention at Brussels, 1897, and the treaties of the United States, and the laws of other nations relating to patents, trade and other marks, and trade or commercial names.

That they shall report to Congress as soon as possible.

That the report shall be so made as to indicate any proposed change in the substance of existing law, and shall be accompanied by notes which shall briefly and clearly state the reasons for any proposed change. It shall also be accompanied by references to such treaties and foreign laws relating to patents, trade and other marks, and trade or commercial names, as, in the opinion of the commissioners, may affect the citizens of the United States.

That the sum of \$250, or so much thereof as may be necessary, be appropriated to pay the necessary expenses of the commissioners in making their report, which sum shall be immediately available.

The SPEAKER. Is there objection to the present consideration of this bill?

Mr. DINGLEY. Is the expense of this commission not to exceed the sum of \$250?

Mr. HICKS. Yes, sir.

Mr. DINGLEY. Can the work be done for that amount?

Mr. HICKS. The expense is not to exceed the sum named in the bill.

Mr. DINGLEY. Can commissioners do this work for that amount?

Mr. HICKS. Yes, sir. Our commissioners abroad have served without compensation, and I have agreed with the gentleman from Missouri [Mr. Dockery] that I will move an amendment to this bill to insert after the word "commissioners," in line 4, page 1, the words "to serve without compensation." If the House will agree to consider the bill, I will move that amendment.

There being no objection, the House proceeded to consider the bill.

Mr. HICKS. I now move to amend by inserting after the word "commissioners," in line 4, page 1, the words "to serve without compensation."

The amendment was agreed to.



Mr. LIVINGSTON. I believe the gentleman from Pennsylvania [Mr. Hicks] did not answer the question of the gentleman from Maine [Mr. Dingley], which was whether all expenses would be covered by \$250. Is the gentleman willing to offer an amendment to add the words "and no more?"

Mr. HICKS. The expenses are to be covered entirely by the sum of \$250, which is for typewriting and other writing that is to be done in connection with the work of this commission. The commission is to report to Congress a revision of the laws on this subject, so as to make our patent and trademark laws correspond with our treaties with foreign nations. That is the purpose of the commission.

Mr. LIVINGSTON. Why not add at the close of the bill, after the words "which sum shall be immediately available," the words "and in full for all expenses?"

Mr. HICKS. I am willing that the gentleman from Georgia should offer that amendment. I will assent to it.

Mr. LIVINGSTON. I offer that amendment, to come in at the close of the last paragraph.

Mr. STEELE. As I understand, these commissioners do their work for nothing, and it certainly would be unjust to ask that they pay their own expenses for typewriting, etc. If this appropriation is not enough, why not give more?

Mr. HICKS. It is all that the commissioners ask and all that the gentlemen who are back of this movement desire.

Mr. LIVINGSTON. I withdraw the amendment.

Mr. DOCKERY. Mr. Speaker, I desire to avail myself of this opportunity to submit one single observation, by way of vindication of my own judgment, in reference to the question of revising our statutes.

I offered a bill in the last Congress providing for a general revision of the statutes of the United States. It will be remembered that there has been no general revision since the revision under the act of 1873 as amended, whereas the usual practice in the States of the Union is to revise their statutes every ten years. Believing that the United States statutes should have an immediate revision, I introduced the bill, which was favorably reported, but for reasons the Speaker is entirely familiar with that bill did not pass.

Subsequently an amendment was offered to the sundry civil bill in the Senate creating a commission to codify and revise the criminal and penal laws of the United States. That commission is now in full blast, and, with a corps of clerks, I suppose is busily engaged in the work of accomplishing this revision.

Now comes another commission—and I agreed not to object to the consideration of this bill—to revise the patent laws of the United States.

I hope at some time, along the lines of these various revisions, we shall have one commission to revise all of the laws of the United States. In my judgment it is an important work, and one that should be accomplished without delay.

Mr. HICKS. Mr. Speaker, in order that there may be no misunderstanding in reference to the pending bill, this relates, I will state to the House, to a revision of the laws covering patents and trademark regulations which come within the scope of our agreement with foreign nations.

I ask a vote upon the bill.

The bill as amended was ordered to be engrossed and read a third time; and it was accordingly read the third time, and passed.

On motion of Mr. Hicks, a motion to reconsider the last vote was laid on the table.

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[Senate, second session, May 11, 1898, Cong. Record, vol. 31, part 5, p. 4780.]

#### HOUSE BILLS REFERRED.

The bill (H. R. 9815) appointing commissioners to revise the statutes relating to patents, trademarks, and trade and commercial names was read twice by its title, and referred to the Committee on Patents.

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[Senate, second session, May 18, 1898, Cong. Record, vol. 31, part 5, p. 4992.]

#### REPORTS OF COMMITTEES.

\* \* \* \* \*

Mr. Platt, of Connecticut, from the Committee on Patents, to whom was referred the bill (H. R. 9815) appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names, reported it without amendment, and submitted a report thereon.

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[Senate, second session, May 25, 1898, Cong. Record, vol. 31, part 6, p. 5188.]

#### PATENTS AND TRADEMARKS.

MR. PLATT, of Connecticut. I ask unanimous consent to call up the bill (H. R. 9815) appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names.

There being no objection, the Senate, as in Committee of the Whole, proceeded to consider the bill. It provides that the President, with the advice and consent of the Senate, shall appoint three commissioners, to serve without compensation, whose duty it shall be to revise and amend the laws of the United States concerning patents, trade and other marks, and trade or commercial names, which shall be in force at the time such commission shall make its final report, so far as the same relates to matters contained in or affected by the convention for the protection of industrial property concluded at Paris March 20, 1883, the agreements under the convention concluded at Madrid April 14, 1891, and the protocols adopted by the conference held under such convention at Brussels, 1897, and the treaties of the United States, and the laws of other nations relating to patents, trade and other marks, and trade or commercial names.

The bill was reported to the Senate without amendment, ordered to a third reading, read the third time, and passed.

[Senate, second session, May 27, 1898, Cong. Record, vol. 31, part 6, p. 5292.]

#### ENROLLED BILLS SIGNED.

A message from the House of Representatives, by Mr. W. J. Browning, its chief clerk, announced that the Speaker of the House had signed the following enrolled bills, \* \* \* and they were thereupon signed by the Vice-President.

\* \* \* \* \*

A bill (H. R. 9815) appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names.

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[House of Representatives, second session, May 27, 1898, Cong. Record, vol. 31, part 6, p. 5304.]

#### ENROLLED BILLS SIGNED.

Mr. Hagar, from the Committee on Enrolled Bills, reported that they had examined and found truly enrolled bills of the following titles, when the Speaker signed the same:

\* \* \* \* \*

H. R. 9815. An act appointing commissioners to revise the statutes relating to patents, trade and other marks, and trade and commercial names.

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[House of Representatives, second session, June 6, 1898, Cong. Record, vol. 31, part 6, p. 5566.]

#### MESSAGE FROM THE PRESIDENT.

A message from the President of the United States, by Mr. Pruden, one of his secretaries, informed the House of Representatives that the President had approved and signed bills of the following titles:

On June 4, 1898. \* \* \*

H. R. 9815. An act appointing commissioners to revise the statutes relating to patents, trade and other marks and trade and commercial names.

This is the statute under which your commission is now acting, and is to be found on page 145 of this report.





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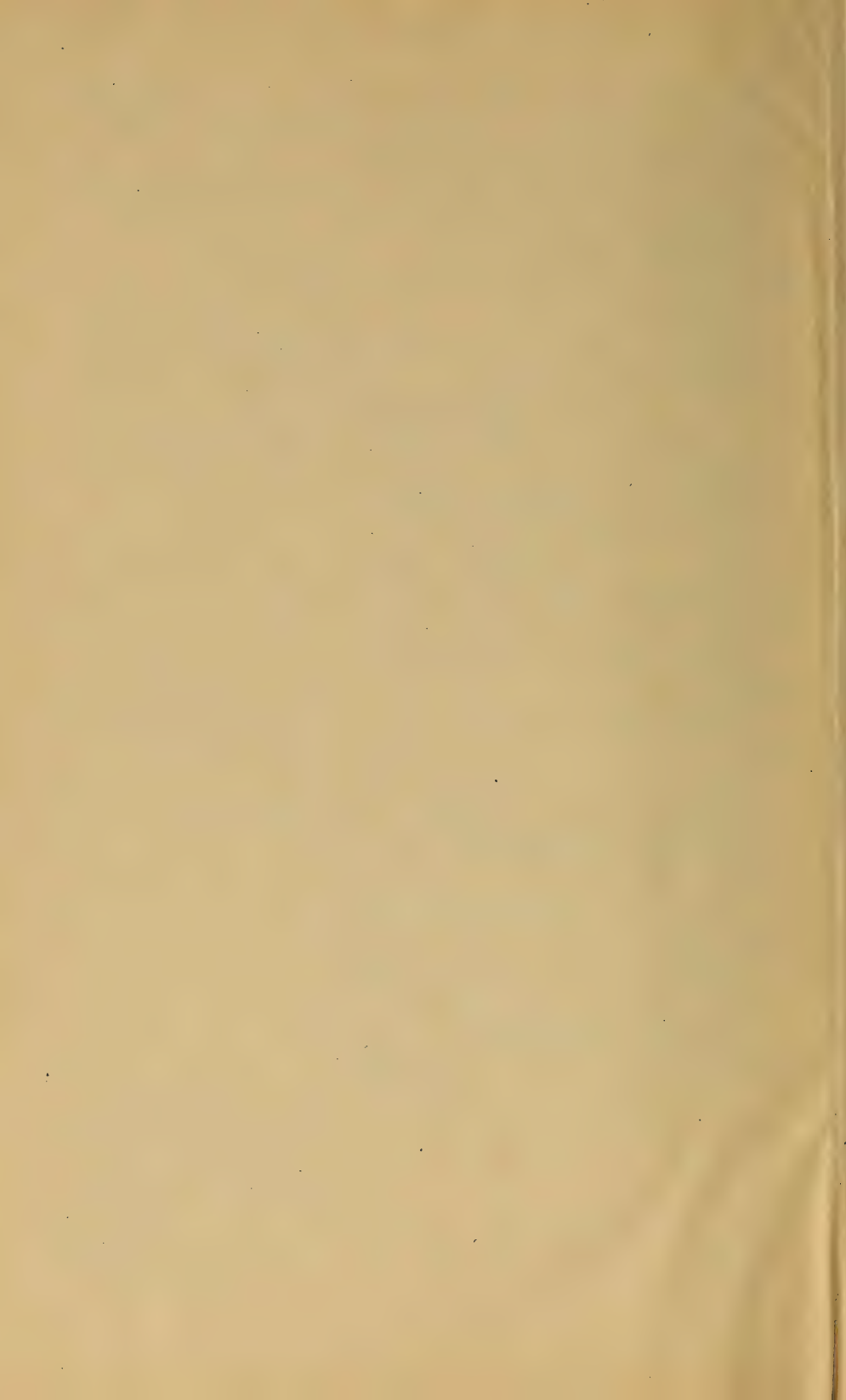
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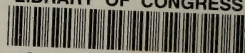








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